

Decision for dispute CAC-UDRP-104674

Case number	CAC-UDRP-104674
Time of filing	2022-06-27 09:36:53
Domain names	diadoraoutletuk.com, diadorahrvatska.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Diadora S.p.A.
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Complainant representative

Organization	Convey srl
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Respondent

Name	J Puplichuisen
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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.

IDENTIFICATION OF RIGHTS

The Complainant is Diadora S.p.A., a legal corporate entity registered in Italy and owner of the trademark DIADORA with several international and national trademark registrations worldwide, including the following :

- INT. TM n° 682095A of July 31, 1997, in classes 3, 9, 12, 14, 16, 18, 25, 28; annex 4.1
- INT. TM n° 682095 of July 31, 1997, in classes 3, 9, 12, 14, 16, 18, 25, 28; annex 4.2
- European Union TM. n° 000339093 of January 07, 1999, in classes 18, 22 and 25; annex 4.3
- Italian TM n° 0001297135 of May 31, 2010 in class 18 , 25, 28 ; annex 4.4
- U.S.A. TM n° 2282558 of October 5, 1999 in classes 18 and 25; annex 4.5

FACTUAL BACKGROUND

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

The Complainant is an athletic footwear and apparel manufacturer and was founded in 1948 by Marcello Danieli that called his company "Diadora" a name suggested by a friend, in Greek, "dia dora" means "by means of gifts".

The Domain Names were registered by the Respondent, without authorization of Complainant, on August 30, 2021 and on July 2, 2021 -and have been redirecting to a website offering for sale Complainant's products.

As soon as the Complainant became aware of the Respondent's registration and use of the Domain Names, it instructed its representative to address to the owner of the Domain Names a cease and desist letter in order to notify him of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer, of the Domain Names to the Complainant.

Therefore, cease and desist letters was sent to Respondent via the Registrant contact online form indicated in the WHOIS records, but the Respondent did not deem appropriate to answer.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).

The disputed Domain Names incorporate the whole of the Complainant's trademark DIADORA and the fact that they include a non-distinctive element such as a generic commercial term, i.e. "outlet", geographical terms (i.e. UK for United Kingdom and "hrvatska" for Croatia) and the generic Top-Level Domain .com do not affect the confusing similarity.

It is a well-established principle that domain names that wholly incorporate trademarks, in particular one as famous as DIADORA, are found to be confusingly similar for the purposes of the Policy, despite the fact that the disputed Domain Names may also contain descriptive or generic terms. See, among the decisions addressing situations where generic terms are used in combination with trademarks, Wal-Mart Stores, Inc. v. Henry Chan, WIPO Case No. D2004-0056 ("chase", "girlsof", "jobsat", "sams", "application", "blackfriday", "blitz", "books", "career(s)", "check", "flw", "foundation", "games", "mart", "photostudio", "pictures", "portrait", "portraitstudio(s)", "registry", "retailink" and "wire" added to WALMART mark).

It should be also noted that the geographical terms in the disputed Domain Names, while cannot be considered enough to distinguish Respondent's Domain Names from the Complainant's mark, are all the more apt to induce confusion among Internet users. DIADORA is, in fact, an internationally well-known mark in the sector of sports, and the Complainant's products are sold worldwide.

The combination of the trademark DIADORA with generic terms could suggest improperly to consumers that the Domain Names and corresponding web sites might be directly controlled or authorized by the Complainant. As indicated in Annexes 5, the Complainant itself operates online sale of its products.

Furthermore, the top level ".com" is merely instrumental to the use in Internet - as found in The Forward Association, Inc., v. Enterprises Unlimited (NAF case FA0008000095491, October 3, 2000) and numerous others - and not able to affect the confusing similarity of the Domain Names to the Complainant's trademark.

In light of the above, the disputed Domain Names are certainly confusingly similar to the prior registered trademarks in which the Complainant has rights pursuant to 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).

According to paragraph 4(a) of the Policy, the burden of proving the absence of the Respondent's rights or legitimate interests in respect of the Domain Names lies with the Complainant. It is nevertheless a well-settled principle that satisfying this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive. Accordingly, it is sufficient for the Complainant to produce prima facie evidence in order to shift the burden of production to the Respondent. See, e.g., Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-

0270.

As a preliminary note, along the lines set forth in *Pharmacia & Upjohn Company v. Moreonline*, WIPO Case No. D2000-0134 and *National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net*, WIPO Case No. D2000-0118, the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

The Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to the registration and use of the Domain Names.

Upon information and belief, the Respondent is not commonly known by the Domain Names as individual, business or other organization and their family names do not correspond to DIADORA or the Domain Names.

The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the Domain Names in connection with a bona fide offering of goods or services before any notice of the dispute.

As better detailed in the paragraphs above and highlighted in the screenshots provided at Annexes 3 and 8, the disputed Domain Names have been redirected by the Respondent to websites, with similar layouts, where the Complainant's trademarks DIADORA are published and prima facie counterfeit DIADORA branded products are offered for sale. As highlighted in the Annexes 3 and 8, in light of the following circumstances is evident that the goods offered for sale are counterfeit:

- the goods are sold disproportionately below market value, half the Complainant's prices;
- the Respondent has concealed his identity both on the whois and on the websites corresponding to the Domain Names, where there are not emails and/or physical addresses to contact the Respondent but only online forms as evidenced in the Annex 3.

In light of the abusive sale of counterfeit goods, the Oki Data Test - dedicated to resellers, distributors or service providers using a domain name containing the complainant's trademark to undertake sales related to the complainant's goods - is inapplicable to this case because the Respondent's conduct is not a legitimate activity, however, should you examine the corresponding websites, there is no evident disclaimer as to the Respondent's lack of relationship with the Complainant and the Respondent has registered two domain names confusingly similar to the Complainant's trademark cornering the market.

It is evident that the Respondent's use cannot be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed Domain Names. Such wilful conduct clearly demonstrates, to the contrary, that Respondent did not intend to use the disputed Domain Names in connection with any legitimate purpose.

Furthermore, such use of the Domain Names cannot be considered a legitimate non-commercial or fair use without intent for commercial gain, because the Respondent is undoubtedly attempting to gain profit from the sales of prima facie counterfeit products and it is clear that the Respondent's intention is to benefit from the Complainant's trademarks' reputation to disrupt the Complainant's business and to illegitimately trade on the Complainant's fame for commercial gain. In the Case No. D2015-1466 WIPO Prada S.A. v. Chen Mingjie, where the Respondent was using its web site to offer for sale prima facie counterfeit PRADA products at prices significantly lower than those of the original products and no disclaimer had been published, the Panel found: "Given the high probability that the goods on offer through the disputed domain name are counterfeit, and the lack of disclosure on the site as to the Respondent's lack of relationship to the Complainant, there is also no evidence of a bona fide offering of goods or services".

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).

As to the assessment of the Respondent's bad faith at the time of registration, in light of the registration and intensive use of the trademark DIADORA since 1948, the advertising and sales of the Complainant's products worldwide, the Respondent could not have possibly ignored the existence of the Complainant's trademark, confusingly similar to the disputed Domain Names.

The aforesaid trademark of the Complainant enjoys worldwide reputation in the sector of manufacturing footwear. The disputed Domain Names were registered on August 30, 2021 and on July 2, 2021, years after the Complainant obtained its trademark registrations.

Furthermore, the actual knowledge of DIADORA trademark by Respondent at the time of the registration of the Domain Names is demonstrated by the facts that the Respondent offers for sale replicas of Complainant's goods and that the Respondent also reproduces the trademarks DIADORA on the web sites corresponding to the Domain Names.

By virtue of its extensive worldwide use, the Complainant's trademark DIADORA has become a well-known trademark in the sector of manufacturing footwear.

Considering the trademark's distinctiveness and well-known character, it is inconceivable that the Respondent was unaware of the existence of the Complainant's registered trademark at the time of the registration of the Domain Names, with which it is confusingly similar. As noted indeed in the CAC decision No. 102087 DIADORA SPORT S.R.L. v. Gillian Grocott: "The Complainant's trademarks enjoy (at least in relevant business and customer circles) well-known status and high level of notoriety. As a result, there is only a remote chance that the Respondent has registered such complex domain name just by a chance and without having a knowledge about the existence of the Complainant's rights and business".

Therefore, it is clear that the Respondent was well aware of the trademark DIADORA and has registered the disputed Domain Names with the intention to refer to the Complainant and to its trademarks.

With reference to the above, the panel highlights that it has been stated in various decisions that the registration of a domain name with the knowledge of the Complainant's trademark is an evidence of bad faith, i.a. in *Belstaff S.R.L. v. jiangzheng ying* Case No. D2012-0793, "the Panel notices that the word "belstaff" is distinctive and the Complainant had expended substantial efforts to create and maintain the reputation of the mark BELSTAFF. Use of the Domain Names by the Respondent took place only long after the trademark BELSTAFF had become well known in the relevant public sector. Therefore, the Respondent should have been aware of the mark BELSTAFF when it applied to register the Domain Names. In this Panel's view, the Respondent's reproduction of the Complainant's trademark BELSTAFF (both word and device trademarks) on the Websites, as well as its offering of purported Belstaff products is sufficient to show that it knew of the BELSTAFF mark when registering the Domain Names. Incorporation of the BELSTAFF mark in the Domain Names without any reasonable justification is sufficient evidence of bad faith by the Respondent".

Indeed, the fact that replicas of DIADORA products are being offered for sale on the web sites corresponding to the Domain Names indicates that the Respondent was fully aware of the Complainant's mark's reputation and association with the Complainant and that his purpose in registering the Domain Names, which incorporates the Complainant's trademark DIADORA, was solely intended to capitalize on the reputation of Complainant's mark by diverting Internet users seeking products under the DIADORA mark to its own commercial web sites .

As highlighted in *Swarovski Aktiengesellschaft v. Jun Qiao*, WIPO Case No. D2013-1617, "the fact that purported Swarovski goods were offered at the relevant website indicates that the Respondent was fully aware of the Swarovski mark's distinct reputation and association with the Complainant. There is no reason to choose such a distinctive mark, and also to include other terms in a domain name that are suggestive of the very business of the Complainant, other than a bad faith attempt to ride on the coattails of the trademark owner".

The use of the disputed Domain Names in connection with commercial web sites where the Complainant's trademark is misappropriated and prima facie counterfeit DIADORA branded products are offered for sale - see Annexes 3 and 8 - clearly indicates that the Respondents' purpose in registering the Domain Names was to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking DIADORA products to their websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites, according to paragraph 4(b) (iv) of the Policy.

As anticipated in the paragraph above, the circumstances that the goods are sold disproportionately below market value (roughly half the Complainant's prices, see the Annexes 3 and 8) and that the Respondent's identity both on the whois and on the websites corresponding to the Domain Names appear to be concealed (Annexes 2 and 3), means that the goods are prima facie counterfeit.

Such use of the Domain Names to promote and sell prima facie counterfeit products is also apt to disrupt Complainant's business. See along these lines *Guccio Gucci S.p.A. v. zhang shao hua*, WIPO Case No. D2010-0332: "The Respondent's website contains the Complainant's logo which is displayed prominently together and images used in its advertising campaigns with replica Gucci handbags being offered alongside the products of the Complainant's competitors. The Respondent has registered the disputed domain name and allowed the operator of the site, to which the disputed domain name resolves, to use it primarily for offering goods to Internet users in a way which disrupts the business of the Complainant. On the basis of the evidence adduced, the Panel finds that the presumption under paragraph 4(b)(iii) of the Policy has been invoked".

Moreover, on the web sites corresponding to the Domain Names there is no disclaimer informing the users as to the Respondents' lack of relationship with the Complainant thus, the websites create the impression that they are authorized by the Complainant.

As anticipated, in light of the low prices, the misappropriation of the Complainant's trademarks and the concealment of the Respondent's identity, the goods offered for sale on the web sites corresponding to the Domain Names are prima facie counterfeit and such conduct constitutes a further evidence of bad faith registration and use of the Domain Names, as stated in several decisions, inter alia *Karen Millen Fashions Limited v. Lily Rose* WIPO Case No. D2012-0428 "the Panel finds Respondent's conduct in registering the disputed domain name and offering for sale counterfeit branded merchandise via Respondent's Website, all without the authorization, approval, or license of the Complainant, amounts to bad faith registration and use under paragraph 4(b)(iv) of the Policy. The Panel therefore finds the requisite element of bad faith has been satisfied, under paragraph 4(b)(iv) of the Policy."

In registering two Domain Names, confusingly similar to the trademark DIADORA, the Respondent has been engaged in a pattern of conduct preventing the Complainant from reflecting the mark in corresponding domain names, as indicated also in the WIPO decision Case No. D2013-2034 *Salvatore Ferragamo S.p.A v. Ying Chou*: "A "pattern of conduct" as required in paragraph 4(b)(ii) of the Policy typically involves multiple domain names directed against multiple complainants, but may also involve multiple domain names directed against a single complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 3.3). Here the latter applies. The fact of registering four domain names that incorporate the Complainant's trademark represents, in the Panel's assessment, a pattern of conduct directed against the Complainant, stopping it from reflecting its trademark in the disputed domain names. The Panel concludes that paragraph 4(b)(ii) of the Policy is made out".

As an additional circumstance demonstrating bad faith, prior Panels have also held that a failure to respond to a cease and desist letter can be evidence of bad faith. See, e.g., *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. D2007-0062: "such bad faith is compounded when the domain name owner or its duly authorized privacy service, upon receipt of notice that the domain name is identical to a registered trademark, refuses to respond or even to disclose the domain name owner's identity to the trademark owner... Such conduct is not consistent with what one reasonably would expect from a good faith registrant accused of cybersquatting".

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.

The Domain Names and the named Respondents can be consolidated in a single UDRP proceeding.

As found in many Panel decisions, the consolidation of multiple registrants as respondents in a single administrative proceeding may in certain circumstances be appropriate under paragraph 3(c) or 10(e) of the Rules, provided that the

Complainant can demonstrate that the Domain Names or the web sites to whom they resolve are subject to common control, and the panel, having regard to all of the relevant circumstances, determines that consolidation would be procedurally efficient and fair and equitable to all parties. Once a case is admitted on a prima facie basis, the respondent has the opportunity to make its submissions on the validity of the consolidation together with its substantive arguments. In the event that the panel makes a finding that the complaint has not satisfied the requisite criteria, the complainant is not precluded from filing the complaint against the individual named respondents. See WIPO Case No. D2010-0281 Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons.

The consensus view of UDRP panels is expressed in WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.11.2: "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario."

When assessing whether multiple domain names can be found under common control, the following circumstances have been evaluated, amongst others, in prior UDRP decisions:

A. Circumstances indicating that different registrants were alter egos of the same beneficial holder (See *Backstreet Productions, Inc. v. John Zuccarini, CupcakeParty, Cupcake Real Video, Cupcake-Show and Cupcakes-First Patrol*, WIPO Case No. D2001-0654), as may be:

A.1. Cases where respondents had common administrative contact or technical contact, or other instances of commonality in the registration information, such as the same postal address or email address (See *ISL Marketing AG, and The Federation Internationale de Football Association v. J.Y. Chung, Worldcup2002.com, W Co., and Worldcup 2002*, WIPO Case No. D2000-0034, in which the disputed domain names had the same administrative contact; *Caesars World, Inc. v. Starnet Communications and Atlantic West Gaming Entertainment, Ltd.*, WIPO Case No. D2002-0066, decision rendered against multiple respondents where the same person was indicated as the administrative contact, billing contact; and *Adobe Systems Incorporated v. Domain OZ*, WIPO Case No. D2000-0057, decision rendered against multiple respondents where respondents shared the same post office box number and email address in their registration information) or

A.2. Circumstances indicating that a single person or entity had registered multiple domain names using fictitious names. See *Guccio Gucci S.p.A. v. Huangwensheng, Shirley, wangliang, xiaomeng xiexun, jiangxiuchun*, WIPO Case No. D2012-0342; *Yahoo!, Inc v. Somsak Sooksripanich and Others*, WIPO Case No. D2000-1461 (decision rendered against multiple Respondents which seemed to be fronts for the real respondent); *Yahoo! Inc. v. Yahoosexy.com, Yahoo-sexy.com, Yahoosexy.net, Yahoousexy.com and Benjamin Benhamou*, WIPO Case No. D2001-1188 (domain names <yahoosexy.com>, <yahoo-sexy.com>, <yahoosexy.net> and <yahoo-sexy.net>); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. D2001-1070; *General Electric Company v. Marketing Total S.A.*, WIPO Case No. D2007-1834.

B. Substantial commonalities in the web sites to whom the disputed domain names resolved and the use of the same domain name servers. See, i.a., *Nintendo of America Inc. v. Administrator Lunarpages, Alan Smith, Neoconsoles Inc., Liu Hai, Linda Wong, and Wong, supra, Apple Inc. v. Fred Bergstrom, Lotta Carlsson, Georges Chaloux and Marina Bianchi*, WIPO Case No. D2011-1388, *Sharman License Holdings, Limited v. Dustin Dorrance/Dave Shullick/Euclid Investments*, WIPO Case No. D2004-0659; and *Balenciaga v. Ni Hao, Shen Dan, Wu Dan, Zhu Qin, Yan Wei*, WIPO Case No. D2011-1541.

C. The incorporation of complainants' trademark in its entirety together with a descriptive term. See *Ecco Sko A/S v. tian yu, Karej, Wuxiaoman, xiao tian*, WIPO Case No. D2011-1606 (incorporation of the complainant's trade mark ECCO in its entirety together with the descriptive term, "shoe(s)" being indicative that the domain names <eccoshoeuk.net> and <eccoshoeuk.com> were subject to common control by the same person or company), *Camper, S.L. v. zhengmiansen, jolin kelly, zy*, WIPO Case No. D2011-1750 and *Balenciaga v. Ni Hao, Shen Dan, Wu Dan, Zhu Qin, Yan Wei, supra*.

In the case at hand the panel believes that the Domain Names, which all incorporate the trademark DIADORA in their entirety, are under the control of a single individual or entity or, at least, reflective of a group of individuals acting in concert.

It should be noted that the domain names share the following similarities

- same extension of the domain names .com;
- same Registrar: Hosting Concepts B.V. d/b/a Registrar.eu;
- same Hosting Provider: GLOBAL COLOCATION LIMITED;
- same Name Servers: NS1.OPENPROVIDER.NL - NS2.OPENPROVIDER.BE - NS3.OPENPROVIDER.EU;
- same Registrant Country: DE;
- same favicon of the websites;
- same footer of the websites;
- same lay-out of the websites;
- same products offered for sale;
- presence of geographical terms associated to the Complainant's trademark in the domain names.

PRINCIPAL REASONS FOR THE DECISION

The Respondent was well aware of the trademark DIADORA and has registered the disputed Domain Names with the intention to refer to the Complainant and to its trademarks. Furthermore, bad faith is compounded when the domain name owner upon receipt of notice that the domain name is identical to a registered trademark, refuses to respond or even to disclose the domain name owner's identity to the trademark owner.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DIADORAOUTLETUK.COM**: Transferred
2. **DIADORAHRVATSKA.COM**: Transferred

PANELLISTS

Name	Thomas Hoeren
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DATE OF PANEL DECISION 2022-07-21

Publish the Decision
