Decision for dispute CAC-UDRP-101824

Case number	CAC-UDRP-101824
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Domain names	STEFANORICCI.SITE

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Stefano Ricci S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Name	Nashan

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant relies on its portfolio of national and international trade mark registrations, which are, or include, the word elements “STEFANO RICCI.”

In particular, it relies on its International Trade Mark No. 407525 for “STEFANO RICCI,” in classes 18 and 25 registered on 27 May 1974. It also has registered rights in China under International Trade Mark No. 767523, for the word mark “STEFANO RICCI” in classes 03,09,14,18,21,25 from its registration on 17 September 2001 and No. 1192240 for “STEFANO RICCI” in classes 3,08,09,11,12,14,16,18,20,21,24,25,26,33,34,35,37,42 registered on 5 August 2013.

It further relies on its use in trade internationally and any rights arising from such use, including from its extensive domain name portfolio and it has secured clearing house registrations to protect those names and its rights.

FACTUAL BACKGROUND

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

The Complainant, STEFANO RICCI S.P.A. is a company with headquarters in Florence or Firenze, Italy. The founder, Mr.

Stefano Ricci, started the company in 1972. It produces classic, elegant, unique, hand-designed pieces for an international clientele. Its products are all made in Italy. The menswear collection consists of a wide range of menswear suits, dress shirts, jeans, polo shirts, shoes, casual wear and neckties. In addition, it also produces exclusive cufflinks and leather goods, such as belts, bags and wallets. The brand is expanding with its home collection, covering porcelain and crystal dinner services, silverware, furnishing accessories, luxury linens and leather goods.

In 2011, the company opened a new headquarters in Florence with more than 100 employees. Today, the brand is run by Mr. Stefano Ricci and his two sons, Niccolò and Filippo. They remain committed to bringing Italian fashion to the world, via their numerous boutiques internationally including in Beijing, Beverly Hills, Milan, Monte-Carlo, Moscow, New York, Paris, Seoul, Shanghai, Singapore and Doha.

It is one of the leading companies in the fashion and luxury Industry and has continuously and extensively used and advertised its trademarks and company name in multiple channels including the Internet, making the “STEFANO RICCI” denomination well-known in many parts of the world.

The disputed domain name, <stefanoricci.site>, was registered by the Respondent on 11 August 2017. On the same date, the disputed domain name was first offered for sale by the Respondent at “sedo.com” at a starting bid of USD $90. On 24 August 2017, the Complainant offered that sum to the Respondent and the Respondent thereafter made a counter offer, for $1,500 before it reduced its demand on 29 November 2017, when it made a final counter offer of $450.

Further, on 6 December 2017, in reply to the Complainant’s Cease and Desist letter, the Respondent offered to sell the disputed domain name to the Complainant on the Chinese platform “Aliyun” for 2.000 yuan (or approximately $300).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS

COMPLAINANT:

Rights

Pursuant to paragraph 3(b)(ix) of the Rules and paragraph 4 (a)(i) of the Policy, the Complainant says the disputed domain name, <stefanoricci.site> is identical or confusingly similar to the Complainant’s name and registered marks. In the case at issue, the second level domain name of the disputed domain name is exactly identical to the Complainant’s trademark. In particular, the addition of the generic top-level domain (gTLD) name ".site" is without legal significance in the analysis.

Legitimate Interests

The Respondent lacks rights or legitimate interests in the disputed domain names under the Policy at 4 (a) (ii) and the Rules at 3(b)(ix)(2)). The Respondent has never been authorized by the Complainant to register or use the disputed domain name and the Respondent is neither the Complainant’s representative nor an authorized licensee, nor a dealer or reseller. The Complainant has never had any business relationship with the Respondent. Pursuant to paragraph 4(c)(i) - (c)(iii) of the Policy, the Respondent does not have any rights or legitimate interests arising from a bona fide offering of goods or services or from legitimate non-commercial or fair use of the domain name. The mark is neither a generic English term, nor descriptive, and it is not a dictionary word, rather it is an inherently distinctive trade mark which solely refers to the Complainant and its goods and services.

The Complainant contends that the Respondent has registered the disputed domain name, identical to the Complainant’s trademark, to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, since the disputed domain name is not connected to any operative website.

Pursuant to paragraph 4(c)(ii) of the Policy, the Respondent has not been commonly known by the domain name, and holds no trade mark or service mark rights in the mark, based on the WHOIS information and there is no evidence of active use of the domain name to indicate that the Respondent might reasonably be considered to have rights or legitimate interests in respect of it.

Bad Faith

The disputed domain name was registered and is being used in bad faith according to paragraph 4(a)(iii) and 4(b) of the Policy and paragraph 3(b)(ix)(3) of the Rules. In particular, for the purposes of the Policy, the circumstances under paragraph 4(b)(i) and 4(b)(ii) of the Policy, if found by the Panel to be present, shall be evidence of both registration and use of a domain name in bad faith: (i) circumstances indicating that a party has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name. The Complainant relies on this and brings to the Panel's attention that the disputed domain name was immediately on registration, offered for sale by the Respondent on the platform "sedo.com", at a starting bid of USD $90. On 24 August 2017, the Complainant offered the Respondent this sum and the Respondent then made a counter offer for $1,500. Whereupon the Respondent reduced its demand until 29 November 2017, when it made a final counter offer of $450. Moreover, on 6 December 2017, in reply to the Complainant's Cease and Desist letter, it offered to sell the disputed domain name on the Chinese platform "Aliyun" for 2.000 yuan (approximately $300). The Complainant contends that such requests clearly exceed out-of-pocket costs as contemplated in the Policy and that the Respondent's behaviour clearly evidences the Respondent's bad faith, which fully meets the requirements of paragraph 4(b)(i) of the Policy in that the Respondent has registered the disputed domain name without any other real and eventual purpose than to sell, rent, or transfer it to its legitimate owner.

Pattern of conduct

The Complainant also says the Respondent has engaged in a pattern of blocking as bad faith under paragraph 4(b)(ii) of the Policy. The Complainant submits and has documented that the Respondent has registered more than four hundred domain names of which many were found to be identical to established trademark rights belonging to third parties, including these below as shown in the reverse WHOIS search based evidence submitted based on the same registration contact details as in this matter:
<armani.site> (Armani), <christiandior.site> (Christian Dior), <Ferragamo.site> (Ferragamo), <diadora.online> (Diadora), <desigual.top> (Desigual), <dolcegabbana.news> (Dolce&Gabbana), <kelloggs.top> (Kelloggs), <Abercrombie.site> (Abercrombie), <carrefour.men> (Carrefour), <caterpillar.press> (Caterpillar), <calvin-klein.website> (Calvin Klein), <damiani.site> (Damiani), <lancome.men> (Lancome), <louis-vuitton.xyz> (Louis Vuitton), <nestle.org.cn> (Nestlé), <rogervivier.news> (Roger Vivier), <seat.men > (Seat), <tommyhilfiger.pw> (Tommy Hilfiger), <zenith-watches.site > (Zenith), <patagonia.site> (Patagonia), <Peugeot.site> (Peugeot).

Similar conduct has been held to fall within the scope of paragraph 4(b)(ii) of the Policy in several cases, including Bellsouth Intellectual Property Corporation v. Simo Elbaz - WIPO Case No. D2003-0530 (bad faith has been found when the Respondent exhibited a "pattern of registering domain names that correspond closely to marks that are owned by others").

Thus, bad faith use and registration can be found in the present case pursuant to paragraphs 4(b)(i) and 4(b)(ii) of the Policy.

The Complainant brings to the Panel's attention that the Respondent, Mr. Nashan, is a professional cybersquatter who has already been found guilty of abusive registration in a similar case, where he had registered - among others - the following domain name <.club> (where the second-level domain is a registered trademark - the Chinese transliteration of "REMY MARTIN"). At the time – as in the present case – the domain name .club was not connected to any active website and the domain name at issue was eventually transferred to Remy Martin & C. by the appointed Administrative Panel, see E. Remy Martin & C. v. Liu Hong Bao, nashan, Na Shan, Yuqing, Naziyu, ZhangXin - WIPO Case No. D2016-1948 (the Respondent - in response to the Complainant's cease and desist letter - had offered for sale, to the trademark owner, one of the (at the time) disputed domain names [<louisxiii.link>] for USD $1,000).

Such conduct clearly demonstrates the real purpose of the Respondent, which registered - and it is still registering - hundreds of clearly infringing domain names with the sole aim to prevent the legitimate trademark owners from reflecting their marks in corresponding domain names and consequently resell them to the related trademark owners at a substantially higher price than the out-of-pocket costs.

Previous Panels have found "[T]he Policy expressly recognizes that other circumstances can be evidence that a domain name was registered and is being used in bad faith". E.g., CBS Broadcasting, Inc. v. LA-Twilight-Zone, WIPO Case No. D2000-0397 and Do The Hustle, LLC v. Tropic Web - WIPO Case No. D2000-0624 ("[T]he examples [of bad faith] in 4(b) are intended to be illustrative, rather than exclusive").

Further, in the light of all of the above, the fact that the domain name is not connected to an active or operative website, does not prevent a finding of bad faith. Indeed, as mentioned both in the WIPO Overview 3.0 at section 3.3, citing Telstra Corporation Limited v. Nuclear Marshmallows, Case No. D2000-0003, at paragraphs 7.8 and 7.9 (bad faith did not require positive action but could be found from all the circumstances of the case where the case concerned the passive holding of a domain name). See also "Cornell Trading, Inc. v. Web-Interactive.com Inc., WIPO Case No. D2000-0887 (the "Respondent's passive holding of the domain name, together with the similar holding of a large number of other domain names incorporating the trade-marks of others constitutes evidence of use in bad faith") and see Yahoo! Inc. and Geo Cities v. Cupcakes, Cupcake City, Cupcake Confidential, Cupcake-Party, Cupcake Parade, and John Zuccarini, WIPO Case No. D2000-0777 ("bad faith can be found where there is no plausible explanation for the registration of a domain name other than to trade on the goodwill of the Complainant").

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

Procedure

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision. The Respondent's contact details were verified and updated based on the most accurate information available to the Complainant based on information provided in another CAC proceeding. CAC also confirmed that the service by email to 6360665@qq.com was confirmed as delivered.

The Panel here granted the request of the Complainant that the language of the proceedings be in English despite paragraph 11(a) of the Rules which provides that unless otherwise agreed the language of the administrative proceeding shall be the language of the Registration Agreement which in this case is in Chinese. The Complainant relied on the Respondent's reply to its Cease and Desist in fluent English, as demonstrating that it clearly understands and speaks the English language and weighted against the prejudice to the Complainant if forced to participate in Chinese, see Groupe Auchan v. xmxzl, WIPO Case No. DCC2006-0004 ("It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case").

PRINCIPAL REASONS FOR THE DECISION

The Panel finds the Complainant has registered rights in the identical name and mark and that mark is a well-known mark in the luxury product market.

The applicable Top Level Domain ("TLD"), here .site, is disregarded under the first element's identity/similarity test. The leading authority is WIPO Case No. D2000-0429 re rollerblade.net. While it may be relevant in some cases to panel assessment of the second and third elements, this is not such case. Therefore, the rule is, identical means identical, see WIPO Case No. D2012-1862 electrolux-vacuum.net.

The Complainant has shown that none of the grounds under paragraph 4 (c) of the Policy are prima facie applicable and so has discharged its burden under paragraph 4(a) of the Policy. The evidential burden then shifts to the Respondent (see WIPO Case D2004-0110 re belupo.com). The Respondent has not come forward, either to explain its rights or interests in the name and mark and why it has selected the disputed domain name, or at all. That does not mean there is a default decision but none of the Policy grounds are relevant on the face of the matter as far as the Panel is concerned – noting that there is no use here at all and only an inactive registration or passive holding. That alone is not determinative and all circumstances are relevant. Here the disputed domain name was not used as such but was immediately parked and offered for sale, adding that passive holding may be relevant for the purposes of the Policy (see Telstra WIPO Case D2000 -0003, Telstra.org). While the issue is highly fact-sensitive, the registration of a domain name identical or similar to a well-known or famous mark without legitimate right or interest in the name creates a strong presumption of bad faith (see Societe Air France v ibiz hosting, CAC 46465, airfranceonline.eu).

Further, while an offer for sale is not necessarily, without more, bad faith; here we do have very clear evidence of an offer from the Respondent, to sell the disputed domain name to the Complainant for a sum far in excess of registration costs. The offer was first to the world on sedo.com and then specifically to the Complainant. The sedo offer was unsolicited and is good evidence (see WIPO case No. D2005-1109, marthastewartfoundation.com; "The Respondent's unsolicited offer to sell these domains to the Complainant on the very day the Respondent registered the marks… is compelling evidence of ..bad faith."). This evidence of offer squarely satisfies the most straightforward ground of paragraph 4(b) of the Policy as evidence of a respondent's bad faith. In these circumstances, and in this case, the Policy is clear and it is appropriate to find the Respondent registered the name and mark in bad faith. We therefore have no need to go on to look at the alternative ground of a pattern of abusive or bad faith registration. The evidence on that point however looks persuasive.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **STEFANORICCI.SITE**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2018-02-02

Publish the Decision