

Decision for dispute CAC-UDRP-105420

Case number	CAC-UDRP-105420
Time of filing	2023-05-10 09:55:45
Domain names	itislandstone.shop, it-stoneisland.shop, stoneislandclearance.com, stoneislanddanmark.com, stoneislanddeutschland.com, stoneislandfactoryoutlet.com, stone-islandgr.com, stoneislandireland.com, stoneislandnorge.com, stoneislandoutlet.com, stone-island-outlets.com, stoneislandpolska.com, stoneislandsuomi.com, stoneislandaustralia.com, stoneislandat.com, stoneislanddubai.com, stoneislandph.com, stoneislandsg.com, xn--stoneislandtrkiye-e3b.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	MONCLER S.P.A.
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Complainant representative

Organization	Convey srl
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RESPONDENTS

Organization	Yuan Yan He
Organization	Wen Zhou Fu Jie Jin Rong Xin Xi Fu Wu You Xian Gong Si
Organization	Web Commerce Communications Limited
Name	Stephanie Cole

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 and uses the STONE ISLAND trademark for which it owns a portfolio of registrations worldwide, including

- International Trademark STONE ISLAND, registration number 510222, registered on February 13, 1987 for goods in classes 03, 09, 14, 18, 28, 34;
- International Trademark STONE ISLAND, registration number 709042 on February 02, 1999 - STONE ISLAND – in Cl. 18, 24, 25;
- International Trademark STONE ISLAND, registration number 873957 on November 07, 2005 – STONE ISLAND – in Cl. 28;

- EUTM STONE ISLAND, registration number 003785995 on September 02, 2005 – STONE ISLAND – in Cl. 3, 9, 14, 18, 25;
- EUTM STONE ISLAND, registration number 003785953 on September 02, 2005 – STONE ISLAND – in Cl. 3, 9, 14, 18, 25.

FACTUAL BACKGROUND

The Complainant is a manufacturer of sport equipment and ready-to-wear outerwear.

In addition to the portfolio of trademark registrations described above, the Complainant has also registered several domain names consisting of or comprising the trademark STONE ISLAND under several different TLDs, including <stoneisland.com>, which was registered on July 02, 1997, <stoneisland.it>, registered on November 27, 2002, <stoneisland.cn>, registered on January 25, 2007, <stoneisland.eu>, registered on April 04, 2006. The Complainant's websites (Annex 8) and Social Media accounts (Annex 9) generate a significant number of visits by Internet users every day and are used by the Complainant to promote and also sell online its products.

The nineteen disputed domain names were registered in 2022 and 2023 on the following dates:

1. <stoneislandclearance.com> 2023-03-23;
2. <stoneislanddanmark.com> 2023-03-27;
3. <stoneislanddeutschland.com> 2023-03-20;
4. <stoneislandfactoryoutlet.com> 2023-03-23T
5. <stone-islandgr.com> 2023-03-20
6. <stoneislandireland.com> 2023-03-20
7. <stoneislandnorge.com> 2023-03-20
8. <stoneislandoutlet.com> 2023-03-23
9. <stone-island-outlets.com> 2023-03-23
10. <stoneislandpolska.com> 2023-03-20
11. <stoneislandsuomi.com> 2023-03-20
12. <stoneislandat.com> 2022-09-28
13. <stoneislandaustralia.com> 2023-03-24
14. <ITISLANDSTONE.SHOP> 2023-01-16
15. <IT-STONEISLAND.SHOP> 2022-11-29
16. <xn--stoneislandtrkiye-e3b.com> 2023-03-20
17. <stoneislanddubai.com> 2023-03-28
18. <stoneislandph.com> 2023-03-28
19. <stoneislandsg.com> 2023-03-28

With the exception of <stoneislandoutlet.com> and <stoneislandaustralia.com> each of the disputed domain names resolves to a website entirely dedicated to the sale of goods bearing the STONE ISLAND mark and each having a similar layout.

The disputed domain names <stoneislandoutlet.com> and <stoneislandaustralia.com> are inactive.

There is no information available about the Respondent except for that provided in the Complainant and in the Whois information for the disputed domain names.

PARTIES CONTENTIONS

The Complainant's Contentions

The Complainant claims rights in the STONE ISLAND trademark, established by its ownership of the portfolio of trademark registrations described below and its use of the mark in its sports equipment and garment business since it was established in 1982 in Italy by the Italian designer Massimo Osti, initially as a secondary line to complement his principal brand C.P. Company which he had started in 1971. In 1983 the company sold 50% of the brand to GFT (Gruppo Finanziario Tessile), which acquired the rest of the company in 1991. In 1993 GFT sold the company to Carlo Rivetti who also bought C.P. Company to form Sportswear Company S.p.A..

The Complainant submits that it has spent considerable effort in promoting the STONE ISLAND mark, thereby acquiring the trademark's goodwill and consequently from the mid-1990s the brand has been popular in the football casual subculture in England and throughout the rest of Europe. The brand can be seen in many football-based films such as Green Street Hooligans and The Football Factory. Canadian rapper Drake, the American filmmaker Spike Lee, and the British singer Zayn Malik are also regularly seen wearing STONE ISLAND and they have helped popularize the brand in pop culture.

In order to protect and promote its brand also on the Internet, the Complainant registered several domain names consisting of or

comprising the trademark STONE ISLAND including <stoneisland.com>, which was registered on July 2, 1997, and <stoneisland.it>, which was registered as early as November 27, 2002. The Complainant's websites and social media accounts generate a significant number of visits by Internet users every day.

The Complainant alleges that the disputed domain names are identical or confusingly similar to the STONE ISLAND trademark in which it has rights, arguing that each of the disputed domain names incorporates the whole of the Complainant's trademark STONE ISLAND with non-distinctive elements such as geographical terms and generic commercial terms and in each case the generic Top-Level Domain ("gTLD") <.com>.

The Complainant argues that the additional terms do not affect the confusing similarity.

The Complainant submits that it is a well-established principle that a domain name that wholly incorporate trademarks, in particular one as famous as STONE ISLAND, is confusingly similar for the purposes of the Policy, despite the fact that the disputed domain name may also contain descriptive or generic terms. See for example *Wal-Mart Stores, Inc. v. Henry Chan*, WIPO Case No. D2004-0056 ("chase", "girlsof", "jobsat", "sams", "application", "blackfriday", "blitz", "books", "career(s)", "check", "flw", "foundation", "games", "mart", "photostudio", "pictures", "portrait", "portraitstudio(s)", "registry", "retailink" and "wire" added to WALMART mark).

The Complainant argues that therefore the combination of the trademark STONE ISLAND with generic terms could suggest improperly to consumers that the disputed domain names and the web sites to which they resolve might be directly controlled or authorized by the Complainant.

The Complainant adds that the geographical terms in the disputed domain names cannot be considered enough to distinguish the disputed domain names from the Complainant's mark and argues that they are all the more apt to induce confusion among Internet users. STONE ISLAND is, in fact, an internationally well-known mark in the sector of luxury apparels, and the Complainant's products are sold worldwide. See along these lines *Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI*, WIPO Case No. D2006-0768.

Furthermore, the Complainant contends that the gTLD extensions <.com> and <.shop> are merely instrumental to the use in Internet and do not affect the confusing similarity of the disputed domain names to the Complainant's STONE ISLAND trademark.

The Complainant next alleges that the Respondent has no rights or legitimate interests in the domain names, and argues that as a preliminary note, along the lines set forth in *Pharmacia & Upjohn Company v. Moreonline*, WIPO Case No. D2000-0134 and *National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net*, WIPO Case No. D2000-0118, the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

The Complainant asserts that Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to the registration and use of the disputed domain names.

Upon information and belief, the Respondent is not commonly known by the disputed domain names as an individual, business or other organization and their family names do not correspond to STONE ISLAND or the disputed domain names.

The Complainant adds that the Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services before any notice of the dispute.

The Complainant refers to screen captures of the websites to which all of the disputed domain names, (except the inactive domain names <stoneislandoutlet.com> and <stoneislandaustralia.com>), resolve. The screen captures are exhibited in an annex to the Complaint. The Complainant argues that the exhibited web pages all have similar layouts to the Complainant's own website.

Each of the Respondent's website contains the STONE ISLAND trademark and purport to offer for sale goods that are *prima facie* counterfeit STONE ISLAND branded products. In support of its allegation that the goods offered by Respondent are counterfeit the Complainant argues:

- there is an absence of disclaimers in the Respondent's websites;
- the Respondent has misappropriated copyrighted images from the Complainant's website;
- the goods are sold disproportionately below market value; and
- the Respondent has concealed his identity both on the Whols for the disputed domain names and on the websites to which the disputed domain names resolve;
- the websites to which the disputed domain names resolve have no email and/or physical addresses to contact the Respondent;
- the goods are being offered by Respondent on the website at disproportionately below their market value; for example the Complainant's Long Sleeve Polo is offered for sale for EUR 170,00 but the same polo in a Respondent website is sold for approximately EUR 30,00

Considering that Respondent is using the disputed domain names to sell counterfeit goods, there is no question that Respondent is a *bona fide* reseller of Complainant's products and the issue of when a reseller may use a trademark does not arise.

The Complainant argues that it is evident that the Respondent's use cannot be considered neither a *bona fide* offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names. Such wilful conduct clearly demonstrates, to the

contrary, that Respondent did not intend to use the disputed Domain Names in connection with any legitimate purpose.

Furthermore, the Complainant argues that such use of the disputed domain names cannot be considered a legitimate non-commercial or fair use without intent for commercial gain, because the Respondent is undoubtedly attempting to gain profit from the sales of *prima facie* counterfeit products and it is clear that the Respondent's intention is to benefit from the Complainant's trademarks' reputation to disrupt the Complainant's business and to illegitimately trade on the Complainant's fame for commercial gain. In the *Prada S.A. v. Chen Mingjie*, WIPO Case No. D2015-1466, where the Respondent was using its web site to offer for sale *prima facie* counterfeit PRADA products at prices significantly lower than those of the original products and no disclaimer had been published, the Panel found: "Given the high probability that the goods on offer through the disputed domain name are counterfeit, and the lack of disclosure on the site as to the Respondent's lack of relationship to the Complainant, there is also no evidence of a bona fide offering of goods or services".

The Complainant next alleges that the disputed domain names were each registered in bad faith, without the authority or licence of the Complainant and argues that, in light of the Complainant's registration and intensive use of the trademark STONE ISLAND manufacturing luxury apparel since 1982, the advertising and sales of the Complainant's products worldwide, the Respondent could not have possibly ignored the existence of the Complainant's trademark, confusingly similar to the disputed domain names.

Furthermore, it is argued that the actual knowledge of STONE ISLAND trademark by Respondent at the time of the registration of the disputed domain names is demonstrated by the facts that in most of disputed domain names the Respondent offers for sale replicas of Complainant's goods and that the Respondent also reproduces the trademarks STONE ISLAND on the web sites corresponding to the these disputed domain names.. See *Sportswear Company S.P.A. v. black kobe, kobe black* WIPO Case No. D2014-2252 "The Panel also concludes that the actual use of the Domain Name is in bad faith. The products offered for sale on the Website are counterfeit "Stone Island" products for reasons set out in paragraph 6.D. The use by a respondent of a domain name which includes a well-known trade mark to resolve to a website which offers and sells counterfeit products under that trade mark is evidence of bad faith registration and use").

The Complainant adds that because its sign STONE ISLAND is a famous trademark and, considering the trademark's distinctiveness and well-known character, it is inconceivable that the Respondent was unaware of the existence of the Complainant's registered trademark at the time of the registration of the domain names, with which it is confusingly similar. Therefore, it is clear that the Respondent was well aware of the trademark STONE ISLAND and has registered the disputed domain names intending to refer to the Complainant and to its trademarks. Such registration of a domain name with the knowledge of a complainant's trademark is an evidence of bad faith. *Belstaff S.R.L. v. jiangzheng ying* WIPO Case No. D2012-0793, "the Panel notices that the word "belstaff" is distinctive and the Complainant had expended substantial efforts to create and maintain the reputation of the mark BELSTAFF. Use of the Domain Names by the Respondent took place only long after the trademark BELSTAFF had become well known in the relevant public sector. Therefore, the Respondent should have been aware of the mark BELSTAFF when it applied to register the Domain Names. In this Panel's view, the Respondent's reproduction of the Complainant's trademark BELSTAFF (both word and device trademarks) on the Websites, as well as its offering of purported Belstaff products is sufficient to show that it knew of the BELSTAFF mark when registering the Domain Names. Incorporation of the BELSTAFF mark in the Domain Names without any reasonable justification is sufficient evidence of bad faith by the Respondent".

The Complainant adds that as shown in the screen captures of the websites to which the disputed domain names resolve exhibited in an annex to the Complaint, replicas of the Complainant's STONE ISLAND products are being offered for sale on the active web sites to which the disputed domain names. The Complainant argues that such offerings indicate that the Respondent was fully aware of the Complainant's mark's reputation and were registered with the sole intent to capitalize on the reputation of Complainant's mark by diverting Internet users seeking products under the STONE ISLAND mark to its own commercial web site. As highlighted in *Swarovski Aktiengesellschaft v. Jun Qiao*, WIPO Case No. D2013-1617, "the fact that purported Swarovski goods were offered at the relevant website indicates that the Respondent was fully aware of the Swarovski mark's distinct reputation and association with the Complainant. There is no reason to choose such a distinctive mark, and also to include other terms in a domain name that are suggestive of the very business of the Complainant, other than a bad faith attempt to ride on the coattails of the trademark owner".

Addressing the disputed domain name <stoneislandaustralia.com> which does not resolve to an active web site, which the Complainant submits is confusingly similar to the Complainant's famous trademark STONE ISLAND; and it is registered in the name of the Respondent who has utilized numerous other similar redirected to web sites where counterfeited goods of the Complainant are sold.

Therefore, the Complainant submits, in accordance with the decision of the panel in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 the Respondent has no rights or legitimate interests in respect to any of the domain names, including the ones that are inactive, and this circumstance constitute bad faith registration and use of the inactive websites.

The Complainant concludes that in registering nineteen disputed domain names, each of which is confusingly similar to the trademark STONE ISLAND, the Respondent has been engaged in a pattern of conduct preventing the Complainant from reflecting the mark in corresponding domain names, see *Salvatore Ferragamo S.p.A v. Ying Chou he* WIPO Case No. D2013-2034: "A "pattern of conduct" as required in paragraph 4(b)(ii) of the Policy typically involves multiple domain names directed against multiple complainants, but may also involve multiple domain names directed against a single complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 3.3). Here the latter applies. The fact of registering four domain names that incorporate the Complainant's trademark represents, in the Panel's assessment, a pattern of conduct directed against the Complainant, stopping it from reflecting its trademark in the disputed domain names. The Panel concludes that paragraph 4(b)(ii) of the Policy is made out".

As soon as the Complainant became aware of the Respondent's registration and use of the confusingly similar domain names, it caused

a cease and desist letter to be sent to the Respondent's email indicated in the Whois record for the disputed domain names on April 03, 2023, There was no reply.

In light of the above, the Complainant submits that the all of the disputed domain names were registered and are being used in bad faith in full satisfaction of paragraphs 4(a)(iii) and 4(b) of the Policy.

The Respondent's Contentions

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.

Preliminary issues on Language of the Proceeding and Consolidation

Language:

Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), provides

"10. General Powers of the Panel

(a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

(b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

(c) The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel.

(d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.

11. Language of Proceedings

(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

Complainant requests the Panel to exercise his discretion and decide that notwithstanding that the Registrar has confirmed that Chinese is the language of the registration agreement, that the proceedings should be conducted in English.

Citing previous panels referenced above, Complainant submits that where as here, the disputed domain name has no meaning other than the English term associated with the domain name, the Panel may appropriately determine that the language of the proceeding shall be conducted in English.

Complainant adds that the website to which the disputed domain name resolves is in the English language and Respondent has chosen Cloudflare, based in San Francisco, California to provide a server for the website, and to do so conducts its business with Cloudflare in English, so therefore Respondent has sufficient knowledge to understand the English Language. Further, because having to translate would unfairly burden Complainant.

Having regard to Rules rr. 10-11 and having considered the submissions of Complainant, this Panel agrees and finds that it is appropriate that this proceeding should be conducted in English as requested, notwithstanding that r.11(a) designates Chinese, being the language of the registration agreement as the default language of the proceedings,

The reasons for the Panel's decision is that the record shows that Respondent either understands and carries on its business in the English language or has at its disposal resources which permits it create, maintain and host an English language website; proceeding in English will not prejudice the Respondent, but proceeding in Chinese would impose a burden on Complainant; the website to which the disputed domain name resolves is in the English language.

Furthermore this Panel is satisfied and finds that for the same reasons, Respondent has not been prejudiced by service of documents in this proceeding in the English language, and its failure to engage with this proceeding or to file any timely response is not due to any inability to understand the documents served to date.

Consolidation of Proceeding

Notwithstanding that there are multiple registrants of the disputed domain names, and they are on two gTLDs, viz <.com> and <.shop>. Each of the disputed domain names, was registered in close proximity of time to each other and each has the same or similar format with the STONE ISLAND mark as its initial and dominant element in combination with either a geographical placename or a reference to retail services. The similarity is more than coincidental. On the balance of probabilities therefore all of the disputed domain names are under the control of a single person, or group of people acting in concert. For that reason, it is appropriate to consolidate the complaints in a single proceeding.

PRINCIPAL REASONS FOR THE DECISION

Complainant's Rights

Complainant has provided convincing, uncontested evidence that it has rights in the STONE ISLAND mark, established by the ownership of the portfolio of trademark registrations described above.

Furthermore, the Complainant's uncontested evidence is that the Complainant has extensively used the mark in its sports equipment and garment business since it was established in 1982.

Confusing Similarity

The disputed domain names can be usefully separated into three categories namely

- where the disputed domain name consists of the STONE ISLAND mark in combination with a geographical placename and the gTLD extension <.com>, namely, <stoneislanddanmark.com>, <stoneislanddeutschland.com>, <stoneislandireland.com>, <stoneislandnorge.com>, <stoneislandpolska.com>, <stoneislandsuomi.com>, <stoneislandaustralia.com>, <stoneislanddubai.com>, <stoneislandsg.com>;
- where the disputed domain name consists of the STONE ISLAND mark in combination with descriptive terms, each of which is a generic reference to retail outlets and sales, namely <stoneislandclearance.com>, <stoneislandfactoryoutlet.com>, <stoneislandoutlet.com>, <stone-island-outlets.com>;
- where the disputed domain name consists of the STONE ISLAND mark in combination with terms that in the absence of an explanation are not immediately recognizable, namely <stone-islandgr.com>, <stoneislandat.com>, <stoneislandph.com>, <itistlandstone.shop>, <it-stoneisland.shop>, and <xn--stoneislandtrkiye-e3b.com>.

In the later category, the letters "gr" in <stone-islandgr.com> might well be taken as a reference to Greece. The element "trkiye" is most probably a reference to the Republic of Türkiye in the domain name <xn--stoneislandtrkiye-e3b.com> but it is included in the third category because the other elements "xn-" and "-3b" have no obvious meaning. Also perhaps the element "it" in <itistlandstone.shop> and <it-stoneisland.shop> might well be considered a reference to Italy, and so might be included in the first category, but that is not necessarily the case.

In each case, the Complainant's STONE ISLAND mark is the dominant and only distinctive element in the disputed domain name. The other elements have no distinguishing characteristic, and in none of the disputed domain names does the presence of the additional terms prevent a finding that the disputed domain name is confusingly similar to the STONE ISLAND mark in which the Complainant has rights.

Similarly, in each case, the presence of the gTLD extensions <.com> or <.shop> in the disputed domain name, prevents a finding of confusing similarity, because, within each of disputed domain name that is the subject of this proceeding, it would be considered to be a necessary technical requirement for a domain name registration,

This Panel finds therefore that the disputed domain names and each of them is confusingly similar to the STONE ISLAND mark, and Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

The Complainant has made out a *prima facie* case that Respondent has no rights legitimate interests in any of the disputed domain names arguing that

- the Respondent is not a licensee nor authorized agent of the Complainant; nor is it any other way authorized to use the Complainant's trademarks;
- the Respondent is not an authorized reseller of the Complainant and has not been authorized to the registration and use of the disputed domain names;
- upon information and belief, the Respondent is not commonly known by the disputed domain names as individual, business or other organization and their family names do not correspond to STONE ISLAND or the domain names;
- the Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute;
- the screen captures annexed to the Complaint show that, aside from the two inactive disputed domain names <stoneislandoutlet.com> and <stoneislandaustralia.com>, resolve, the rest of the disputed domain names redirect to websites with similar layouts where the Complainant's trademark STONE ISLAND is published and on which products which are prima facie counterfeit STONE ISLAND branded products are offered for sale.
- The Complainant, still referring to the screen captures argues that In light of the following circumstances is evident that the goods offered for sale are counterfeit, namely,
- the absence of disclaimers in the Respondent's websites;
- the Respondent has misappropriated copyrighted images from the Complainant's website;
- the goods are sold disproportionately below market value;
- the Respondent has concealed his identity both on the Whols and on the websites to which the disputed domain names resolve, where there are not emails and/or physical addresses to contact the Respondent.
- Furthermore the Complainant argues that the test in the well known decision Oki Data shows that the Respondent's use of the disputed domain names cannot be considered either a bona fide offering of goods or services or a legitimate non-commercial or fair use of any of the active disputed domain names;
- such wilful conduct clearly demonstrates, to the contrary, that Respondent did not intend to use the disputed domain names in connection with any legitimate purpose;
- furthermore the Respondent does not have a legitimate non-commercial or fair use without intent for commercial gain, because the Respondent is undoubtedly attempting to gain profit from the sales of prima facie counterfeit products and it is clear that the Respondent's intention is to benefit from the Complainant's trademarks' reputation to disrupt the Complainant's business and to illegitimately trade on the Complainant's fame for commercial gain.

It is well established that once a complainant makes out a *prima facie* case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that Respondent has no rights or legitimate interests in an of the disputed domain names.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

The Complainant has adduced clear and convincing, uncontested evidence that it has trademark and service mark rights in the STONE ISLAND mark which predate the registration and first use of the disputed domain names in 2022 and 2023.

The Complainant has shown that it has acquired a substantial international reputation and goodwill in the mark by extensive use, advertising and promotion.

Each of the disputed domain names have the Complainant's STONE ISLAND name and mark as its dominant and only distinctive feature.

Furthermore the evidence inevitably leads to the conclusion that on the balance of probabilities all of the disputed domain names are registered and controlled by the same person or persons.

It is therefore most improbable that the registrant of the disputed domain name was unaware of the Complainant, its mark and its products, when the disputed domain name was chosen and registered.

Given the extent of the Complainant's reputation and goodwill in the STONE RIVER mark, on the balance of probabilities each of the disputed domain name was registered in bad faith with Complainant with the intention of taking predatory advantage of the Complainant's goodwill.

The use to which all but two of the marks have been put since registration, each resolving to a website which purports to offer goods bearing the Complainant's brand is supportive of this finding.

The Complainant has argued that the goods offered on the websites to which all but two of the disputed domain names resolve are counterfeit. In the absence of any response or denial, and given the strong arguments put forward by the Complainant, and in particular the extremely low discounts which the Respondent purports to offer, this Panel finds that on the balance of probabilities the goods which the Respondent purports to offer for sale using the STONE RIVER mark as the dominant element in the website addresses, are counterfeit.

If this is not the case then, the grossly uneconomic discounts offered by Respondent. means that on the balance of probabilities the

Respondent has no intention of actually supplying the goods which are purportedly offered on the website.

In either case the disputed domain names, which resolve to websites (i.e. all except <stoneislandoutlet.com> and <stoneislandaustralia.com>) are being used in bad faith to resolve to websites which falsely purport to offer for sale Complainant's STONE ISLAND branded products.

Such use of the those disputed domain names that are active and resolve to the active websites described above, to attract, confuse and divert Internet traffic and to deceive Internet users constitutes use in bad faith for the purposes of the Policy.

The evidence adduced proves on the balance of probabilities that all of the disputed domain names including the inactive <stoneislandoutlet.com> and <stoneislandaustralia.com> are owned by and under the control of the same individual or individuals.

It follows therefore, that given that each of the disputed domain names contains the Complainant's mark in its entirety, the passive holding of <stoneislandoutlet.com> and <stoneislandaustralia.com> constitutes use in bad faith for the purposes of the Policy.

As this Panel has found that each of the disputed domain names was registered and is being used in bad faith, Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii) in respect of each of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **itislandstone.shop**: Transferred
- 2. **it-stoneisland.shop**: Transferred
- 3. **stoneislandclearance.com**: Transferred
- 4. **stoneislanddanmark.com**: Transferred
- 5. **stoneislanddeutschland.com**: Transferred
- 6. **stoneislandfactoryoutlet.com**: Transferred
- 7. **stone-islandgr.com**: Transferred
- 8. **stoneislandireland.com**: Transferred
- 9. **stoneislandnorge.com**: Transferred
- 10. **stoneislandoutlet.com**: Transferred
- 11. **stone-island-outlets.com**: Transferred
- 12. **stoneislandpolska.com**: Transferred
- 13. **stoneislandsuomi.com**: Transferred
- 14. **stoneislandaustralia.com**: Transferred
- 15. **stoneislandat.com**: Transferred
- 16. **stoneislanddubai.com**: Transferred
- 17. **stoneislandph.com**: Transferred
- 18. **stoneislandsg.com**: Transferred
- 19. **xn--stoneislandtrkiye-e3b.com**: Transferred

PANELLISTS

Name	James Bridgeman
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DATE OF PANEL DECISION	2023-06-18
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Publish the Decision