

Decision for dispute CAC-UDRP-104869

Case number	CAC-UDRP-104869
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Time of filing	2022-09-26 09:46:18
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Domain names	NARAMILANO.COM
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Passaggio Obbligato S.p.A.
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Complainant representative

Organization	Perani Pozzi Associati
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Respondent

Organization	Lin
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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 the owner, among others, of the following registrations for the trademark "NARA CAMICIE":

- International trademark registration n. 910024 "", granted on May 31, 2006 and duly renewed, in classes 25, 35 and 42;
- International trademark registration n. 503785 "NARACAMICIEEE", granted on June 3, 1986 and duly renewed, in class 25;
- EU trademark registration n. 003372349 "NARA CAMICIEE", filed on September 26, 2003, granted on February 22, 2005 and duly renewed, in class 25; and
- EU trademark registration n. 17873219 "NARACAMICIE", filed on march 13, 2018 and granted on July 24, 2018, in class 35.

Moreover, the Complainant filed the following EU trademark applications **on June 21, 2021**:

- EU trademark application n. 018496800 "NARA MILANO" filed on June 21, 2021, in connection with classes 3, 9, 18, 25 and 35;
- EU trademark application n. 018496801 "NARACAMICIE MILANO" filed on June 21, 2021, in connection with classes 3, 9, 18, 25 and 35; and
- EU trademark application n. 018498212 "NARA", filed on June 21, 2021, in connection with classes 9, 18, 25 and 35.

The Complainant is also the owner, among the others, of the following domain names: <NARACAMICIE.IT>, .COM, <NARA-CAMICIE.IT>, .EU, <NARAMILANO.IT>, .EU, .INFO, .BIZ, .ORG, .NET, .DE, .MX, .CO, .IN, .UK, .CO.UK, .ASIA, .AT, .COM.TR, .CN, .COM.CN, .MT, .NL, .RS, .RU, .ES, .LU, .JP, .PT, .FR, .US, .HK, .TW.

On June 21, 2021, the Respondent registered the domain name <NARAMILANO.COM>.

It is more than obvious that the domain name <NARAMILANO.COM> exactly reproduces the trademark “NARA MILANO” of the Complainant and is confusingly similar to the well-known trademark “NARA CAMICIE”, with the mere substitution of the mark’s verbal portion “CAMICIE” with the term “MILANO”, one of the places where the Complainant has different Nara Camicie stores and where the brand history began.

FACTUAL BACKGROUND

The Complainant (Passaggio Obbligato S.p.A.) is a company controlled by Fenicia S.p.A. (to which the well-known brand Camicissima belongs). The two companies, together, constitute a leading group in the men’s and women’s shirt segment, in Italy and abroad.

The origins of Passaggio Obbligato S.p.A. date back to 1986, when it inaugurated its business with the first series of shirts produced exclusively for the NaraCamicie store on Via Montenapoleone in Milan. Thanks to a gradual and steady success for NARACAMICIE and for Passaggio Obbligato S.p.A., Nara Camicie stores have spread extensively throughout the country and internationally to a sales network that now has about 380 outlets worldwide.

Nara Camicie products are distinguished by the attention paid to quality, finishes and trendy styling. The collections include shirts, suits, knitwear, jackets and pants, trendy and versatile total looks (a vast assortment of more than 1,800 different garments with a wide range of sizes and fits).

In addition, the disputed domain name is not used for any *bona fide* offerings. More particularly, there are present circumstances indicating that the Respondent 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 Complainant for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

It is more than obvious that the domain name <NARAMILANO.COM> exactly reproduces the trademark “NARA MILANO” of the Complainant and is confusingly similar to the well-known trademark “NARA CAMICIE”, with the mere substitution of the mark’s verbal portion “CAMICIE” with the term “MILANO”, one of the places where the Complainant has different Nara Camicie stores and where the brand history began.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has no rights in the disputed domain name, and any use of the trademarks “NARA CAMICIE” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned company to use the domain name at issue.

BAD FAITH

The domain name NARAMILANO.COM was registered and is used in bad faith.

PROCEDURAL FACTORS

All procedural factors have been met.

PRINCIPAL REASONS FOR THE DECISION

The UDRP provides for a mandatory administrative proceeding for disputes between the registrant and any third-party over the abusive registration and use of a domain name. It was adopted by ICANN in 1999 and incorporated by reference into the domain name registration agreement between the ICANN-accredited registrars and registrant to provide remedy to the widespread phenomenon of cybersquatting, i.e. registration of domain names confusingly similar to trade marks for profit. As well known, the UDRP uses a three-part test to determine whether a domain name shall be considered abusive registration:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
2. The registrant has no rights or legitimate interests in respect of the domain name;
3. The domain name has been registered and is being used in bad faith.

The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

It is more than obvious that the domain name <NARAMILANO.COM> exactly reproduces the trademark “NARA MILANO” of the Complainant and is confusingly similar to the well-known trademark “NARA CAMICIE”, with the mere substitution of the mark’s verbal portion “CAMICIE” with the term “MILANO”, one of the places where the Complainant has different Nara Camicie stores and where the brand history began.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent has no rights on the disputed domain name, and any use of the trademarks “NARA CAMICIE” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned company to use the domain name at issue.

The domain name was registered and is used in bad faith.

The Complainant’s trademark “NARA CAMICIE” is distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to it indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wording “NARA CAMICIE”, the same would have yielded obvious references to the Complainant. The Complainant submits, an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant’s trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant’s trademark. This is a clear evidence of registration of the domain name in bad faith.

Paragraph 4(b) of the Policy also provides a non-exhaustive list of circumstances that can constitute evidence of a Respondent’s bad faith in registering and using a disputed domain name. In particular, the consensus view of WIPO UDRP panellists is that bad faith may in, some cases, be found in other conducts carried out by a domain name holder. Panels have tended to make such findings in circumstances in which, for example, a complainant’s mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the Complainant’s trademark rights.

The above is even more evident considering that the most recent Complainant’s trademark (EU trademark registration n. 018496800 “NARA MILANO”) has been filed on June 21, 2021, the exact same day on which the disputed – and identical – domain name has been registered. Such circumstance is rather suspicious, given that “NARA MILANO” is a business identifier of the Complainant. It is therefore very likely that the Respondent received (or was aware of) an insider information concerning the imminent trademark filing carried out by the Complainant or has monitored the Complainant’s trademarks filings in order to anticipate a possible domain name registration by the Complainant.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established. In fact, it is very likely that the Respondent has registered the domain name right after the filing of Complainant's mark only with the aim of offering it for sale at a price representing considerable profit over its direct costs of registration. This is clear evidence of bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **NARAMILANO.COM:** Transferred

PANELLISTS

Name	Vít Horáček
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DATE OF PANEL DECISION 2022-10-21

Publish the Decision