

Decision for dispute CAC-UDRP-105165

Case number **CAC-UDRP-105165**

Time of filing **2023-02-01 09:18:17**

Domain names **NARACAMICIEONLINESHOP.COM**

Case administrator

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

Complainant

Organization **Passaggio Obbligato S.p.A.**

Complainant representative

Organization **Perani Pozzi Associati**

Respondent

Organization **Web Server Kft.**

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 owns the following trademark registrations:

- International trademark registration number 910024 for NARACAMICIE, registered on 31 May 2006, in classes 25, 35 and 42;
- International trademark registration number 503785 for NARA CAMICEEEE registered on 3 June 1986, in class 25; and
- EU trademark registration number. 003372349 for NARA CAMICEE, registered on 22 February 2005, in class 25.

FACTUAL BACKGROUND

The Complainant began its business in 1986. It is now a subsidiary of Fenicia S.p.A and together the two companies are a leading group in the men's and women's shirt segment, in Italy and abroad and have about 380 sales outlets around the world.

The Complainant owns trademarks registrations for NARACAMICIE, NARA CAMICEEEE and NARA CAMICEE, which predate the registration of the disputed domain name. The Complainant also owns numerous domain names, incorporating its trademark, such as <naracamicie.com> and <naracamicie.it>.

The Respondent registered the disputed domain name on 27 February 2020, using a privacy service.

PARTIES CONTENTIONS

The Complainant's contentions are summarised below.

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).

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).

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).

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.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4 (a) of the Policy requires the Complainant to prove each of the following three elements:

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

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant contends that the disputed domain name is confusingly similar to its trademarks.

The addition of the top-level suffix, ".com" is a standard registration requirement. It does not add any distinctiveness to a domain name and can be disregarded when assessing whether the disputed domain name is confusingly similar to the Complainant's trademark.

The disputed domain name incorporates the Complainant's trademark, NARACAMICIE, and adds to it the words "online" and "shop", which are terms associated with the Complainant's business. The Complainant's trademark is the dominant feature and clearly recognisable in the disputed domain name. The addition of the words "online shop", to the Complainant's trademark do not prevent a finding of confusing similarity.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark and that the requirements of paragraph 4(a)(i) of the Policy have been met.

B. NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent has no rights in the disputed domain name. It asserts that:

- i. the Respondent is not authorised or licenced to use the Complainant's trademark NARA CAMICIE;
- ii. the Respondent is not commonly known as disputed domain name; and
- iii. the disputed domain name resolves to an error page and there is no evidence of any fair or non-commercial use of the disputed domain name.

The Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain name. The burden of proof now shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name.

The Respondent has not filed a Response and there is no evidence to show that the Respondent has any rights or a legitimate interest in the disputed domain name. The Respondent is not authorised to use the Complainant's trademark and is not commonly known by the disputed domain name. The disputed domain name resolves to an error page. There is no evidence of any bona fide offering of goods or services, or a legitimate non-commercial or fair use of the disputed domain name by the Respondent.

Taking the above factors into consideration, the Panel finds that the Respondent has no rights or legitimate interest in the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

C. REGISTERED AND BEING USED IN BAD FAITH

The Complainant asserts that the disputed domain name has been registered and is being used in bad faith. The Complainant states that its trademark, NARA CAMICIE, is distinctive and well-known around the world. The fact that the Respondent registered a domain name that is confusingly similar to its trademark, indicates that the Respondent knew of the Complainant's trademark when it registered the disputed domain name. It states that if the Respondent had carried even a basic Google search for NARA CAMICIE it would have found obvious references to the Complainant and its trademark. The Complainant also asserts that the disputed domain name is not being used for any bona fide offerings and that the passive holding of a domain name with knowledge that it infringes another party's trademark rights is evidence of bad faith registration and use.

The Respondent has not filed a response nor rebutted any of the Complainant's assertions regarding bad faith registration and use of the disputed domain name. The Complainant's International trademark, NARACAMICIE, has been registered since 2006. It seems implausible that the Respondent did not know of the Complainant's trademark when it registered the disputed domain name. The most likely reason for the Respondent to register a domain name that incorporates the Complainant's trademark is to seek to create a likelihood of confusion with the Complainant and its trademark.

The Respondent has incorporated the whole of the Complainant's long-standing and distinctive trademark mark into the disputed domain name and added to it the words "online shop", which are words closely associated with the Complainant's business. The Respondent has provided no evidence nor asserted any legitimate rights in respect of the disputed domain name. As stated in *Comerica Inc. v. Horoshiy, Inc.*, WIPO Case No. D2004-0615: "The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. ...To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent."

As numerous UDRP panels have found, the passive registration of a domain name can amount to bad faith registration and use in certain circumstances (for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003). In the present case, the Complainant's trademark is distinctive and long-standing. The Respondent has used a privacy service to conceal its identity, has failed to submit a Response to the Compliant, has provided no evidence of any actual or intended good faith use of the disputed domain name, and has no rights or legitimate interest in it. There is no conceivable use of the disputed domain name by the Respondent that would not amount to an infringement of the Complainant's trademark rights.

Taking all the above factors into consideration, the Panel concludes that the disputed domain name was both registered and is being used in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. NARACAMICIEONLINESHOP.COM: Transferred

PANELLISTS

Name Veronica Bailey

DATE OF PANEL DECISION 2023-03-09

