Decision for dispute CAC-UDRP-101795

Case number	CAC-UDRP-101795
Time of filing	2017-12-13 11:48:32
Domain names	canali.group

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	CANALI IRELAND LIMITED

Complainant representative

Organization	Convey srl

Respondent

Name	Nashan

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies on the following trademarks:
- International trademark CANALI with registration number 341928A, for goods in class 25, registered on February 2, 1968;
- International trademark CANALI with registration number 756400, for goods an services in classes 3, 6, 9, 16, 18, 20, 25 and 34, registered on September 8, 2000;
- International trademark CANALI with registration number 543504A for goods and services in classes 6, 9, 14, 16, 18, 20, 25, 34 and 42, registered on October 2, 1989;
- International trademark C CANALI with registration number 1123321, registered for goods and services in classes 3, 9, 14, 18, 24, 25 and 42, registered on March 12, 2012;
- Chinese trademark CANALI with registration number 12160350 for goods in class 25, registered on July 28, 2014;
- Chinese trademark with registration number 2003772 for goods in class 25, registered on March 21, 2003; the Panel understand that represents CANALI in Chinese characters;
together and individually referred to as the "CANALI Trademark"

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

1. The Complainant is a prominent men's high-end fashion and luxury company, distributing a wide range of products such as suits, shoes, bags and men accessories all around the world, through more than 250 boutiques and 1,000 retail stores, in more than 100 countries across the globe.

2. The CANALI Trademark is distinctive and well-known all around the world.

3. The disputed domain name is identical to the CANALI Trademark as the second level of the disputed domain name is exactly identical to the Complainant's CANALI Trademark. In particular, the sole addition of the generic top-level domain ("gTLD") name ".group" is without legal significance since the use of a gTLD is required of domain name registrants and does not serve to identify a specific service provider as a source of goods or services.

4. The Respondent was never authorized by the Complainant to register and use the disputed domain name and the Respondent is neither the Complainant's representative nor an authorized licensee, neither a dealer nor a reseller. The Respondent does not have rights or legitimate interests arising from a bona fide offering of goods or services or from legitimate non-commercial or fair use of the disputed domain name. And the Respondent has not been commonly known by the disputed domain name and holds no trademark or service mark rights in the term "CANALI".

5. Rather, the Complainant contends that the Respondent has registered the disputed domain name to prevent the Complainant from reflecting the CANALI Trademark in a corresponding domain name, since the disputed domain name - at present - is not connected to an operative website.

6. The Respondent's contention in reply to the Complainant's cease and desist letter that it had registered the disputed domain name to host a blog for his pet allegedly named "Canali", should not be considered as a valid ground from which a legitimate interest to own the disputed domain name could arise.

7. The Respondent registered and used the disputed domain name in bad faith as it registered the disputed domain name in order to prevent the Complainant from reflecting the CANALI Trademark in a corresponding domain name, while being engaged in a pattern of such conduct. In this respect the Complainant has documented that the Respondent has registered more than four hundreds other domain names of which several were found to be exactly identical to established trademark rights belonging to third parties.

PARTIES CONTENTIONS

No administratively compliant Response has been filed. However, the Complainant submitted evidence showing that the Respondent replied to the Complainant´s cease and desist letter as follows:

"Dear Sirs,
hank you for your mail.
I should tell you that my pet is called 'canali' and I'm planning to build a blog for my pet.
But, if you want to purchase my domain name, please kindly make me an offer.
Thank you."

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The language of the registration agreement is Chinese so that the language of these proceedings should be Chinese pursuant to paragraph 11 of the Rules. The Complainant requested the Panel that the language of proceedings be English rather than Chinese, since the Respondent replied to the Complainant's cease and desist letter in fluent English, demonstrating that it clearly understands and speaks the English language.

The Respondent did not respond on this issue.

Paragraph 11(a) of the Rules stipulates that:

"unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

Paragraph 10(c) of the Rules provides that "The Panel shall ensure that the administrative proceeding takes place with due expedition."

In view of the finding of the Panel that the Respondent did reply to the Complainant's cease and desist letter in perfect English, thereby showing that he understands English very well and is capable of understanding the Complaint and responding to the Complaint, while the Complainant apparently does not speak Chinese, the Panel does not consider it prejudicial to the Respondent if English were adopted as the language of the proceeding. The proceeding would be unduly delayed if the Complaint and annexes thereto had to be translated into Chinese. In keeping with the Policy aim of facilitating a relatively time and cost-efficient procedure for the resolution of domain name disputes, the Panel accordingly determines that it would be appropriate for English to be the language of the proceeding.

The Panel is satisfied that all other procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. A top level domain is a prerequisite part of a domain name and, in principle, not relevant to establish if the disputed domain name is identical or confusingly similar to the Complainant’s trademark. In this matter the Panel finds that the disputed domain name is identical to the CANALI Trademark. And even if the gTLD “. group” – being a dictionary word of its own – would be considered, it is insignificant to the overall impression as an average Internet user could reasonably understand “group” to mean that the disputed domain name is part of a group of companies together with the Complainant.

2. The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

3. In the absence of a Response, the Panel infers that the Respondent had the CANALI Trademark in mind when registering the disputed domain name, which was therefore registered and is being (passively) used in bad faith, in order to prevent the Complainant from reflecting the CANALI Trademark in a corresponding domain name, which constitutes a clear act of typo squatting. The Panel further concurs with the Complainant’s allegation that the Respondent is engaged in a pattern of such conduct, given the evidence submitted that the Respondent registered many domain names in different new gTLD’s which include famous trademarks of different kind, apparently without the trademark owner’s consent. Many panels found that the Respondent violated the Policy and ordered the transfer of the relevant disputed domain names to the respective trademark

owners (e.g. E. Remy Martin & C° v. Liu Hong Bao, nashan, Na Shan, Yuqing, Naziyu, ZhangXin, WIPO Case No. D2016-1948; PVH Corp., Calvin Klein, Inc., Calvin Klein Trademark Trust, Tommy Hilfiger Licensing, LLC v. Zhao Zhong Xian, nashan, Liu Hong Bao, WIPO Case No. D2017-0465; Twin Set - Simona Barbieri S.P.A. v. nashan, WIPO Case No. D2017-1121; Natixis v. Nashan, WIPO Case No. D2017-1227; Pierre Balmain S.A. v. Nashan, WIPO Case No. D2017-1552; LES ECHOS SAS v. Nashan, WIPO Case No. D2017-1925; Novartis AG v. NaShan, WIPO Case No. D2017-2181).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **CANALI.GROUP**: Transferred

PANELLISTS

Name	**Alfred Meijboom**

DATE OF PANEL DECISION 2018-01-24

Publish the Decision