

## Decision for dispute CAC-UDRP-103520

Case number CAC-UDRP-103520

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Domain names **buttero.com**

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### Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

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### Complainant

Organization **CALZATURIFICIO BUTTERO SRL**

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### Complainant representative

Organization **STUDIO PARINI ANDREOLINI CUPIDO**

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### Respondent

Organization **YANG CHAO WEI**

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#### 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.

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#### IDENTIFICATION OF RIGHTS

The Complainant is the owner of the BUTTERO trademark since 1990, including but not limited to the followings:

- Italian trademark BUTTERO 1368453, registered since 1990;
- Italian trademark BUTTERO 1558000, registered since 2013;
- European trademark BUTTERO 1026876, registered since 2009;
- European trademark BUTTERO 5675822, registered since 2008;
- International trademark (designating Singapore) BUTTERO 838550, registered since 2004;
- International trademark (designating Japan, Norway, China and Switzerland, Mexico and USA) BUTTERO 878352, registered since 2005;
- International trademark (designating European Union and Japan) BUTTERO 1026876, registered since 2009;
- International trademark (designating Korea) BUTTERO 1173141, registered since 2013;
- US trademark BUTTERO 4397759, registered since 2013;
- Hong Kong trademark BUTTERO 199604619, registered since 1996;
- Korean trademark BUTTERO 401081178, registered since 2015.

Furthermore, the Complainant is also the owner of various domain names including <buttero.it> which was created on February 9 1999 and some others as below:

-<buttero.jp>;  
-<buttero.asia>;  
-<buttero.net>;  
-<buttero.eu>;  
-<buttero.cn>.

The Complainant also highlights that BUTTERO is also part of its company name - Calzaturificio Buttero Srl since 1984.

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#### FACTUAL BACKGROUND

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

The Complainant is an Italian company founded in 1984 by Mauro Sani and run by the Sani family who manufactures and markets artisanal shoes throughout the world. The company has operations worldwide including in China.

The Complainant is the owner of the BUTTERO trademark since 1990.

The Registration Date of the disputed domain name is July 29, 2003.

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#### PARTIES CONTENTIONS

#### PARTIES' CONTENTIONS:

##### COMPLAINANT:

The Complainant is the owner of the BUTTERO trademark since 1990 and has global operation including China.

The disputed domain name <buttero.com> has been created on July 29, 2003 and it had 35 changes on 35 unique IP addresses and 3 registrar with 3 drops. The disputed domain name is currently not being used for an active website and it appears that it has never been used for an active website since it was registered.

The Complainant throughout its Chinese distributor first filled in a purchase form in order to buy the domain name. The Complainant has been contacted by Mr. Leo of eName, the Registrar of the disputed domain name, who asked speculatively RMB 200,000 (about EUR 25,000 Euro) in order to transfer the disputed domain name. Therefore, the Complainant's lawyers sent a C&D letter to the Registrar offering EUR 8,000 in order to buy the domain name and warning that "should your client fail to accept our proposal, we have already been appointed to file a complaint before ICANN to ask the [sic] riassignment".

The Complainant is not aware of the identity of the Registrant. On WHOIS, it is only possible to find the name and the email address of the Registrar. Mr. Leo of eName answered in English to us declaring that his client has not accepted our proposal and refusing to provide us with the contact details of the Registrant.

The disputed domain name is identical to Complainant's BUTTERO trademarks, the BUTTERO domain names and the BUTTERO company name.

The disputed domain name <buttero.com> is currently not being used for an active website and it appears that it has never being used for an active website since it was registered 18 years ago. The Respondent is operating under a privacy shield. The Respondent has not by virtue of the content of a website nor by its use of the dispute domain name shown that it will be used in connection with good faith offering of goods or services.

The disputed domain name does not resolve to an active website. It is proved that Mr. Leo of eName (in which Mr. Leo

declared that he is from eName which is the Registrar) asked on behalf of his client RMB 200,000 RMB (about EUR 25,000) to sell the disputed domain name to the Complainant. Since the disputed domain name is not active and it appears that it has never been used for an active website since it was registered 18 years ago and given that we filed a proof of the money request made by the Registrar on behalf of the Respondent, it is evident that selling and speculation were the main purposes of the Respondent. Therefore, the <buttero.com> domain name has been registered and it is used in bad faith.

#### RESPONDENT:

"Trademark is different from the disputed domain name, which means trademark rights could not be used in domain name area. According to the trademark laws, it did not forbid people to use trademark as a domain name, and the trademark laws do not allow people to use others' trademark for infringement on the owner's benefit. Registering <buttero.com> could not prove that it is an infringement on owners' interests, and also the trademark is a normal trademark rather than an internationally famous trademark.

Respondent got the legal domain name basis on the 'the first apply, the first register' rule from ICANN, and controversial person did not argue for the using problem between 2003 and 2021 January.

The disputed domain name has not been used on vicious purpose and has not damaged the Complainant's analysis and url transmit. Also, this domain name has not been set up with any website.

The Complainant has tried to ask the domain name registration service provider to buy it from us at RMB 60,000 Almost USD 9,200, and they thought the price we offered, which is RMB 120,000 Almost USD 18,400, is much higher than they could accept, so they tried to do the malicious arbitration in order to 'rob' the disputed domain name. These case is the same as <vallila.com> which is a typical Reverse Domain Name Hijacking case. We have the evidence of voice recording from the Complainant trying to buy the disputed domain name from us, and the mobile phone number is [redacted]."

#### 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).

First, the Complainant claims rights in the BUTTERO mark through its trademark registrations. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12).

Second, the Complainant claims that the prominent part of the disputed domain name is identical to its trademark registrations and domain name.

The Panel accepts that the prominent part of the disputed domain name is identical to Complainant's trademark BUTTERO, and the ".com" generic top-level domain ("gTLD") is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy. In addition, the Panel wants to highlight one point is that under the paragraph 4(a)(i) of the Policy, the comparison between the disputed domain name and Complainant's valid trademark registrations is an objective test which means whether a reasonable man would agree the disputed domain name is identical or confusingly similar to Complainant's trademark. The registration date of the trademarks and disputed domain name, jurisdiction of the trademark registrations and whether the trademark is an internationally famous trademark are all irrelevant to the comparison under the paragraph 4(a)(i) of the Policy, see paragraph 1.1.2 of the WIPO Overview 3.0 ("Noting in particular the global nature of the Internet and Domain Name System, the jurisdiction(s) where the trademark is valid is not considered relevant to panel assessment under the first element. Also, the goods and/or services for which the mark is registered or used in commerce, the filing/priority date, date of registration, and date of claimed first use, are not considered relevant to the first element test. These factors may however bear on a panel's further substantive determination under the second and third elements.").

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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#### 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant contends that the Respondent is passively holding the disputed domain name and the disputed domain name has not been used for 18 years. The Respondent did not make any use of the disputed domain name since the registration, and it was confirmed by the Respondent that it has no demonstrable plan to use the disputed domain names. It demonstrates a lack of legitimate interests in respect of the disputed domain name. In addition, the Respondent employs a privacy service to hide its identity.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name as it is commonly agreed that passive holding does not constitute a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain names, see *ARCELORMITTAL (SA) v. Milen Radumilo*, 102379 (CAC 2019-04-18). The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name.

The Respondent rebuts that it got the disputed domain name on first come first serve basis and the Complainant had not raised any concern between 2003 and January 2021. Furthermore, the disputed domain name has not been used on vicious purpose or damaging Complainant's website.

The Panel is of the view that successfully registering a domain name does not automatically claims rights or legitimate interests to a domain name. Instead, paragraph 4(c) of the Rules listed some common circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate Respondent's rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or 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; or
- (ii) 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; or
- (iii) you are making a legitimate non-commercial 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.

In the present case, Respondent neither has any actual or demonstrable preparations to use the disputed domain name, nor has been commonly known by the disputed domain name, nor is making a legitimate non-commercial or fair use of the disputed domain name. Past panels have also declined to specifically adopt the doctrine of laches or its equivalent in UDRP cases, see paragraph 4.17 of the WIPO Overview 3.0 ("Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits.").

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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#### 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).

The Complainant reiterates that the disputed domain name has not been resolved to an active website since its registration 18 years ago. In addition, the Complainant claims that the Respondent set the asking price for the disputed domain name via the eName, the Registrar, at RMB 200,000 (approximately equal to Eur 25,000 or USA 18,400) to sell the disputed domain name. Both actions evince that selling and speculation were the main purpose of the Respondent.

The Respondent rebuts that the Complainant reached out to eName, the Registrar, to buy the domain name at RMB 60,000 (approximately equal to EUR 12,500 or USD 9,200) and said the asking price set by the Respondent in advance is much higher than they could accept, so the Complainant tried to "rob" the disputed domain name via malicious arbitration. The case is the same as "vallilia.com" which is typical Reverse Domain name Hijacking case. The Respondent has further provided a voice recording some text messages between itself and eName.

(Considering Reverse Domain Name Hijacking is a separate issue from this section, its findings is included in a separate section under Procedural Factors.)

Pursuant to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a disputed domain name in bad faith:

- (i) circumstances indicating that you have registered or you have 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 that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

According to the evidence presented by both parties, it is undisputed that the Complainant is the party who showed the willingness to acquire the disputed domain name but the first offer was made by the Respondent via the Registrar. If the disputed domain name was not registered primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, the Respondent can reject the invitation from the Complainant. Instead, the Respondent set an asking price which exceeds the documented out-of-pocket costs related to the disputed domain name. Furthermore, the Panel agrees with the Complainant that the Respondent registered the disputed domain name 13 years after its first trademark registration and the it has been holding the disputed domain name for 18 years, which show that the Respondent's main purpose for registering and keeping the disputed domain name is solely for commercial gain. The Respondent also ignored Complainant's Cease and Desist letter and declined to resolve the disputed in an amicable way. From the Annexes provided by the Respondent, the Panel further finds from the conversation between the Respondent and the Registrar via an instant messenger in Chinese that the Respondent told the Registrar "It is an international brand, the price cannot be low." and "If the budget is not high then just leave it." It obviously shows that the Respondent clearly know BUTTERO is an international brand and it aims to sell it to the Complainant or other third party at a high price which obviously constitutes bad faith under paragraph 4(b)(1) of the Policy.

On this basis, the Panel is satisfied both the registration and use of the disputed domain name are in bad faith.

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

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#### PROCEDURAL FACTORS

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.

#### PRELIMINARY FINDINGS - LANGUAGE OF PROCEEDING:

The Panel notes that the language of the Registration Agreement is Chinese as confirmed by the Registrar, eName. Both the official Complaint and Response were submitted in English. Pursuant to paragraph 11 of the Rules, 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.

The Complainant requests to use English as the language of proceeding, with the arguments that the Complainant is an Italian company who does not know Chinese. English is not the native language of the Complainant or its representatives, and the Respondent has responded to Complainant's C&D letter in English. Considering English is the most common language and it does not give advantage to either party, English seems to be a fair language in this proceeding.

In addition, the Complainant also states that "buttero" has no meaning in Chinese.

On February 5, 2021, the Respondent submitted a request to CAC to use Chinese as the language of proceeding. On February 10, 2021, the Respondent submitted the official Response in English without any request to use Chinese as the language of proceeding.

The Panel is bilingual and is well equipped to deal with the proceeding in both Chinese and English. Having considered the circumstances, Panel believes that it would be fair to both parties to use English as the language of proceeding and it can also uphold the principle of UDRP being a swift dispute resolution process. On this basis, the Panel determines that the language requirement has been satisfied through the English language Complaint and Response, and decides that the language of proceeding to be English.

#### REVERSE DOMAIN NAME HIJACKING

Paragraph 15(e) of the Rules provides that "if the Panel concludes that the dispute is not within the scope of Paragraph 4(a) of the Policy, it shall so state. If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

In the present case, the Respondent cites the previous case related to the domain name <vallila.com> and claims that both the present case and the <villila.com> case are typical Reverse Domain Name Hijacking cases. The Panel notes that in the <vallila.com> case, the domain name <vallila.com> was registered 4 years before the Complainant of that case applied to register its first trademark. However, in the present case, the Complainant registered its first trademark since 1990 which is 13 years earlier than the registration of the disputed domain name. On this basis, the Panel has found no similarity between the 2 cases and no evidence that the Complaint was brought in bad faith.

For the foregoing reasons, the Panel does not find that the Complainant attempted Reverse Domain Name Hijacking within the meaning of the Rules.

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#### PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

**Accepted**

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

1. **BUTTERO.COM**: Transferred

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## **PANELLISTS**

Name	<b>Mr Paddy TAM</b>
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DATE OF PANEL DECISION **2021-02-23**

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**Publish the Decision**

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