

## Decision for dispute CAC-UDRP-104969

Case number CAC-UDRP-104969

Time of filing 2022-11-08 08:09:28

Domain names SUN68IT.ONLINE

### Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

### Complainant

Organization NUMERO 8 S.R.L.

### Complainant representative

Organization GLP S.r.l.

### Respondent

Name Melinda Ulbrecht

#### 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 trademarks "SUN68":

- International trademark registration n. 871547 "SUN68", granted on September 15, 2005 and duly renewed in class 25, covering Australia, Switzerland, Croatia, Monaco, Norway and Singapore;
- International trademark registration n. 1042450 "SUN68", granted on May 28, 2010 and duly renewed in classes 3, 9, 14, 16, 18, 25 and 35, covering among others Australia, Switzerland, South Korea, Russia, etc.;
- European Union trademark no. 4526174 "SUN68", filed on July 5, 2005, granted on May 15, 2006 and duly renewed, in class 25;
- European Union trademark no. 9138025 "SUN68", filed on May 28, 2010, granted on April 18, 2011 and duly renewed, in classes 3, 9, 14, 16, 18 and 35;
- Chinese trademark registration no. 23554375A "SUN68", filed on April 13, 2017, granted on October 21, 2018 in class 25; and
- US trademark registration no.6604755 "SUN68", filed on December 2, 2019 and granted on January 4, 2022 in class 25.

#### FACTUAL BACKGROUND

The Complainant is a renowned Italian manufacturer of apparel, shoes and clothing accessories under the well-known brand "SUN68".

Numero 8 is based in Noventa di Piave and – since its establishment in 2005 – has expanded and grown to almost two million pieces distributed each year at more than 2.300 retail dealers. "SUN68" is currently one of the highest performing companies in Italy. The Complainant's current annual turnover amounts to 58 million Euro (and an estimated 70 million Euro for the for 2023).

The success of the Complainant's trademark "SUN68" has been widely reported by both the national and international press and the public who recognized the high value of "SUN68" apparel in events such as PITTI UOMO, one of the world's most important platforms for men's clothing and accessory collections, and for launching new projects in men's fashion. This is the result of the considerable investments made by the Complainant for the promotion of its brand (as a mere example, annual spending of 200,000 Euros in press advertising only in Italy, building a unique partnership with Italian major sport/ lifestyle press group "RCS" (La Gazzetta dello Sport, Sportweek, Corriere della Sera), including co-partnership organized events, EU press office in Antwerp and Amsterdam (MMBSY <https://www.mmbsy.com/>), with annual spending of 80K Euros in ambassadors and events projects, over 110K Euros in multichannel online advertising (social and Google), etc.).

Apart from being the owner of numerous earlier trademarks, the Complainant is also the owner, among others, of the domain name <SUN68.COM>, registered on August 22, 2005 and currently connected to the Complainant's official website <https://www.sun68.com>.

On February 25, 2022, the Respondent registered the domain name <SUN68IT.ONLINE>.

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#### PARTIES CONTENTIONS

The Complainant contends that <SUN68IT.ONLINE> is identical to "SUN68" trademark, with the mere addition of letters "IT", a clear reference to the country-code of ITALY.

The Complainant contends it has no relationship to the Respondent, the disputed domain name does not correspond to the name of the Respondent and is not used for legitimate purposes.

The Complainant's trademark "SUN68" 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. The current use of the disputed domain name causes great damages to the Complainant, due to the misleading of its present clients and to the loss of potential new ones.

No administratively compliant Response has been filed.

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#### 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).

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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).

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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).

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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.

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#### PRINCIPAL REASONS FOR THE DECISION

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

#### RIGHTS

The Complaint has established rights in the name SUN68. The disputed domain name <SUN68IT.ONLINE> is found to be confusingly similar to the Complainant's Trademark, company name and domain name. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of

- a) disregarding the top-level suffix in the domain name (i.e. ".online"), and
- b) finding that the addition of a generic or generally non-distinctive element to the protected trademark (in this case the letters IT as an abbreviation for "Italy" ) would not be considered sufficient to distinguish a domain name from a trademark. The reference to Italy can be seen as a clear reference to the geographical origins of the products.

The disputed domain name is therefore confusingly similar to the earlier rights in the name SUN68.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the UDRP.

#### NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Respondent is not commonly known by the disputed domain name. The Respondent is in no way related to the Complainant. The Respondent has not been granted an authorization or license to use the disputed domain name by the Complainant. The Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy). The disputed domain name resolves to a web site purporting to sell the Complainant's products without being authorised to do so.

In summary, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

#### BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. The Respondent is also in no way commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

The Complainant's trademark "SUN68" 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 "SUN68", the same would have yielded obvious references to the Complainant. 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 clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bona fide offerings. Instead, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site. On the website, several services can be detected, but not in good faith: in fact, the domain name is connected to a website replicating the colours, layout, graphic and even the images from the Complainant's official campaign. Internet users searching for information on the Complainant's goods are

misdirected to the Respondent's websites where they have attempted to make purchases of unauthorized "SUN68" goods from a source not authorised to do so. Instead, such users have been scammed by the Respondent on his website, since the prepaid items have never been shipped to the customers.

The current use of the disputed domain name causes great damage to the Complainant, due to the misleading of existing clients and the loss of potential new clients. The Respondent's commercial gain is evident, since it is obvious that the Respondent's sponsoring activity is being remunerated.

Therefore, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

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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. **SUN68IT.ONLINE**: Transferred

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## **PANELLISTS**

Name	<b>Udo Pflughar B.A. (Melb.)</b>
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DATE OF PANEL DECISION **2022-12-15**

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**Publish the Decision**

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