



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Finmeccanica S.p.A. v. Moniker Privacy Services / Guillermo Lozada**

**Case No. D2008-0884**

#### **1. The Parties**

The Complainant is Finmeccanica S.p.A., Rome, Italy, represented by Massimo Cimoli, Italy.

The Respondent is Moniker Privacy Services / Guillermo Lozada, Houston, Texas United States of America ("US"), represented by Pierfrancesco C. Fasano, Italy.

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

The disputed domain name <ansaldo.com> is registered with Moniker Online Services, LLC.

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 10, 2008. On June 11, 2008, the Center transmitted by email to Moniker Online Services, LLC a request for registrar verification in connection with the domain name at issue. On June 23, 2008, Moniker Online Services, LLC 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 24, 2008 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 July 3, 2008. 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"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 8, 2008.

On July 28, 2008, pursuant to a request from both parties, the Center suspended the procedure in order to allow the parties to pursue a settlement of the dispute. On August 25, 2008, the Complainant requested that the proceedings be reinstated and the Center did so on the same date.

In accordance with the Rules, paragraph 5(a), the due date for Response was August 30, 2008. The Response was filed with the Center on August 26, 2008.

The Center appointed Richard Hill as the sole panelist in this matter on September 3, 2008. 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 well-known, large holding company. It owns numerous trademarks for the string ANSALDO and several of its subsidiaries have company names that include that term.

The term “ansaldo” is an Italian surname, and was the surname of the founder of a company that was later acquired by the Complainant.

The Complainant’s various Ansaldo companies are widely known, and the ANSALDO mark is very well known.

The Respondent is the United States of America agent of a company now called Mangiarotti.

From 2001 until March 2008, this company had a name that included the word “ansaldo”, because it had acquired some subsidiaries of the Complainant. The name was changed in March 2008 in response to the revocation by the Complainant of previously granted licenses to use the names containing the word “ansaldo”.

The disputed domain name was first registered by a Korean individual in 2001. In 2002, the web site at the disputed domain name stated that it was “under construction”. In 2003 and 2004, the web site at the disputed domain name stated that the domain name was for sale. Since 2005, the disputed domain name has been used to point to generic search pages.

The Respondent acquired the disputed domain name from the Korean individual in January 2008, for the sum of USD 25’000.

At present, the search page pointed to by the disputed domain name does not feature products or services associated with the ANSALDO mark or that compete with the Complainant’s products or services.

## **5. Parties' Contentions**

### **A. Complainant**

According to the Complainant, the Respondent registered the contested domain name in 2001.

The Complainant states that ANSALDO is an Italian trademark that is very famous in the energy plants business and in the train and underground transportation system. The Company was established at the end of the last century in Genoa, Italy and since then it is synonymous of quality and excellence.

The Complainant owns trademarks for the string ANSALDO in many countries and for various product categories. And the mark is famous and has a long history. The Complainant is the holding company of several companies operating under the Ansaldo name, such as Ansaldo Energia; Ansaldo Sts; Ansaldo Fuels Cells; Ansaldo Nucleare; Ansaldo Electric Drive; Ansaldo Breda .

Further, says the Complainant, Ansaldo is quite an unusual Italian name that has become famous thanks to the Complainant's activities. The Respondent has no relationship with Italy and/or the Ansaldo companies. He has been using the contested domain name very minimally just as a page in which a search engine is available to carry out further thematic searches.

The disputed domain name is clearly identical to the Complainant's trademark.

According to the Complainant, the Respondent has no rights or legitimate interests in the disputed domain name because he is not a licensee or an authorised person to hold the contested domain name, and because he has been using the disputed domain name to attract possible clients of the Complainant and possible customers and to divert them to different producers or different web sites. The Respondent has a different trade name and it is not known by the domain name.

Anyone entering the website at the contested domain name has only one choice, that is to carry out a further search including a word in the text box then pressing the search button and the search engine will display a list of thematic web sites that you may or may not open. It is therefore a sort of web parking in which the contested domain name has been used only as the attraction domain name but in which nothing at all is related to products and services offered by the Complainant or associated with the ANSALDO name or trademark.

The Complainant alleges that the disputed domain name has been registered and used in bad faith because the Respondent has registered it to intentionally attempt to attract for commercial gain, Internet users to the Respondent's web site and then to divert them to other site through the search routine which is the only choice that a user has after he or she enters the site.

Further, says the Complainant, the circumstances of this case compel the conclusion that the Respondent registered and has used the disputed domain name in an attempt to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's ANSALDO trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and online store.

And the Complainant states that the Respondent registered and has used the disputed domain name in an attempt to obstruct the activity of the trademark owner and to attract, for commercial gain, Internet users to its website.

## **B. Respondent**

According to the Respondent, in 2001 Ansaldo Energia, a subsidiary of the Complainant, sold its division of special components to Camozzi group, setting up a new company for such purpose called “Ansaldo Camozzi Energy Special Components”. Ansaldo Camozzi Energy Special Components Spa (Camozi group) had the entire share capital of the company called “Ansaldo Camozzi Nuclear & Energy Special Components”.

The Respondent states that in 2007 Ansaldo Camozzi Energy Special Components (Camozi group) intended to assign the business branch (related to the production of steam generators, of huge components for electronuclear power stations, of robotized welding systems and mechanical components for huge telescopes) to “Ansaldo Camozzi Nuclear & Energy Special Components”, and, subsequently, to sell its majority shareholding to third parties. Under Italian law, from limited liability company (Srl) Ansaldo Camozzi Nuclear & Energy Special Components was converted into public limited company (Spa) on December 14, 2007.

The Respondent alleges that Mangiarotti is a joint-stock company (Spa) incorporated under Italian law, and active in the chemical, petrochemical, high vacuum, L.N.G. & L.P.G., power plant fields of activity, and is engaged, *inter alia*, in the designing and manufacturing of steel equipment for hydraulic power plants, pressure vessels and heat exchanges for oil, gas and associated industries.

According to the Respondent, Mangiarotti approached Ansaldo Camozzi Energy Special Components Spa (Camozi group) as a potential buyer and, with the consent of the latter, conducted a due diligence to evaluate the target company and its assets for acquisition. Further to the due diligence, on December 11, 2007, Mangiarotti and Ansaldo Camozzi Energy Special Components Spa (Camozi group) concluded an agreement to transfer 70% of the shares of Ansaldo Camozzi Nuclear & Energy Special Components Spa, i.e. 7,000,000.00 (seven million) equity shares with a nominal value of Euro 1.00 (one), to Mangiarotti. On December 18, 2007 the transfer of the shares was completed and 7,000,000.00 (seven million) equity shares with a nominal value of Euro 1.00 (one) were allocated to Mangiarotti.

The Respondent, Mr Guillermo Lozada, states that he is an authorized agent of Mangiarotti.

The Respondent states that in January 2008, Mangiarotti, through its agent Mr. Guillermo Lozada, purchased the disputed domain name from a Korean seller, Mr. Youngho Lee, by Escrow transaction paying the price of USD 25,000.00 plus escrow fees of USD 214.50.

The Respondent alleges that, as in the past, even after the acquisition of Ansaldo Camozzi Nuclear & Energy Special Components Spa from Ansaldo Camozzi Energy Special Components Spa (Camozi group), Mangiarotti and the Complainant (through its controlled company named Ansaldo Nucleare Spa) continued to have a business relations.

According to the Respondent, on March 20, 2008, the Complainant, which controls Ansaldo Energia, sent a notice by registered letter to Ansaldo Camozzi Energy Special Components and to Ansaldo Camozzi Nuclear & Energy Special Components in order to terminate the Trademark and Trade Name Licence Agreement signed on April 6, 2001. In consequence the recipients were invited to not use any longer the trademark and trade name ANSALDO.

In consequence, says the Respondent, on April 23, 2008, an extraordinary shareholders' meeting of Ansaldo Camozzi Nuclear & Energy Special Components (Mangiarotti Group) was held to approve the following resolutions: (1) to change the location of the registered office; and (2) to modify the business name of the company to Mangiarotti Nuclear Spa.

On June 10, 2008, the Complainant filed a complaint with the Center which gave rise to the present dispute.

The Respondent states that on July 15, 2008, the Respondent communicated to the Complainant and to the Center to have registered other domain names including the word "Ansaldo" under different TLDs and stated that it was willing to transfer them against the reimbursement of the price paid.

The Respondent further states that, notwithstanding all the above mentioned facts, with a letter dated August 22, 2008 the Complainant, through its counsellors, declared Mangiarotti "totally strange and unknown" and "this request unfair and further proof of the Respondent's bad faith".

The Respondent does not contest the Complainant's trademark rights, and the identity between those marks and the disputed domain name.

The Respondent alleges that he has rights and legitimate interests in the disputed domain name because, at the time he acquired the disputed domain name, he was the US agent of Mangiarotti Spa, a company that, just few months before the registration of the disputed domain name, had acquired Ansaldo Camozzi Energy Special Components Spa (Camozzi group), a company containing in its trade name the word "Ansaldo". Further, Mangiarotti acquired Ansaldo Camozzi Energy Special Components Spa (Camozzi group), a company licensee, according to the Licensing Agreement between the Complainant and Ansaldo Camozzi Energy Special Components Spa signed on April 6, 2001.

The Respondent further submits that, at the time of acquisition (December 2007), no one, neither the Complainant nor Camozzi group, communicated to the Respondent that Ansaldo Camozzi Nuclear Energy Components Spa had no rights or legitimate interest in the word "ansaldo". Only three months after the date of acquisition (18 December 2007) and two months after the registration of disputed domain name (15 January 2008), on March 23, 2008, did Mangiarotti receive the registered letter from the Complainant, in which the Complainant communicated the termination of the Trademark and Trade Name Licence Agreement signed on April 6, 2001 between it and Ansaldo Camozzi Nuclear Energy Components SpA; therefore before March, 23 2008 Respondent had the (unchallenged) right and/or the legitimate interest in the trade name "Ansaldo Camozzi Nuclear Energy Components" including the word "ansaldo". Ansaldo Camozzi Nuclear Energy Components Spa, the company acquired by Mangiarotti on December 2007, has been a subsidiary of the Complainant since 2001, when Camozzi Italian group acquired the division "Special Components" from Ansaldo

Energia (a subsidiary of the Complainant).

The Respondent states that he has registered a domain name including a word “ansaldo” included in the trade name of a company acquired (in compliance with the principle “first come first served”), and used that domain name in good faith, because the Respondent’s principal (respecting the Complainant’s Intellectual Property Rights)

- (a) changed its name to remove the word “ansaldo” as soon as it received from the Complainant the termination letter of the 2001 Trademark and Trade Name License Agreement,
- (b) “web-parked” it and
- (c) sought a settlement of the dispute (in compliance with the principle “*bona fide* intention to use”).

Further, says the Respondent, he “parked” the disputed domain name pending future use. Therefore, there is no intention to attract net surfers. In itself, parking for financial gain is not a violation of the Policy and is, in such cases, recognized as a *bona fide* offering of services. The distinction between parking legally and parking in violation of the Policy lies in the conduct of the Respondent. Liability attaches only when the Respondent has engaged in bad faith conduct, such as using the domain name to advertise products or services that compete with those offered by the Complainant.

According to the Respondent, just the opposite is true in the present case. Searching by the generic term “energy components” on the web site at the disputed domain name the net surfer will result in finding pages totally different from the Complainant’s competitors.

The Respondent declares and affirms that when he registered and used the disputed domain name he believed to have a “right” or “legitimate interest” to the word “ansaldo” on the basis of the right to a company name containing that word.

The Complainant alleges that the Respondent registered the disputed domain name to intentionally attempt to attract for commercial gain, Internet users to the Respondent’s web site and the to divert them to other sites through the search routine which is the only choice that a user has after he or she enters the site. But, says the Respondent, the Complainant’s case under this head is based on one understandable, but fundamental misunderstanding. Contrary to the Complainant’s genuinely held belief, it is clear from the Respondent’s submitted materials that the registration of disputed domain name has been filed on the trade name basis. No bad faith. No intention to attract customers for commercial gain. Indeed, the Respondent has demonstrated that, at the date of the registration of the disputed domain name, he was the agent of a company that was the proprietor of a trade name “Ansaldo”.

According to the Respondent, the fact that the disputed domain name may have been listed for sale by Korean seller is of no assistance to the Complainant. The buying and selling of domain names is, in and of itself, a perfectly legitimate trading activity. There is nothing before the Panel to demonstrate that the Respondent registered the disputed domain name with a view to profiting from it on the back of the Complainant’s goodwill/trade marks.

The Respondent states that he tried to solve the dispute by transferring the domain

name to the Complainant against the reimbursement of the amount paid to the Korean seller. But the Complainant refused to settle the matter, considering that the payment is not due, because of the fact that “Ansaldo” is a well-known name in the industry.

According to the Respondent, buying and selling domain names is perfectly legal, as long as the domain being sold does not infringe on the trademark rights of a third party. But Intellectual Property rights holders should be aware that possessing, for instance, a trademark for a given term does not automatically mean that you have a legitimate legal claim to a domain name which contains that term.

Considering the facts that were known to the Complainant when it commenced this action, the Respondent asks the Panel to make a finding of reverse domain name hijacking.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

Both parties agree that the disputed domain name is identical to the Complainant’s registered trademark.

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

The disputed domain name was first registered by an individual in Korea, presumably for speculative reasons. It was subsequently offered for sale and used to point to search sites.

The history of the use of the disputed domain name can be found through The Wayback Machine, at “<http://www.archive.org>”.

The available case record indicates that the Respondent acquired the disputed domain name from the Korean individual in January 2008. At that time, the name of the company that he represented included the word “ansaldo”. Further, at that time, the company appears to have had certain licenses and rights to use the Ansaldo name.

The full name of the company was long and complex, and both parties agree that the name Ansaldo is widely known. A domain name comprising that name could be a definite commercial asset.

According to 4(c)(ii) of the Policy, rights or legitimate interests in a domain name are demonstrated if:

you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights

As stated above, the full name of the company that the Respondent was representing is too long and complex to be registered as a domain name. Given the potential value of the Ansaldo name (as a name), the Panel’s finding below that the Complainant has failed to prove bad faith in this case and given that the Ansaldo name was part of the name of the company for which the Respondent was acting, the Panel finds that the

Respondent did on balance have a legitimate interest in the disputed domain name when he acquired it from the original registrant (the Korean individual).

For a supporting precedent (albeit in different factual circumstances), see *G. A. Modefine S.A. v. A.R. Mani*, WIPO Case No. D2001-0537, in which the panel stated (concerning the domain name <armani.com> in which the complainant was the owner of the famous ARMANI mark):

“The Complainant’s case that the Respondent has no legitimate interest rests in essence on suggesting that the Respondent should not have registered a name which is a mixture of his own initials and surname but should instead have registered his own full name or some other variant of it. The Panel rejects that submission. It is very common practice for people and organizations to register domain names which are based upon initials and a name, acronyms or otherwise variants of their full names. So far as the Panel understands the Complainant’s submission at all, it seems to be predicated on the fact that by doing so the Respondent is likely to cause confusion with the Complainant’s mark – that wrongly imports into the test for legitimate interest an element of confusion or bad faith.”

Accordingly, the Panel finds that the Complainant has failed to prove that the Respondent lacks rights or legitimate interests in the disputed domain name.

### **C. Registered and Used in Bad Faith**

The Complainant alleges that the disputed domain name has been registered and used in bad faith because the Respondent has registered it to intentionally attempt to attract for commercial gain, Internet users to the Respondent’s web site.

But the Complainant does not provide any evidence to support that assertion. On the contrary, as noted above, the Respondent has provided evidence to support his assertion that he registered the domain name believing that he had rights to use it to promote the products and services of the company that he was representing.

There is no evidence before the Panel to establish that the Respondent acted in bad faith when he acquired the disputed domain name from the original registrant (a Korean individual). On the contrary, the evidence shows that, at that time, the Respondent was the agent of a company whose name included the widely known Ansaldo name. It would seem perfectly plausible for the Respondent to acquire the contested domain name in order to develop the business activities of the company that he was representing, given that the name is widely known and was part of the company’s name.

It could be argued that the Respondent should have given the contested domain name to the Complainant when, following the revocation of the license to use the Ansaldo name, it could no longer use the disputed domain name to promote the goods and services of the company he was representing. See e.g. *R&M Italia SpA, Tycon Technoglass Srl v. EnQuip Technologies Group, Inc.*, WIPO Case No. D2007-1477. However it is noteworthy that in that case a significant component of the panel’s finding of bad faith appeared to rest on the respondent’s continued use of the disputed domain name to promote products of competitors of the complainant. Such circumstances do not appear to be present in the instant dispute. The Respondent is a US resident. Thus, it is appropriate to note that that in *Hasbro*,



*Inc. v. Clue Computing, Inc.*, 66 F.Supp.2d 117, (D. Mass., 1999), the court held that holders of a mark are not automatically entitled to use that mark as their domain name: trademark law does not support such a monopoly; if another Internet user has an innocent and legitimate reason for using the mark as a domain name and is the first to register it, that user should be able to use the domain name, provided that he has not otherwise infringed upon or diluted the trademark.

In any event, in this Panel's view the Policy does not impose a duty to transfer a domain name, absent bad faith behavior. The Policy allows a good faith owner of a domain name to sell it for a profit. As the Panel stated in *Manchester Airport PLC v. Club Club Limited*, WIPO Case No. D2000-0638:

“Selling a domain name is not *per se* prohibited by the ICANN Policy (nor is it illegal or even, in a capitalist system, ethically reprehensible).”

The available evidence shows that the Respondent was apparently willing to transfer the disputed domain name to the Complainant in exchange for reimbursement of his costs for acquiring the domain name. But the Complainant did not wish to pay that price.

As the panel stated in *G. A. Modefine S.A. v. A.R. Mani*, WIPO Case No. D2001-0537, already cited above (albeit in different factual circumstances):

“The figure suggested by the Respondent in his counter-offer seems entirely reasonable. It is a matter for the Complainant as to why it did not accept that offer. Its apparent belief that simply because it is the undisputed owner of a world famous name it can use the ICANN procedure to dispossess summarily a third party of what is a combination of his initials and surname, which on the evidence he has used in a *bona fide* manner since the early 1990s, is simply wrong.”

In this Panel's view nothing in the Policy prevents the Respondent from attempting to get a return on his legitimately acquired domain name, for example by selling it to a person whose surname is Ansaldo (indeed, an individual operates a personal website at <ansaldo.org>), or by using it for a generic search site, provided of course that the Respondent does not use the disputed domain name in order to disrupt the Complainant's business or to mislead Internet users or to target or cash-in specifically on the fame of the Complainant's mark.

And if such use were to subsequently occur, it may indeed provide a basis for the Complainant bringing some future action against the Respondent on that basis.

But for the present purposes, there is nothing in the current record to establish that the Respondent has used, or is using, or plans to use, the disputed domain name in a way that would be considered to be in bad faith under the Policy. In particular, both parties agree that the search page at the disputed domain name is not related to the Complainant's products or services and does not point to competitors of the Complainant.

In and of itself, parking a domain name for financial gain is not a violation of the Policy and is, in such cases, recognized as a bone fide offering of services, e.g. *Mariah Media Inc. v. First Place® Internet Inc.*, WIPO Case No. D2006-1275. Liability attaches only when the Respondent has “registered the domain name then placed it on a parking

service, which redirect[s] the user to a website advertising [goods or services competitive with Complainant,]”, see for example *Cloer Elektrogeräte GmbH v. Motohisa Ohno*, WIPO Case No. D2006-0026; *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. D2007-1912.

Nothing in the record establishes that the Respondent acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant for valuable consideration in excess of documented out-of-pocket costs; nor that the Respondent engaged in a pattern of conduct related to registering domain names in order to prevent the Complainant from reflecting its mark in a corresponding domain name; nor that the Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor.

Further, the Panel does not find any evidence in the record to support any other finding of bad faith registration or use.

The burden of proof under these proceedings falls on the Complainant, in accordance with Paragraph 4(a) of the Policy.

Having considered all the evidence, the Panel finds that the Complainant has failed to prove that the Respondent registered and is using the disputed domain name in bad faith.

#### **D. Reverse Domain Name Hijacking**

Paragraph 1 of the Rules defines Reverse Domain Name Hijacking:

**Reverse Domain Name Hijacking** means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.

The general conditions for a finding of bad faith on the part of the Complainant are well stated in *Smart Design LLC v. Carolyn Hughes*, WIPO Case No. D2000-0993:

“Clearly, the launching of an unjustifiable Complaint with malice aforethought qualifies, as would the pursuit of a Complaint after the Complainant knew it to be insupportable.”

These conditions are confirmed in *Goldline International, Inc. v. Gold Line*, WIPO Case No. D2000-1151 and *Sydney Opera House Trust v. Trilynx Pty. Limited*, WIPO Case No. D2000-1224 (where the condition is stated as “the respondent must show knowledge on the part of the complainant of the respondent’s right or legitimate interest in the disputed domain name and evidence of harassment or similar conduct by the complainant in the face of such knowledge”), which in turn cites *Plan Express Inc. v. Plan Express*, WIPO Case No. D2000-0565.

There is nothing in the record to indicate malice on the part of the Complainant and nothing to indicate that the Complainant knew that its case was insupportable.

The request for a finding of Reverse Domain Name Hijacking is therefore dismissed.

**7. Decision**

For all the foregoing reasons, the Complaint is denied.

The request for a finding of Reverse Domain Name Hijacking is dismissed.

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Richard Hill  
Sole Panelist

Date: September 15, 2008