

Decision for dispute CAC-UDRP-105278

Case number	CAC-UDRP-105278
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Time of filing	2023-03-10 09:45:19
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Domain names	giordanashop.com
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Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Name	Piergiorgio Andretta
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Complainant representative

Organization	Convey srl
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Respondent

Name	
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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 is the registered owner of several trademarks worldwide consisting of and or containing the term “GIORDANA”, amongst others of International Registration n. 529214 GIORDANA, registered on September 20, 1988 for goods in class 25, designating amongst others Germany; International registration n. 1144934 GIORDANA, registered on November 13, 2012 for goods in class 25, designating amongst others China.

FACTUAL BACKGROUND

It results from the Complainant's undisputed allegations that the trademark GIORDANA has its roots in 1971 when the Complainant - elite cyclist - founded an importing and distribution company. The Complainant left Italy when he was twenty years old for Canada and became the first North American distributor for frames and cycling clothes. Working with the biggest names in the sport, his goal has always been to offer the highest quality European equipment to elevate the American cycling experience.

In the late 1970s, the Complainant's success and expertise allowed him to launch Giordana Sport, his own cycling apparel brand, through the GIORDANA company which designs and produces apparel for the everyday rider and professional racers, too.

Over the years GIORDANA brand has sponsored athletes at all levels including National Teams, WorldTour teams, World Champions, Olympic gold medallists.

The Complainant has recently opened a dedicated GIORDANA manufacturing facility in Italy, creating also a chain of distributors worldwide.

The Complainant further contends its trademark GIORDANA be distinctive and well-known worldwide in the sector of cycling apparel and has many boutiques and a distribution network worldwide

The Complainant uses the domain name <giordanacycling.com> to connect to a website, through which it advertises and sell its products.

The disputed domain name <giordanashop.com > was registered on December 18, 2021 and resolves to a website displaying Complainant's trademarks and further reproducing the Complainant's copyrighted images and allegedly selling Complainant's branded products at a discounted price/low prices.

On October 12, 2022 a cease and desist letter was sent by the Complainant's authorized representative to the Respondent requesting to refrain from using the disputed domain name as well as to transfer the disputed domain name to the Complainant. There was no reply and no comply to this request.

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 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

1. Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of various trademark registrations for GIORDANA.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") at section 1.7.

This Panel shares this view and notes that the Complainant's registered trademark GIORDANA is fully included in the disputed domain name, followed by the term "shop". Furthermore, it is the view of this Panel that the addition of the term "shop" in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the

Complainant's trademark is clearly recognizable in the disputed domain name (see WIPO Overview 3.0 at section 1.8).

Finally, the gTLD ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see WIPO Overview 3.0 at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

2. Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a prima facie case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and, in particular, did not authorize the Respondent's use of the trademark GIORDANA, e.g. by registering the disputed domain name comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, it results from the Complainant's non-contested evidence that the disputed domain name resolves to a website on which the Complainant's GIORDANA goods are allegedly sold and which did not accurately and prominently disclose the lack of the Respondent's relationship with the Complainant. Since this use is clearly commercial, it cannot be considered a legitimate noncommercial 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 pursuant to paragraph 4(c)(iii) of the Policy.

Furthermore, such use cannot be qualified a bona fide offering of goods or services in accordance with paragraph 4(c)(i) of the Policy and the Oki Data test (e.g. Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903) as it is misleading and diverting consumers, making them erroneously believe that the Respondent is an authorized dealer, retailer, or re-seller of GIORDANA products, and is authorized to promote sales of GIORDANA products. This is reinforced by the following facts: (1) the Respondent did not add any note, information or disclaimer pointing out that it actually has no relationship with the Complainant; (2) the website is accessible under a disputed domain name that comprises the Complainant's trademark entirely, together with the terms "shop", which is related to the Complainant's business activity; (3) the Complainant operates the similar domain name <giordanacycling.com>; and (4) the website to which the disputed domain name resolves, reproduces without any authorization the Complainant's trademarks and further uses images which are identical to those displayed on the Complainant's website and allegedly offers for sale products claiming to be from the Complainant at discounted prices. See also WIPO Overview 3.0, section 2.8.1: "Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Oki Data test', the following cumulative requirements will be applied in the specific conditions of a UDRP case: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) the respondent must not try to 'corner the market' in domain names that reflect the trademark. The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark".

It is acknowledged that once the panel finds such prima facie case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

3. According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy). It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant's documented allegations that the disputed domain name resolves to a website allegedly selling the Complainant's GIORDANA branded products, reproducing without any authorization the Complainant's trademarks and further using product images which are identical to those displayed on the Complainant's website.

For the Panel, it is therefore evident that the Respondent knew the Complainant's mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark when it registered the disputed domain name, and likely registered it due to its similarity with the Complainant's trademark and domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the

Complainant’s trademark GIORDANA followed by the term “shop”. Registration of a disputed domain name which contains a third party’s mark, in awareness of the similarity with said mark and in the absence of rights or legitimate interests amounts to registration in bad faith. In the circumstances of this case, the Panel finds that the registration of the disputed domain name was in bad faith.

Finally, the further circumstances surrounding the disputed domain name’s registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see WIPO Overview 3.0 at section 3.2.1):

- (i) the nature of the disputed domain name (a domain name incorporating the Complainant’s mark plus the addition of the term “shop”);
- (ii) the content of the website to which the disputed domain name directs, allegedly selling the Complainant’s GIORDANA branded products, reproducing without any authorization the Complainant’s trademarks and further using images which are identical to those displayed on the Complainant’s website;
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the disputed domain name;
- (iv) the Respondent’s failure to submit a response and to reply to the cease and desist letter.

In light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **giordanashop.com**: Transferred

PANELLISTS

Name	Dr. Federica Togo
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DATE OF PANEL DECISION 2023-04-26

Publish the Decision