

Decision for dispute CAC-UDRP-105462

Case number	CAC-UDRP-105462
Time of filing	2023-05-31 10:07:17
Domain names	berettafirearmsusa.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Fabbrica d'Armi Pietro Beretta S.p.A.
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Complainant representative

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

Organization	Guide Mail
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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 has provided evidence of ownership of the following trademark registrations:

- International trademark registration No. 147879 for BERETTA (word mark), registered on July 07, 1950, in international classes 8 and 13;
- International trademark registration No. 746766 for BERETTA (word mark), registered on November 08, 2010, in international class 9;
- European Union trademark registration No. 9743543 for BERETTA (word mark), filed on February 17, 2011 and registered on June 28, 2011, in international classes 08, 09, 13, 14, 18, 25 and 34;
- European Union trademark registration No. 3801537 for BERETTA (word mark), filed on April 28, 2004 and registered on August 19, 2005, in international class 28.

FACTUAL BACKGROUND

The Complainant in the present dispute is Fabbrica d'Armi Pietro Beretta, a privately held Italian firearms manufacturing company, founded in 1526 by Mastro Bartolomeo Beretta.

By the end of the 17th century, the Complainant had become the second largest gun barrel maker and has supplied weapons for every major European war since 1650.

Nonetheless, the Complainant has been owned by the same family for almost five hundred years and is a founding member of "Les Henokiens", an association of bicentenary companies that are family owned and operated.

In 1918, the Beretta Model 1918, one of the first submachine guns in the world, was fielded by the Italian army: the Complainant manufactured rifles and pistols for the Italian military until the 1943 Armistice between Italy and the Allied forces during World War II; with the Wehrmacht's control of northern Italy, the Germans seized the Complainant and continued producing arms until the 1945 German surrender in Italy.

After the war, the Complainant continued to develop firearms for the Italian Army and police, as well as the civilian market.

The success of the Complainant is not at all limited to European market: in the 1980s, BERETTA enjoyed a renewal of popularity in North America after its Beretta 92 pistol was selected as the service handgun for the United States Army under the designation of "M9 pistol"; in the 1970s, the Complainant also started a manufacturing plant in São Paulo, Brazil, as a contract between the Complainant and the Brazilian government was signed for the production of Beretta 92s for the Brazilian Army until 1980.

The parent company, Beretta Holding, also owns Beretta USA, and acquired several domestic competitors (such as Benelli and Franchi) and some foreign companies, including SAKO, Stoeger, Tikka, Uberti, and the Burris Optics company.

Nowadays BERETTA firearms are used worldwide for a variety of civilian, law enforcement and military purposes: the Complainant is known for the innovative technology of its products; sporting arms account for three-quarters of sales, however it is also renown for other products such as the marketing shooting clothes and accessories.

Beretta Holding closed the 2021 with 958 million Euro of revenue, of which 250 million Euro has been generated by the Complainant and more than 3380 employees, based not only in Europe but also in Australia, New Zealand, Russia, Turkey, United States and China.

Presently still operating in several countries worldwide, the Complainant is to date the oldest active manufacturer of firearm components in the world.

The Complainant is also the owner of the domain name <beretta.com>, registered on March 18, 1997 and pointed to the website "www.beretta.com", used by the Complainant to promote its BERETTA firearm products.

The disputed domain name <berettafirearmsusa.com> was registered on September 21, 2021 and currently resolves to a website publishing BERETTA trademarks and offering BERETTA firearms at discounted prices.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant states that the disputed domain name <berettafirearmsusa.com> is confusingly similar to its trademark BERETTA, as it reproduces the trademark in its entirety with the sole addition of the descriptive term "firearms", the geographical indicator "usa" (to indicate the United States) and the generic TLD ".com", which is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name because the Respondent is in no way related to the Complainant and has never received any approval of the Complainant (or the other related parties), expressed or implied, to use its trademarks or any other trademark identical or confusingly similar to such trademarks, nor to register any domain name identical or confusingly similar to such marks.

The Complainant further underlines that the Respondent is not commonly known by the disputed domain name since it never acquired any rights in a trademark or trade name corresponding to the disputed domain name.

Moreover, the Complainant emphasizes that the Respondent is using the disputed domain name to publish BERETTA trademarks and official images without any authorization, to offer for sale clearly counterfeit goods and submits that, in doing so, the Respondent is not using the disputed domain name for a *bona fide* offering of goods or services, nor for a legitimate or fair use under the UDRP Policy.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering its prior registration of the trademark BERETTA and its world renown, distinctiveness and reputation, it is highly unlikely that the Respondent registered the disputed domain name without actual knowledge of BERETTA and its rights in such trademarks. The Complainant submits that it is highly likely instead, that the Respondent intentionally registered the disputed domain name to attract internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant and its trademarks.

The Complainant also reaffirms that the disputed domain name has been used to publish, without consent from the Complainant, BERETTA trademarks, official promotional images and products, at extremely discounted prices and without disclosing in any way the lack of relationship with the Complainant on its website.

RESPONDENT

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. The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark BERETTA as it reproduces the trademark in its entirety with the mere addition of the descriptive term "firearms", the geographical indicator "usa" (acronym of "United States") and the generic TLD ".com", which can be disregarded for the purpose of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a prima facie case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred.

Indeed, the Complainant stated that the Respondent is not related in any way with the Complainant, that it does not carry out any activity for, nor has any relationship with the Complainant. The Panel also notes that, based on the records, there is no evidence that the Respondent might be commonly known by the disputed domain name.

Moreover, the Panel finds that the Respondent's use of the disputed domain name in connection with the offer for sale of heavily discounted firearms under the trademark BERETTA, without providing any disclaimer of non-affiliation with the Complainant, does not amount to a *bona fide* offering of goods or services. Furthermore, the Respondent's use of the disputed domain name is, and has been, clearly commercial in nature, as the Respondent has clearly aimed at gaining revenues from the sales of the purported BERETTA firearms featured on its website.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the prior use of the Complainant's trademark BERETTA in connection with the promotion and sales of the Complainant's firearms and related clothing also online through the Complainant's website "www.beretta.com" and considering that the disputed domain name combines the Complainant's trademark with the descriptive term "firearms", which directly refers to the Complainant's field of activity, the Respondent very likely registered the disputed domain name having the Complainant's trademark in mind.

The Panel also notes that the Respondent's use of the disputed domain name in connection with an online store offering firearms under the trademark BERETTA without displaying any disclaimer of non-affiliation with the Complainant amounts to bad faith under paragraph 4(b)(iv) of the Policy, since the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the products advertised therein.

Therefore, the Panel finds that the Respondent's registration and use of the disputed domain name amounts to bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **berettafirearmsusa.com**: Transferred

PANELLISTS

Name	Luca Barbero
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DATE OF PANEL DECISION	2023-07-07
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Publish the Decision