

**DISPUTE RESOLUTION SERVICE****D00020003****Decision of Independent Expert**

Zambon S.p.A.

and

Ms Vanmala Bansode

**1. The Parties:**

Complainant: Zambon S.p.A.  
Zambon S.p.A.  
Via Lillo del Duca, 10  
Bresso  
Milano  
20091  
Italy

Respondent: Ms Vanmala Bansode  
Farande Nagar  
Nanded  
53100  
Italy

**2. The Domain Name:**

zambon.co.uk

**3. Procedural History:**

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

22 March 2018 12:32 Dispute received  
22 March 2018 14:47 Complaint validated  
22 March 2018 15:10 Notification of complaint sent to parties  
12 April 2018 02:30 Response reminder sent  
17 April 2018 12:59 No Response Received  
17 April 2018 12:59 Notification of no response sent to parties  
24 April 2018 11:53 Expert decision payment received

#### **4. Factual Background**

I have taken the following from the Complainant's Complaint and its supporting evidence, which have not been disputed.

- The Complainant is an international pharmaceutical company originally established in Italy over 100 years ago. It now has a global presence with 2,800 employees and 2016 revenues of 713 million euros.
- The Complainant has numerous trade mark registrations around the world incorporating its ZAMBON name which have been in use in a very substantial way for over a hundred years.
- The Respondent, who also claims to be based in Italy, registered the Domain Name on 2 February 2017 and four days later she sent an unsolicited email to the Complainant offering to sell it to the Complainant for £15,000. That sum was later reduced to £1,500 then £500. The Complainant rejected those offers and filed this DRS Complaint when the Respondent failed to agree to transfer the Domain Name to it for nothing.
- The Domain Name has previously resolved to various random third party websites, such as the supermarket chain Lidl, and also to a Sedo parking page earning click through income from sponsored links and where it was offered for sale generally for £7,000.

#### **5. Parties' Contentions**

In summary, in its Complaint, which was supported by various exhibits, the Complainant made the following submissions:

- The Complainant is an Italian multinational pharma company established in 1906 in Vicenza, Italy. The Complainant's company name, ZAMBON, is the surname of the founder, Mr. Gaetano Zambon and it is now run by the third generation of the Zambon family.
- From its beginnings in Italy it has expanded into Europe and overseas in South America and the Far East. A subsidiary company in the UK was founded in 1989. It now operates in more than eighty countries spread over the five continents with 2,800 employees and 2016 revenues of 713 million euros.
- The Complainant has earned a strong and recognized international reputation over the years for high quality products and services, being well-established in three therapeutic areas (respiratory, pain and women's care) as well as specialty disease areas such cystic fibrosis and Parkinson's Disease.
- The Complainant is the owner of several national, European and international trade mark registrations worldwide for ZAMBON which has been in use as distinctive sign for the

Complainant's activity for more than one hundred years and is a well-known trade mark enjoying a wide reputation and goodwill.

- The Complainant has also developed a strong online presence in social media, managing dedicated accounts on, for example, You Tube, Twitter and LinkedIn which all encompass ZAMBON in their name.
- The Complainant is also the owner of several domain names incorporating the ZAMBON name and trade mark and operates its corporate websites using the domain names <zambongroup.com> and <zambonpharma.com> with its international subsidiaries using dedicated websites resolving from domain names such as <zambon.it>, <zambon.be>, <zambon.fr>, <zambon.de>, <zambon.es>, <zambon.com.cn>, <zambon.ru>, <zambon.co>, <zambon.com.br>, and <zambon.co.id>.
- On 2 February 2017, the Respondent registered the Domain Name without any authorisation from the Complainant.
- The Domain Name now resolves to an inactive website after suspension of the registration by the competent authorities / registrar. It had previously pointed to random websites (such as Lidl) and a pay per click landing page with commercial links related to third parties' websites and which offered the Domain Name for sale for £7,000.
- On 6 February 2017, shortly after the registration of the Domain Name, the Respondent sent the following unsolicited message to the Complainant, offering the Domain Name for sale:

*"I am contacting you regarding domain name Zambon.co.uk. I own this domain name and I wish to sell it. It seems you own many other extensions for keyword 'Zambon'. Thought you might be interested in this too. This domain can be useful for your website to rank on Google. Please revert back if you are interested in buying this domain name".*

- The Complainant responded by requesting additional information about the inquiry and the Respondent replied by requesting £15,000 to transfer the Domain Name. The Complainant instructed its authorised representatives to send a cease and desist letter to the Respondent by email notifying her of the infringement of its intellectual property rights and requesting transfer of the Domain Name free of charge. It was not possible to send the letter via registered mail as the postal address associated with the Domain Name is clearly inaccurate: no street number was specified and in any case no city named "Nanded" exists in Italy.
- The Respondent replied to the email alleging that she had no knowledge of the Complainant's trade mark. The Complainant's authorised representative responded pointing out that, since she had first contacted the Complainant via an unsolicited email, it was impossible that she was unaware of the Complainant's existence and related intellectual property rights over the ZAMBON trade mark. A further request to transfer the Domain Name was made.
- The Respondent answered requesting £1,500 and, after it was pointed out the amount requested clearly still exceeded the reimbursement of her out-of-pocket costs for the Domain Name, the Respondent reduced her request to £500. This was rejected by the Complainant who again requested a simple transfer of the Domain Name, but no further reply was received from the Respondent, despite a reminder.
- The Domain Name at present is due for renewal, but the Complainant opted to commence these DRS proceedings in order to avoid the registration being subject to a late renewal by the Respondent or being registered by another third party. As was stated in Staples

Inc. –v- Transworld Leisure (DRS 01514), a case where the disputed domain name had expired before the filing of the complaint: *“The question (..) arises as to whether the Domain Name can still be in the hands of the Respondent after the registration has expired. The answer is in the affirmative.”*

- The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name as the Domain Name is identical to the company name of the Complainant and its registered trade marks, ignoring the .co.uk suffix which it is right to do when making the comparison - see J Sainsbury PLC and SAIDA KHAFIF (DRS D00018607); Deckers Outdoor Corporation v. David Lee (DRS D00008907); and Novartis AG and Zhao Ke (DRS D00018787).
- The Respondent clearly registered the Domain Name with the Complainant’s marks and company name in mind and, considering the distinctiveness of the trade name and trade marks, the Respondent chose this Domain Name in bad faith only to profit from the reputation of the Complainant and its goodwill.
- The Domain Name, in the hands of the Respondent, is an Abusive Registration. The Respondent has no rights or legitimate interests in respect of the Domain Name, is not commonly known by the Domain Name as an individual, business, or other organisation and has not provided any evidence of any use of, or demonstrable preparations to use, the Domain Name in connection with a bona fide offering of goods or services before or after any notice of the dispute. Indeed, the Respondent used to resolve the Domain Name to random unrelated websites, including a pay-per-click page where it was offered for sale at £7,000. The Respondent is not a licensee or an authorised agent of Complainant or in any way legally permitted to use the Complainant’s trade marks and company name.
- Since the Complainant’s ZAMBON name and trade mark enjoys a considerable degree of reputation and has been extensively used for more than one hundred years, it is inconceivable that the Respondent was unaware of the existence of the Complainant’s trade mark incorporated within the Domain Name. It is quite clear that the Domain Name was chosen because of its association with the Complainant and its products. There could be no other reason for choosing it. The well-known nature of a trade mark to which a domain name is identical or confusingly similar is evidence of an abusive registration - see Barclays PLC and James Robinson (DRS D00010915).
- Given the Domain Name is as an exact match for the Complainant’s ZAMBON name and trade mark, it would be difficult to conceive of a use that would not fall foul of the DRS Policy without the consent of the Complainant - see ALF (Aquatic Distributors) Ltd and Kettering Koi & Ponds Ltd (DRS D00015763).
- In addition, the Respondent’s actual knowledge of the Complainant’s name and trade mark at the time of the registration of the Domain Name is clearly demonstrated by the fact that the Respondent sent an unsolicited communication to the Complainant only four days after having finalised the registration of it, by sending an email to the Complainant’s corporate email address dedicated to domain name matters, offering the Domain Name for sale to the Complainant.
- Given the identity of the Domain Name with the Complainant’s trade marks and company name, there is a clear likelihood that Internet users could be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with Complainant, irrespective of the contents published on any website to which it resolves. Such ‘initial interest confusion’ has been held to provide a basis for a finding of an abusive registration in several DRS decisions – see Ferrero S.p.A and Mr Peter Ross

(DRS D00009187), Emirates v Michael Toth (DRS 8634), EL CORTE INGLES, S.A. and Manuel Sanchez (DRS D00011532) and paragraph 3.3. of the Experts' Overview

- The use made by the Respondent of the Domain Name, being redirected to different random websites and pay per click pages, is evidence of an abusive registration - see Chrome River Technologies, Inc. v. Mr Yang HongJuan (DRS 19380) and Medical Elite Recruitment & Practice Sales Limited and Mr Phillip Barker (DRS D00017759). The Respondent was certainly gaining from click-through commissions on the sponsored links that were published on the Sedo parking page to which the Domain Name resolved and this was done to attract by deception visitors to websites of the Complainant's competitors and for commercial gain – see Aldershot Car Spares v Gordon (DRS 02464), The Royal Bank of Scotland Group Plc v John Wilfred (DRS 3952) and Newbury Building Society v Webster (DRS 3967).
- The Respondent requested sums between £15,000 and £500 to transfer the Domain Name to the Complainant as the legitimate trade mark owner, even after having been notified of Complainant's rights over the ZAMBON trade mark. Such amounts are well in excess of the out-of-pocket costs directly related to the Domain Name - see Quantel Limited v. Ellis Wright (DRS 02321), Doosan International Luxembourg SARL v. Alistair Thomson (DRS D00012129), Goodridge Limited v. K300 Limited (DRS D00009135), and Barclays PLC v. Eric Zhang (DRS D00011897). The amounts requested clearly demonstrate that the Respondent attempted to profit from the sale of the Domain Name which is evidence of an abusive registration in accordance with paragraph 5.1.1.1 of the DRS Policy.
- Even the current use of the Domain Name, resolving to an inactive website, does not prevent consumers from being deceived and confused by it. Several previous DRS decisions have considered that such a "blocking registration" is unfairly detrimental to a complainant's rights. Passive holding of a domain name does not constitute legitimate non-commercial or fair use of it and previous historic use is relevant – see The Gap, Inc. and Gap (ITM) Inc. and Cybernet Ventures Limited (D00000820) and Hanna-Barbera Productions, Inc. and Graeme Hay (DRS 00389 Appeal). Accordingly, the Complainant believes that the use of the Domain Name by the Respondent before she was put on notice of the complaint should be taken into consideration by the Expert and such use should be considered neither as a genuine offering of goods or services nor as a legitimate non-commercial or fair use of the Domain Name.
- In addition to the above, paragraph 5.1.6 of the DRS Policy is applicable to the present case since *"The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name."* As held in Remitly U.K., Ltd. and Hofer Jan (DRS D00018407), to apply this circumstance *"The Complainant has to establish the (..) mark has a reputation (..) at the time of registration of the Domain Name given that this paragraph of the Policy is concerned with the Respondent's reasonable justification or not for registration"*. The Complainant has provided evidence to prove the reputation of its ZAMBON trade marks and that the Respondent was certainly aware or should have been aware of the Complainant's rights at the time she registered the Domain Name.
- Finally, the Respondent has used fictitious data for the registration of the Domain Name, indicating a postal address which is blatantly incomplete or false. As stated in several prior DRS cases, the use of false contact information constitutes a further indication of an abusive registration according to Paragraph 5.1.4 of DRS Policy.

The Respondent did not respond to the Complaint.

## 6. Discussions and Findings

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, namely that:

1. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

These terms are defined in the Nominet DRS Policy as follows:

- **Rights** means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.
- **Abusive Registration** means a Domain Name which either:
  - i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
  - ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

### Does the Complainant have Rights?

The Complainant is an established global pharmaceutical business and has traded in a very significant way under the ZAMBON name for over 100 years. It also owns various trade mark registrations for its ZAMBON trade mark. In the circumstances, the Complainant clearly has Rights in the ZAMBON name for the purposes of the DRS.

### Is the Domain Name identical or similar to the ZAMBON name?

In assessing whether a domain name is identical or similar to a name or mark the “.co.uk” suffix can be ignored, unless perhaps the name or mark concerned itself includes a particular top-level domain suffix, which is not the case here.

In the circumstances, I find that the Domain Name is identical to the ZAMBON name or mark in which the Complainant has Rights.

### Is the Domain Name an Abusive Registration?

Even though the Respondent failed to respond to the Complaint, the Complainant still bears the burden of proving its case. The Complainant has submitted a very full and well-reasoned Complaint, supported by cogent documentary evidence and referencing a number of relevant previous DRS decisions. This all goes to demonstrate a very clear case of an Abusive Registration.

Paragraph 5 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 5.1.1 states as follows:

*“Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

1. *5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*
2. *5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or*
3. *5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;”*

The Respondent claimed not to have known of the Complainant's ZAMBON trade mark, but she is also based in Italy where the Complainant was first established and has its principal office. It is particularly telling that only four days after registering the Domain Name she contacted the Complainant offering to sell it for £15,000. That figure is clearly very much in excess of the cost of registering it. Whilst trading in domain names for profit is of itself unobjectionable, when making the offer in this case the Respondent specifically referred to the importance of the UK market and the fact that the Complainant already had many other domain names comprising its ZAMBON name and that she thought the Domain Name might also be of interest to the Complainant.

It is inconceivable that, when registering the Domain Name, the Respondent was not well aware of the existence of the Complainant and its Rights in the ZAMBON name. It is highly likely that when registering the Domain Name, the Respondent will have known that its existence would block the Complainant from registering it and that its subsequent use would be able to ride on the coat tails of the Complainant's goodwill and reputation. She therefore saw an opportunity to take advantage of the fact that, despite owning numerous domain name registrations of its Zambon name, the Complainant had not itself registered the .co.uk domain name extension.

I therefore find that at the time the Respondent registered the Domain Name she did so in a manner that took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

In addition, the Complainant also relies upon the subsequent use made by the Respondent of the Domain Name and points to paragraph 5.1.2 of the DRS Policy, which states as follows:

*“Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;”*

Before dealing with the two types of previous use of the Domain Name I should say that I agree with the Complainant's point made in its Complaint that historical use is relevant. It can and should be taken into account and the mere fact that the Domain Name has now been suspended as a result of the Complainant's actions and points nowhere is not relevant.

The first type of use of the Domain Name complained of by the Complainant is that it resolved to a Sedo parking page where it was offered generally for sale along with various third party sponsored links by which 'click-through' income was generated for the Respondent. As paragraph 8.5 of the DRS Policy makes clear, connecting a domain name to a parking page and earning 'click-through' revenue from it via links to other websites is not in itself objectionable. But it goes on to confirm that:

*"However, the Expert will take into account:*

*8.5.1 the nature of the Domain Name;*

*8.5.2 the nature of the advertising links on any parking page associated with the Domain Name; and*

*8.5.3 that the use of the Domain Name is ultimately the Respondent's responsibility"*

This makes it clear that even if the Respondent has ceded day to day control of the use of the Domain Name to a third party such as Sedo, she cannot simply wash her hands of any responsibility for what they then do with it as it still remains her domain name. In this case, the Domain Name is identical to the Complainant's established name and trade mark, was originally registered in order to take advantage of that fact and the Complainant says that the sponsored links were for third party commercial competitors of the Complainant. In the circumstances, I am satisfied that this amounts to abusive use of the Domain Name for which the Respondent is responsible.

The second type of use of the Domain Name complained of is when it resolved to various third party websites, such as that of the supermarket chain Lidl. Whilst not a competitor, the Complainant relies upon 'initial interest' confusion and section 3.3 of the Experts' Overview which is published on the Nominet website to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts, the members of Nominet's panel of independent adjudicators, have dealt with those issues to date and identifying any areas where Experts' views differ.

As discussed by the Appeal Panel in DRS 15788 (starwars.co.uk), notwithstanding the UK Court of Appeal's judgement in *Interflora v Marks and Spencer* being critical of the use of "initial interest confusion" as a concept relevant to English trade mark law, initial interest confusion remains an applicable principle in determining whether or not a domain name registration was abusive for the purposes of the Nominet DRS.

The Experts' Overview says that, where the names are identical and cannot sensibly refer to anyone other than the Complainant, there is bound to be a severe risk that a search engine will return the URL for a website connected to the Domain Name. In this case, the Domain Name is identical to the Complainant's name and mark, and there seems to be no other material users of the "Zambon" name as a business name. If an Internet user looking for one of the Complainant's websites arrives by mistake at a website to which the Domain Name resolved, the user may have been faced with a random well-known third party website like Lidl. Even if the Internet user has been deceived by the Domain Name when arriving at the site, when, as in this case, the site is that of a well-known third party in an entirely unconnected line of business, whilst it may cause annoyance or frustration I am not convinced that a material number of Internet users would assume that it is "registered to, operated or authorised by, or otherwise connected with the Complainant". However, paragraph 5.1.2 of the DRS Policy is just one of a number of non-exhaustive examples of the type of use of a domain name that might be evidence of an abusive registration. Any other use that has taken



unfair advantage of or has been unfairly detrimental to the Complainant's Rights is also relevant.

Where, as in this case, the Domain Name has been registered with a view to taking advantage of the Complainant's name and reputation without cause and for financial gain, I would be slow to decide that, when making this sort of use of it, the Respondent has failed in her quest. Some Internet users may not bother to look any further for the Complainant and annoyance and frustration caused to Internet users trying to access the Complainant's website may well rub off and tarnish the Complainant's brand and reputation merely by association. I have little doubt the Respondent had hoped that such use might have persuaded the Complainant to pay her a substantial sum of money for the Domain Name to prevent it from containing to happen. In my view, such use clearly takes unfair advantage of and is unfairly detrimental to the Complainant's Rights.

The Complainant also relies upon two further examples of evidence of an abusive registration from paragraph 5 of the DRS Policy. First, paragraph 5.1.4 states as follows:

*"It is independently verified that the Respondent has given false contact details to [Nominet]"*

The address given by the Respondent when registering the Domain Name was *"Farande Nagar, Nanded, 53100, Italy"* and the registration details confirm that Nominet was unable to match the address (and/or the Respondent's name) against a third party source. The Complainant points out that no street number was specified and no city named "Nanded" exists in Italy. As independent verification of this point, the Complainant provided the results of searches conducted on the web mapping services of the main search engines and the full list of current Italian cities whose names begin with the letter "N" that had been downloaded from the website of the Italian Government's Revenue Agency. In particular, I accept the latter evidence as independent verification.

Secondly, paragraph 5.1.5 of the DRS Policy states as follows:

*"The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name".*

The circumstances of this case fall squarely within paragraph 5.1.5 of the DRS Policy.

## **7. Decision**

For the reasons outlined above I find that the Complainant has proved, on the balance of probabilities, that it has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

In the circumstances I order that the Domain Name be transferred to the Complainant.

**Signed:**

**Dated:** 18 May 2018

Chris Tulley