

Decision for dispute CAC-UDRP-105231

Case number	CAC-UDRP-105231
Time of filing	2023-03-06 15:36:54
Domain names	BONILASHOP.COM, chiara-boni.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Chiara Boni & Sons S.r.l.
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Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.
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Respondents

Name	67 Jure
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Name	bing xu
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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 owns an extensive portfolio of trade mark registrations consisting of or incorporating the name “Chiara Boni”, including the following:

Chiara Boni

Chinese national word trade mark “CHIARA BONI”, registration No 55770767, first registered on 14 October 2009 in international class 25.

Chiara Boni La Petite Robe

Figurative EU trade mark “CHIARA BONI LA PETITE ROBE”, registration No 014671689, first registered on 9 March 2016 in international classes 3, 18, 25 and 35; figurative International trade mark “CHIARA BONI LA PETITE ROBE”, registration No 1286255, first registered on 15 October 2015 in international classes 3, 18, 25 and 35; and figurative national Italian trade mark “CHIARA BONI LA PETITE ROBE”, registration No 2015000060159, first registered on 26 October 2018 in international classes 3, 18, 25 and 35.

These trade mark registrations all predate the registration of the disputed domain names.

The Complainant also owns numerous domain names consisting of or comprising the name “Chiara Boni”, including the domain names <chiaraboni.eu>, registered in 2010; and <chiaraboni.com>, <chiaraboni.net>, and <chiaraboni.it>, all registered in 2011. The Complainant’s domain names all connect to the Complainant’s official website at www.chiaraboni.com.

Finally, the Complainant widely promotes its products on Instagram and Twitter under the account name “Chiara Boni La Petite Robe”.

FACTUAL BACKGROUND

The Complainant, Chiara Boni & Sons S.r.l., is a fashion business based in Milan, Italy. The company is also known as “Chiara Boni La Petite Robe”. The company and the brand take their names from their founder, Chiara Boni. Chiara Boni began her career as a designer in 1971, opening her first boutique in Florence, where she offered clothes designed by herself. In 1985, she signed an agreement with Gruppo Finanziario Tessile (GFT), which led to the birth of “Chiara Boni S.p.A”. GFT and Chiara Boni designed and created prestigious collections of pret-à-porter fashion and sportswear for women and men in collaboration with partners such as Ungaro, Armani and Valentino. In collaboration with GFT, Chiara Boni also realised a project in China, selling a men's line made with Italian fabrics and Chinese manufacturing. Following the sale of the trade marks by GFT in 2001, Chiara Boni repurchased the trade marks. In 2007, the trade mark “La petite Robe” entered the market in relation to innovative garments made of stretch fabrics, which are foldable in micro tulle envelopes, are easy to wash and do not require ironing.

The Complainant’s core business is derived from its main boutiques in Rome and Milan, and from the sale and distribution of its products online through its official website at www.chiaraboni.com.

Since 2010, Chiara Boni’s collections are also offered widely on the international fashion markets, including in the United States. In addition, the Company sells its products in countries around the world also through other online sales platforms for fashion and luxury goods, such as Farfetch.com and Yoox.com.

The Complainant’s fashion collections frequently receive international press and media coverage, for example, in Vanity Fair, Elle and Cosmopolitan, and are presented at fashion shows internationally. Chiara Boni has also collaborated with celebrities such as Chiara Ferragni, Alena Seredova and Sharon Stone.

The latest financial statements filed by Chiara Boni & Sons S.r.l. in the business register correspond to the year 2021 and report a turnover of € 14,180,304.

The disputed domain name <chiara-boni.com> was registered on 13 September 2022; the disputed domain name <bonilashop.com> was registered on 3 September 2022. Both disputed domain names resolve to online shops mirroring the Complainant’s official website and offering clothing and accessories for sale by reference to the names “Chiara Boni” and “Chiara Boni La Petite Robe”.

PARTIES CONTENTIONS

Complainant’s contentions are summarised above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are identical or confusingly similar to a trade mark 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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

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

PROCEDURAL FACTORS

The Whois records for the disputed domain names in the present proceedings identify different registrant names, and these proceedings therefore in principle concern two separate Respondents. The Complainant requests that the disputed domain names and the named Respondents be consolidated in a single UDRP proceeding. In determining this issue, the Panel respectfully adopts the reasoning of other panels in relation to consolidation requests: paragraph 4(f) of the Policy provides that “[i]n the event of multiple disputes between [a respondent] and a complainant, either [the respondent] or the complainant may petition to consolidate the disputes before a single Administrative Panel....” This is permissible where it “promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expense, reduces the potential for conflicting or inconsistent results arising from multiple proceedings, and generally furthers the fundamental objectives of the Policy.” (See, for example, WIPO Case No D2009-0985, MLB Advanced Media, The Phillies, Padres LP -v- OreNet, Inc.). Furthermore, paragraph 3(c) of the Rules provides that “[t]he complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.” UDRP panels have looked to a variety of factors in determining whether multiple domain names are, in fact, of common ownership. (see WIPO Overview 3.0 at par. 4.11.2). Such factors as similarities in the Whois information, similar naming conventions in the disputed domain names, similar website resolution, etc, may lead to the conclusion that domain names with different registrant names are, nevertheless, owned by a single entity. (See, for example, WIPO Case No D2014-0474, Delta Dental Plans Association -v- ICS INC., et al. (consolidation of 31 domains allowed where “[t]he Panel notes that each of the disputed domain names follows an identical naming convention, namely (DELTA DENTAL marks + of + state name or two-letter state abbreviation); WIPO Case No D2021-0497, Cephalon Inc -v- Whois Privacy Protection Foundation / Grigorij Minin, Whois Privacy Protection Foundation / Artem Bogdanov, and Alex Ivanov, Evgeny Shaposhniko (while the names of the registrants of the disputed domain names are different, one factor to consider in allowing consolidation “the Domain Names were registered on two days, November 13, 2020 and November 20, 2020, with only seven days difference”).

In the present proceedings, the registrant names for the disputed domain names differ. However, the disputed domain names share significant communalities, including, that they were registered within a narrow time window; are both registered with the same registrar; they both use the same hosting service; they both resolve to websites impersonating the Complainant’s official website, and use the Complainant’s trade marks and product images, without disclosing who owns and operates the websites; both websites use common elements, including the footers and links at the bottom of pages, similar contact forms and delivery information, and both use the same contact e-mail address on the respective privacy policy pages. Furthermore, both registrants use e-mail addresses using the domain extension .live.

In view of these similarities, the Panel finds it likely on balance of probabilities that they are owned by the same person. The Panel further notes that none of the registrants of the disputed domain names has participated in these proceedings to dispute the Complainant’s assertion of common ownership of the disputed domain names. The Panel therefore finds that there are sufficient grounds to conclude that it would be fair and equitable, as well as procedurally efficient, to permit the consolidation of the disputed domain names into this single case.

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

With regard to the first UDRP element, the Panel finds that the disputed domain name <chiara-boni.com> is confusingly similar to the Complainant’s trade mark CHIARA BONI. Indeed, the disputed domain name incorporates the Complainant’s trade mark in its entirety but adds a hyphen between the two name elements “Chiara” and “Boni”. The Panel follows in this respect the view established by numerous other decisions that a domain name which wholly incorporates a complainant’s registered trade mark may be sufficient to establish confusing similarity for purposes of the UDRP (for example, WIPO Case No D2003-0888, Dr. Ing. h.c. F. Porsche AG -v- Vasiliy Terkin <porsche-autoparts.com>). Furthermore, the addition of a hyphen from the disputed domain name is not sufficient to alter the overall impression of the designation as being connected with the Complainant’s trade mark, and does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trade marks and associated domain names. This is effectively a plain case of the Respondent using the disputed domain name in an attempt to typo-squat with regard to the Complainant’s registered domain name <chiaraboni.com>.

With regard to the second disputed domain name, <bonilashop.com>, on a side-by-side comparison between their textual elements, the Panel does not immediately identify any confusing similarity between the disputed domain name and the Complainant’s traded marks, the Complainant’s argument to the contrary notwithstanding that the disputed domain name incorporates the key name element “Boni” and that the Complainant’s trade marks are therefore recognisable in the disputed domain name. However, the Panel notes that the first element functions primarily as a threshold requirement to assess the Complainant’s standing to file a UDRP complaint. The Panel considers it appropriate in the circumstances of this case to follow the practice established by panels in other cases of looking at the broader case context to support a finding of confusing similarity. That broader context shows that the disputed domain name resolves to a website with clear references to the Complainant’s trade marks and, indeed, impersonating the Complainant’s own official website, and seeking to trade off the Complainant’s reputation. The Panel is therefore satisfied, that the disputed domain name <bonilashop.com> is also confusingly similar to the Complainant’s trade marks.

With regard to the second UDRP element, the Panel notes that both disputed domain names resolve to websites impersonating the Complainant’s official website, and using the Complainant’s trade marks and product images. Both websites also include an e-commerce functionality and offer for sale a range of products by reference to the Complainant’s trade marks. The Complainant alleges

that the products offered for sale on both websites are clearly counterfeit. While that allegation is not supported by any evidence, and panels are generally not prepared to accept merely conclusory or wholly unsupported allegations of illegal activity, including counterfeiting, even when the respondent is in default, the products offered for sale on both websites are clearly offered at highly discounted prices.

However, the Panel notes that the websites accessed through the disputed domain names carry a high risk of affiliation with the Complainant, suggesting that they are either the Complainant's own websites, or are at least endorsed by the Complainant, where this is not the case. The Panel accepts the Complainant's submissions in this regard that the Respondents are not affiliated with or related to the Complainant in any way and are neither licensed nor otherwise authorised to make any use of the Complainant's trade marks, or to apply for or use the disputed domain names. Indeed, the websites accessed through the disputed domain name do not identify who owns and operates them, and do not clearly and prominently identify the registrants' relationship with the Complainant.

In the circumstances, the Panel accepts that the webpages accessed through the disputed domain names take unfair advantage of the Complainant's trade marks for the purpose of directing traffic to those webpages for commercial gain, and also mislead Internet users because they seek to impersonate the Complainant. The Panel therefore concludes that the websites to which the disputed domain names resolve do not constitute a bona fide offering of goods or services.

Furthermore, the Whois information does not suggest that the Respondents are commonly known by the disputed domain names <chiara-boni.com> and <bonilashop.com>. Neither is there any indication that the Respondents are making legitimate non-commercial or fair use of the disputed domain names.

Against this background, and absent any response from the Respondents, or any other information indicating the contrary, the Panel concludes that the Respondents have no rights or legitimate interests in respect of the disputed domain names.

With regard to the third UDRP element, it is reasonable to infer that the Respondents either knew, or should have known, that the disputed domain names would be confusingly similar to the Complainant's trade marks, and that they registered the disputed domain name in full knowledge of the Complainant's trade marks. Indeed, it is likely that the disputed domain would not have been registered if it were not for the Complainant's trade mark (see, for example, WIPO Case No D2004-0673 Ferrari Spa -v- American Entertainment Group Inc). The Panel notes that the Respondents seek to attract Internet users to their own websites for commercial gain, based on the Complainant's trade marks, which constitutes further evidence of bad faith (see, for example, WIPO Case No D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC ("In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve [...] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.")). Absent any response from the Respondents, or any other information indicating the contrary, the Panel therefore also accepts that the Respondents have registered and are using the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **BONILASHOP.COM**: Transferred
- 2. **chiara-boni.com**: Transferred

PANELLISTS

Name	Gregor Kleinknecht LLM MCIArb
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DATE OF PANEL DECISION	2023-04-11
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Publish the Decision