

Decision for dispute CAC-UDRP-104867

Case number	CAC-UDRP-104867
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Time of filing	2022-09-23 09:48:49
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Domain names	zegna-store.com, ZEGNAVENTE.COM, WEARZEGNA.COM
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	CONSITEX S.A.
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Complainant representative

Organization	Convey srl
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RESPONDENTS

Name	
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Name	
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Name	Hbdgg Tdee
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of trademark registrations for ZEGNA, including but not limited to:

- International Registration No. 466534, ZEGNA, registered on 27 January 1982; and
- European Union Trade Mark No. 011679792, ZEGNA, registered on 1 August 2013.

FACTUAL BACKGROUND

Founded in 1910 by Ermenegildo Zegna in Trivero, Italy, the Complainant is an Italian luxury fashion house with its legal corporate entity and owner of the ZEGNA trademarks registered in Switzerland. As of 2021, the Complainant is a public company listed on the New York Stock Exchange. The Complainant operates physical retail stores in locations throughout the world. In addition, the Complainant is the registrant of the domain name <zegna.com>, from which it operates an online store, shipping to Internet users across the globe.

The disputed domain name <zegna-store.com> was registered on 21 April 2022.

The disputed domain name <zegnavente.com> was registered on 17 June 2022.

The disputed domain name <wearzegna.com> was registered on 30 May 2022.

At the time of submission of the Complaint, the disputed domain names resolved to online stores purporting to sell the Complainant's products at substantially discounted prices (the "Respondent's websites"). At the time of this decision, none of the disputed domain names resolves to an active web page.

On 21 July 2022 the Complainant sent a cease and desist letter to the Respondent, requesting *inter alia* transfer of the disputed domain names. The Complainant sent a reminder notice to the Respondent on 15 September 2022. The Respondent did not reply to the Complainant's cease and desist letter.

PARTIES CONTENTIONS

Complainant

The Complainant asserts rights in the ZEGNA trademark. The Complainant submits that the disputed domain names are confusingly similar to its ZEGNA trademark. The Complainant asserts that the additional terms "store", "vente" ("sale" in French), and "wear" could suggest that the disputed domain names are directly controlled or authorized by the Complainant.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant submits that the Respondent is using the disputed domain names to offer for sale goods bearing the Complainant's ZEGNA trademark that are advertised at prices that are disproportionately below their market value. According to the Complainant, the goods advertised at the Respondent's websites are counterfeit. As such, argues the Complainant, the Respondent is not using the disputed domain names in connection with any *bona fide* offering of goods or services. The Complainant further asserts that there is no evidence that the Respondent is commonly known by the disputed domain names, nor is the Respondent making any legitimate noncommercial or fair use of the disputed domain names.

The Complainant submits that the disputed domain names were registered and are being used in bad faith. The Complainant argues that actual knowledge on the part of the Respondent may be inferred from the Respondent's websites, which purport to offer for sale goods bearing the Complainant's ZEGNA trademark, which the Complainant argues are counterfeit. The Complainant asserts that the disputed domain names were registered in order to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking the Complainant to the Respondent's websites. The Complainant argues that the Respondent's offering for sale of counterfeit goods on the Respondent's websites disrupts the Complainant's business, and that by registering three domain names comprising the Complainant's ZENGNA trademark, the Respondent has engaged in a bad-faith pattern of domain name registration. The Complainant submits that the Respondent's failure to reply to the Complainant's cease and desist letter further evidences the Respondent's bad faith.

The Complainant requests transfer of the disputed domain names.

Respondent

The Respondent did not file a Response to the Complaint.

RIGHTS

The Panel finds that the Complainant has established rights in the ZEGNA trademark, the registration details of which are provided above.

Each of the disputed domain names comprises the Complainant's ZEGNA trademark in its entirety, together with an additional term "store", "vente" ("sale" in French), and "wear" respectively, under the generic Top-Level Domain ("gTLD") ".com". The Panel finds that the Complainant's ZEGNA trademark is recognizable in each of the disputed domain names, and that the additional terms "store", "vente", and "wear" do not prevent a finding of confusing similarity between the disputed domain names and the Complainant's ZENGNA trademark.

The gTLD ".com" may be disregarded for purposes of comparison under the first element of the Policy.

The Panel finds the disputed domain names to be confusingly similar to the Complainant's ZEGNA trademark. The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

As stated above, the disputed domain names previously resolved to websites purporting to sell products bearing the Complainant's ZEGNA trademark. The Complainant alleges that these products are counterfeit. The Panel notes in this regard that the Respondent appears to have misappropriated copyrighted product images from the Complainant's website, and that the goods offered for sale via the Respondent's websites were offered at prices substantially below market value. In the absence of any reply from the Respondent, the Panel considers it entirely plausible that the goods offered for sale via the Respondent's websites were in fact counterfeit. Prior UDRP panels have categorically held that the use of a domain name for illegal activity (*e.g.*, the sale of counterfeit goods, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent; see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 2.13. Even if the Panel were to assume that the goods offered for sale were genuine, the Respondent has failed to accurately and prominently disclose its lack of relationship with the Complainant. The Panel therefore finds that the Respondent has no valid claim of rights or legitimate interests in the disputed domain names as an unauthorized reseller of the Complainant's products; see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903. The Panel finds that the Respondent has not made use of the disputed domain names in connection with a *bona fide* offering of goods or services pursuant to paragraph 4(c)(i) of the Policy.

The Respondent's use of the disputed domain names does not support any legitimate claim of being commonly known by the disputed domain names, nor is there any other evidence to support a finding that the Respondent is commonly known by the disputed domain names as contemplated by paragraph 4(c)(ii) of the Policy. The Panel further finds that the Respondent is not making any legitimate noncommercial or fair use of the disputed domain names within the meaning of paragraph 4(c)(iii) of the Policy.

For the above reasons, the Panel finds that Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel notes that the registration of its ZEGNA trademark substantially predates the registration of the disputed domain names. Since its founding over 100 years ago, the Complainant has gained substantial reputation throughout the world in connection with its luxury clothing and related goods. The Panel finds that actual knowledge of the Complainant and intent on the part of the Respondent to target the Complainant's ZEGNA trademark through the disputed domain names may be inferred from the contents of the Respondent's websites, which made explicit reference to the Complainant. In the circumstances, the Panel finds that the Respondent registered the disputed domain names, having no authorization to make use of the Complainant's trademark in a domain name or otherwise, with a view to creating a misleading impression of association with the Complainant, in bad faith.

The Panel further finds that by using the disputed domain names in the manner described above, Internet users were likely to be misled as to the source of the goods offered for sale via the Respondent's websites. The Panel concludes that by using the disputed domain names, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its websites, by creating a likelihood of confusion with the Complainant's ZEGNA trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites and the goods advertised for sale therein, in bad faith pursuant to paragraph 4(b)(iv) of the Policy. The fact that the disputed domain names no longer resolve to active websites does not materially affect the Panel's findings under this element of the Policy.

The Panel finds that the disputed domain names were registered and are being used in bad faith. The Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

Consolidation of the Respondent

Where a complaint is filed against multiple respondents, UDRP 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; see WIPO Overview 3.0, section 4.11.2.

In the present case, the Panel notes that the disputed domain names display the following commonalities:

- All of the disputed domain names were registered with the same registrar;
- All three registrants of the disputed domain names are listed as being located in China;
- All of the disputed domain names comprise the Complainant's ZEGNA trademark together with descriptive terms with an inherent connection to the fashion industry;
- All of the disputed domain names were registered under the same gTLD ".com";
- All of the disputed domain names previously resolved to websites that displayed similar information;
- Similar or the same products bearing the Complainant's ZEGNA trademark were offered for sale via the Respondent's websites; and
- None of the disputed domain names currently resolves to an active website.

None of the Whols-listed registrants has come forward to submit a reply to the Complaint. In the circumstances, the Panel finds it more likely than not that the disputed domain names were registered by the same ultimate beneficial owner, or that the disputed domain

names are subject to common control by registrants associated with one another. The Panel considers that consolidation of three nominally-distinct Respondents is fair and equitable in the present case, and has accordingly granted the Complainant's request for consolidation of the Respondents. The Complainant has referred to the registrants of the disputed domain names collectively as the "Respondent" throughout this decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has established rights in the ZEGNA trademark. The disputed domain names are confusingly similar to the Complainant's ZEGNA trademark. The Complainant has demonstrated that the Respondent has no rights or legitimate interests in respect of the disputed domain names, and that the disputed domain names were registered and is being used in an attempt to create a misleading impression of association between the Complainant, its ZEGNA trademark, the disputed domain names, and the websites to which they previously resolved, in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **zegna-store.com**: Transferred
- 2. **ZEGNAVENTE.COM**: Transferred
- 3. **WEARZEGNA.COM**: Transferred

PANELLISTS

Name	Jane Seager
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DATE OF PANEL DECISION 2022-11-03

Publish the Decision