

Decision for dispute CAC-UDRP-105150

Case number	CAC-UDRP-105150
Time of filing	2023-01-27 10:25:53
Domain names	nalinisale.store, nalinicycling.store

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	MOA UNO VINCENZO MANTOVANI DI CLAUDIO MANTOVANI & C. S.A.S.
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Complainant representative

Organization	Convey srl
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Respondent

Organization	Kndeh Uferh (Kndeh Uferh)
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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, MOA SPORT MANTOVANI VINCENZO DI MANTOVANI CLAUDIO & C. S.N.C., is domiciled in Italy and is the owner of various trademark registrations including the signs "NALINI", such as:

- International Trademark No 609895 NALINI + device, registered in Class 25
- New Zealand Trademark No 766710 NALINI + device, registered in Class 25
- US Trademark No 2138140 NALINI registered in Class 25
- Israeli Trademark No 199219 NALINI + device, registered in Class 25

The Domain Names <nalinisale.store> and <nalincyling.store> were registered by the same Respondent on June 14th, 2022 and have been pointed to websites which share the same lay-outs and where Complainant's counterfeit products are offered for sale.

The Complainant requested that the domain names and the named Respondents 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. In this case, the disclosed data on the respective registrants are the same and the respective domain names were created on the same day and

time, before the same registrar.

FACTUAL BACKGROUND

The trademark NALINI has its roots when Vincenzo Mantovani, the founder, coming off a cyclist career crowned with the silver medal at the 1964 Tokyo Olympics team pursuit, who started - in the late 1960s - to design and produce garments for his cyclist friends and for himself. A few years later, Claudio Mantovani, younger brother of Vincenzo and goal keeper for the Italian National Team and AC Milan, joined in the business.

Supported by MOA SPORT, its technological laboratory, the Complainant produces genuine and original cycling garments with unique performance and fit which are offered for sale through several retailers worldwide. MOA SPORT has been among the first producers to introduce advanced technologies and new materials on the pad in cycling clothing; in particular, MOA SPORT made fibres instead of deerskin.

On all NALINI pads the outer fabric are OEKO-TEX certified. OEKO-TEX® is a certification that safeguards users from the presence of dangerous substances in the fabrics. Moreover, the fabrics and foams are all antibacterial, light, breathable, hydrophilic, and they are absolutely innovative for their technology and design.

In order to protect and promote its brand, the Complainant has been extensively using the NALINI denominations on all internet environments including and not limited to the complainant's official website <https://www.nalini.com/>

A cease and desist letter was sent to an available address on October 12th, 2022, but it could not be delivered.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

- 1. The Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;**

(Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

The Domain Names registered by the Respondent are confusingly similar to trademarks in which Complainant has rights.

The Domain Names incorporate the whole of the Complainant's trademark NALINI and the fact that they include non-distinctive elements - such as "sale", "cycling" - the generic Top Level Domain .store does not affect the confusing similarity.

The combination of the trademark NALINI with generic terms could suggest improperly to consumers that the Domain Names and corresponding web sites might be controlled by the Complainant or with the Complainant's authorization.

In light of the above, the Domain Names are certainly confusingly similar to the prior registered trademark in which the Complainant has rights pursuant to paragraph 4(a)(i) of the Policy.

- 1. The Respondent has no rights or legitimate interests in respect of the Domain Names;**

(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

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

Upon information and belief, the Respondent is not commonly known by the Domain Names as individuals, business or other organization and his family name does not correspond to NALINI 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.

The Domain Names are redirected by the Respondent to websites where the Complainant's trademarks NALINI are reproduced to sell counterfeit products offered for sale at low prices.

Respondent's use can not be considered either a bona fide offering of goods or services or a legitimate non-commercial or fair use of the Domain Names.

Such willful conduct clearly demonstrates, to the contrary, that Respondent is not intended to use the Domain Names in connection with any legitimate purposes.

Moreover, the Respondent has not reply to the cease and desist letter providing a valid reason for the registrations of the Domain Names confusingly similar to the Complainant's trademark, this circumstance excludes that the Respondent could have rights or legitimate interests in respect of the Domain Names.

1. The Domain Names were registered and are being used in bad faith.

(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

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 trademarks NALINI since many years, and the advertising of the Complainant's products worldwide, the Respondent could not have possibly ignored the existence of the Complainant's trademark.

The NALINI trademark of the Complainant enjoys worldwide reputation in the sector of cycling apparel and has many boutiques and a distribution network worldwide.

The Domain Names were registered on June 14th, 2022, years after the Complainant obtained its trademark registrations.

Furthermore, the actual knowledge of NALINI trademarks by Respondent at the time of the registration of the Domain Names is demonstrated by the facts that the Respondent has offered for sale on replicas of Complainant's cycling apparel reproducing also the trademark NALINI.

With reference to the above, the Complainant 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.

The fact that replicas of NALINI products are offered for sale on the websites corresponding to the Domain Names indicate that the Respondent has been fully aware of the Complainant's mark's reputation and association with the Complainant and that his purpose in registering the Domain Names was solely to capitalize on the reputation of Complainant's NALINI trademarks by diverting Internet users seeking products under the NALINI trademark to its own commercial websites, selling counterfeited products at discounted prices.

Respondent has intentionally attempted to attract for commercial gain Internet users to its websites by creating a likelihood of confusion with Complainant's mark as to Complainant as a source, sponsor, affiliate or endorser of Respondent's websites. Respondent registered and is using the disputed domain names in bad faith within the meaning of paragraph 4(b)(iv) of the Policy."

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".

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant is an Italian company that owns several NALINI trademarks, such as the hereabove cited trademarks:

- International Trademark No 609895 NALINI + device, registered in Class 25
- New Zealand Trademark No 766710 NALINI + device, registered in Class 25
- US Trademark No 2138140 NALINI registered in Class 25
- Israeli Trademark No 199219 NALINI + device, registered in Class 25

The Disputed Domain Names are <nalinisale.store> and <nalinicycling.store>

The Disputed Domain Names wholly incorporates the NALINI trademark.

It only differs from the NALINI trademarks by the addition of the generic term "sale" or "cycling".

This addition does not avoid the confusing similarity to the NALINI trademark.

The Disputed Domain Name then contains the distinctive and recognizable NALINI trademark.

Thus, the Disputed Domain Names are confusingly similar to the NALINI trademarks.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

NO RIGHTS OR LEGITIMATE INTERESTS

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- (ii) the Respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

The Complainant asserts that the Respondent is not related in any way with the Complainant and that it did not grant any license or authorization to register the Disputed Domain Names. This allegation was not contested by the Respondent.

The Respondent did not respond to the Complainant to rebut its *prima facie* case. It did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the Disputed Domain Names.

Under the UDRP, the complainant is merely required to make out a *prima facie* case showing that the Respondent lacked rights or legitimate interests.

Therefore, the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in respect to the Disputed Domain Name.

The Panel concludes that the Respondent did not establish any right or legitimate interest to the Disputed Domain Names (within the meaning of paragraph 4(a)(ii) of the Policy).

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).

BAD FAITH

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the disputed domain name.

It provides that:

"For the purposes of paragraph 4(a)(iii), 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 Domain Name in bad faith:

- (i) circumstances indicating that the Respondent has registered or the respondent has 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 the respondent's documented out-of-pocket costs directly related to the Domain Name; or
- (ii) the Respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website 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 the respondent's website or location or of a product or service on the respondent's website or location."

The NALINI trademarks were registered prior to the disputed domain names and are well-known .

The Respondent is using the disputed domain names to resolve to a webpage offering NALINI branded products at discounted prices, which appear to be counterfitted products.

The Respondent targeted the NALINI well-known trademark when it registered the disputed domain names, in the intent to use them to sell these NALINI branded goods.

He simply added the generic terms "sale" and "cycling", in order to be able to use domain names that could attract the internet users looking for NALINI products.

This pattern proves that he was well aware of the NALINI trademarks.

Given the circumstances of the case, the Panel is of the opinion that, relying on Par. 4(b)(iv) of the Policy:

“ 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.”.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

As disclosed by the registrar, the disputed domain names were registered by the same Respondent on June 14th, 2022 and have been pointed to websites which share the same lay-outs and where Complainant's counterfeit products are offered for sale.

The Panel is of the opinion that the procedure can be consolidated, they are registered in the name of the same Respondent.

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.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain names <nalinisale.store> and <nalinicycling.store> wholly incorporate the prior NALINI trademark.

The addition of the generic terms "sale" and "cycling" do not avoid any confusing similarity with the NALINI trademark.

The Respondent did not react and the Complainant made a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names.

The pattern of registration of the disputed domain names and their use to resolve to websites offering NALINI branded goods, which are allegedly presented as fake, show that the Respondent targeted these NALINI trademark when creating these domain names, in order to attract the internet users to its own websites offering fake NALINI branded products.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **nalinisale.store**: Transferred
2. **nalinicycling.store**: Transferred

PANELLISTS

Name	Marie-Emmanuelle Haas Avocat
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DATE OF PANEL DECISION 2023-03-06

Publish the Decision
