Decision for dispute CAC-UDRP-105776

Case number	**CAC-UDRP-105776**
Time of filing	**2023-09-20 09:22:19**
Domain names	**loropianaargentina.com, loropiana-australia.com, loropiana-belgie.com, loropianabudapest.com, loropiana-colombia.com, loropiana-danmark.com, loropianaegypt.com, loropiana-greece.com, loropianahelsinki.com, loropiana-hrvatska.com, loropiana-india.com, loropiana-ireland.com, loropiana-israel.com, loropiana-italia.com, loropiana-japan.com, loropiana-ksa.com, loropiana-malaysia.com, loropiana-nederland.com, loropiana-norge.com, loropianaparis.com, loropianaperu.com, loropiana-philippines.com, loropiana-portugal.com, loropiana-singapore.com, loropianasrbija.com, loropianasverige.com, loropiana-turkiye.com, loropiana-uae.com, loropiana-uk.com, loropiana-usa.com, loropiana-romania.com, loropiana-schweiz.com, loropianaaustralia.net, loropianacanada.net, loropianaireland.net, loropiananz.net, loropianauk.net, loropianabelgie.net, loropianaitalia.net, loropiananederland.net, loropiananorge.net, loropianabelgique.com, loropianabrasil.com, loropianasuisse.com, loropianauruguay.com, loropianachile.net, loropianacz.net, loropianacolombia.net, loropianahrvatska.net, loropianagreece.net, loropianapolska.net, loropianaportugal.net, loropianaromania.net, loropianaslovenia.net, loropianaask.net, loropianabulgaria.com, loropianaestonia.com, loropianahungary.com, loropianalatvija.com, loropianakuwait.com, loropianalietuva.com, loropianadanmark.net, loropianadeutschland.net, loropianafrance.net, loropianaschweiz.net, loropianasouthafrica.net, loropianasuomi.net, loropianaisrael.net, loropianajapan.net, loropianauae.net, loropianaperu.net, loropianasrbija.net, loropianasverige.net**

Case administrator

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

Complainant

Organization	**Loro Piana S.p.A.**

Complainant representative

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

Respondents

Organization	**Web Commerce Communications Limited**
Name	**Alexandra Lane**
Name	**Oscar Gibson**
Name	**Katherine Richards**

Name	**Connor Gould**
Name	**Tilly Scott**
Name	**Oscar Gibson**
Name	**Alice Buckley**
Name	**Madeleine Cooper**

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 is inter alia owner of EU trademark registration no. 018162715 "Loro Piana <fig.>", registered on May 22, 2020, in class 25 (hereinafter referred to as the "Trademark").

FACTUAL BACKGROUND

The Complainant is an Italian company specializing in clothing and textile products. It is considered one of the largest cashmere manufacturers and the world's leading artisan company processing luxury fibres. The Complainant today has a total of 152 stores, of which 135 are directly operated. The company reached the 1-billion-euro sales mark in 2019, and revenues in 2021 are forecast to surpass the 2019 figures. The Complainant provides information on its company and offers its products online at www.loropiana.com.

The disputed domain names were registered on August 4, 2023, August 7, 2023, August 8, 2023, and August 10, 2023, respectively. These domains have partly been utilized to host active websites that prominently feature the protected Loro Piana device logo and showcase copyrighted pictures taken from the Complainant’s official website.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to the Trademark. They argue that they all contain the well-known Trademark combined with geographic or generic words, which do not exclude a similarity with the Trademark but rather increase the likelihood of confusion.

Additionally, the Complainant argues that the Respondent lacks rights or legitimate interests in the disputed domain names. Specifically, they state that the Respondent is no authorized dealer, agent, distributor, or reseller of the Complainant's products nor that they are authorized to register and use the Trademark in a domain name. The Complainant further contends that a total number of 32 of the disputed domain names lead to active websites that reproduce part of the images of the Complainant’s official marketing campaigns and that the layout of the Respondent's fake websites is very similar to the layout of the Complainant’s official website. The Complainant also points to the fact that the websites prominently feature the Complainant’s Loro Piana device logo and therefore aim to mislead potential consumers in order to push consumers to purchase counterfeit goods. With regard to the inactive domain names, the Complainant argues that these domain names are neither used for a bona fide offering of goods and services nor in relation to a legitimate noncommercial activity.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. They state that the Respondent registered domain names containing a very well-known trademark without any authorization from the trademark holder and is partly using the domain names in connection with fake websites. As a result, the Respondent registered the disputed domain names in bad faith. With regard to bad faith use, the Complainant argues that some of the disputed domain names redirect to websites that offer counterfeit goods, and unduly depict copyrighted pictures taken from the Complainant’s official website and that these disputed domain names are being used to intentionally attract for commercial gain, Internet users to the Respondent’s web sites, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s web site and of a product or service on the Respondent’s web site or location. As regards the inactive domain names, they argue that such domain names are used in bad faith through passive holding because the reputation of the Trademark combined with the fact that the Trademark is associated with geographical terms makes it very improbable that the use of the disputed domain names would not infringe the Trademark.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 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 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. Preliminary Issue: Consolidation of Respondents

Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 4.11.1, paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. When considering a complaint filed against multiple respondents, section 4.11.2 of the WIPO Overview 3.0 states that “panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario”.

In light of the Complainant's request to consolidate the multiple Respondents, the Panel concludes that the disputed domain names are indeed under common control for the following reasons:

- All the disputed domain names were registered within a span of only six days using the same registrar.
- The disputed domain names share a similar pattern in their construction, with the addition of geographical terms, such as countries, cities, or abbreviations of state names to the Trademark.
- A total number of 32 of the disputed domain names show identical websites and are, according to the whois information, registered by the same entity in Kuala Lumpur, MY.
- All of the inactive domain names are, according to the whois information, registered by natural persons from Italy and France, respectively, namely Alexandra Lane from Venezia (5 domain names), Oscar Gibson from Venezia (10 domain names), Katherine Richards from Portofino (4 domain names), Connor Gould from Venezia (10 domain names), Tilly Scott from Portofino (6 domain names), Alice Buckley from Venezia (3 domain names), and Madelaine Cooper from Paris (3 domain names). However, the whois information of all of the inactive domain names shows a pattern as well given that all of the e-mail addresses used by the domain owners are registered under the domain name "cxtmail.com" and are all made up in the same pattern, namely using the first name and the second name of the domain owner followed by a number.

From the above, it suggests the assumption that, at the very least, the 32 active domain names on one side and the 41 inactive domain names on the other are under common control.

However, given that all of the disputed domain names are equally registered with "Alibaba.Com Singapore E-Commerce Private Limited", which is, in the panel's experience, not too common a registrar for domain holders from Italy and France, and given that at least one of the inactive domain names is registered on the very same day as some of the actives ones (e.g. the domain name

<loropiana-singapore.com> and 28 of the inactive domain names have been registered on August 7, 2023), it is more likely than not for the Panel, taking into account all the circumstances of the specific case, that all of the disputed domain names are under common control.

Furthermore, the Respondent has not contested or provided any rebuttal regarding the consolidation request made by the Complainant. Therefore, the Panel finds that consolidation would be fair and equitable, and henceforth refers to the four registrants collectively as the "Respondent" throughout this decision.

2. Substantive Issues

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

(i) the disputed domain names are identical or confusingly similar to the Complainant's trademark; and
(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
(iii) the disputed domain names have been registered and are being used in bad faith.

2.1 The Panel accepts that the disputed domain names are confusingly similar to the Trademark as they fully include the verbal elements of the Trademark. It is well established that a domain name that wholly incorporates a trademark may be confusingly similar to such a trademark for purposes of the Policy despite the addition of geographical identifiers like the ones used in the present case. Likewise, the fact that the Trademark includes additional graphical elements does not hinder a finding of confusing similarity under the Policy. Graphic elements, not being reproducible in a domain name, need not be considered when assessing identity or confusing similarity.

2.2 The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain names. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent did not deny these assertions in any way and therefore failed to prove any rights or legitimate interests in the disputed domain names.

Based on the evidence on file, the Panel cannot find any rights or legitimate interests of the Respondent either. In particular, the Panel finds that the Respondent's websites do not meet the Oki Data criteria as the Respondent, at least, has not disclosed its total lack of relationship or connection to the Complainant but rather prominently featured the Complainant's protected Loro Piana device logo, which gives the false impression that the pages were at least authorized by the Complainant. Accordingly, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in respect of the disputed domain names under paragraphs 4(a)(ii) and 4(c) of the Policy.

2.3 The Panel is also satisfied that the Respondent registered the disputed domain names with full knowledge of the Complainant and its rights in the Trademark as the Respondent is using four of the disputed domain names to forward Internet users to a website which includes the Complainant's protected Loro Piana device logo.

As to bad faith use, by using 32 of the disputed domain names in connection with the websites mentioned above, the Respondent was, in all likelihood, trying to divert traffic intended for the Complainant’s website to its own for commercial gain as set out under paragraph 4(b)(iv) of the Policy. Furthermore, with regard to the disputed domain names, which have not been used in connection with an active website so far, the Panel finds that the circumstances in the present case support a finding that such domain names are to be considered to be used in bad faith under the Policy under the passive holding doctrine. The Trademark is well established, the Respondent failed to submit a response or to provide any evidence of actual or contemplated good-faith use, and, in the present case, the Panel assumes that a good-faith use of the domain names is implausible.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **loropianaargentina.com**: Transferred
2. **loropiana-australia.com**: Transferred
3. **loropiana-belgie.com**: Transferred
4. **loropianabudapest.com**: Transferred
5. **loropiana-colombia.com**: Transferred
6. **loropiana-danmark.com**: Transferred
7. **loropianaegypt.com**: Transferred
8. **loropiana-greece.com**: Transferred
9. **loropianahelsinki.com**: Transferred
10. **loropiana-hrvatska.com**: Transferred
11. **loropiana-india.com**: Transferred
12. **loropiana-ireland.com**: Transferred

13. **loropiana-israel.com**: Transferred
14. **loropiana-italia.com**: Transferred
15. **loropiana-japan.com**: Transferred
16. **loropiana-ksa.com**: Transferred
17. **loropiana-malaysia.com**: Transferred
18. **loropiana-nederland.com**: Transferred
19. **loropiana-norge.com**: Transferred
20. **loropianaparis.com**: Transferred
21. **loropianaperu.com**: Transferred
22. **loropiana-philippines.com**: Transferred
23. **loropiana-portugal.com**: Transferred
24. **loropiana-singapore.com**: Transferred
25. **loropianasrbija.com**: Transferred
26. **loropianasverige.com**: Transferred
27. **loropiana-turkiye.com**: Transferred
28. **loropiana-uae.com**: Transferred
29. **loropiana-uk.com**: Transferred
30. **loropiana-usa.com**: Transferred
31. **loropiana-romania.com**: Transferred
32. **loropiana-schweiz.com**: Transferred
33. **loropianaaustralia.net**: Transferred
34. **loropianacanada.net**: Transferred
35. **loropianaireland.net**: Transferred
36. **loropiananz.net**: Transferred
37. **loropianauk.net**: Transferred
38. **loropianabelgie.net**: Transferred
39. **loropianaitalia.net**: Transferred
40. **loropiananederland.net**: Transferred
41. **loropiananorge.net**: Transferred
42. **loropianabelgique.com**: Transferred
43. **loropianabrasil.com**: Transferred
44. **loropianasuisse.com**: Transferred
45. **loropianauruguay.com**: Transferred
46. **loropianachile.net**: Transferred
47. **loropianacz.net**: Transferred
48. **loropianacolombia.net**: Transferred
49. **loropianahrvatska.net**: Transferred
50. **loropianagreece.net**: Transferred
51. **loropianapolska.net**: Transferred
52. **loropianaportugal.net**: Transferred
53. **loropianaromania.net**: Transferred
54. **loropianaslovenia.net**: Transferred
55. **loropianaask.net**: Transferred
56. **loropianabulgaria.com**: Transferred
57. **loropianaestonia.com**: Transferred
58. **loropianahungary.com**: Transferred
59. **loropianalatvija.com**: Transferred
60. **loropianakuwait.com**: Transferred
61. **loropianalietuva.com**: Transferred
62. **loropianadanmark.net**: Transferred
63. **loropianadeutschland.net**: Transferred
64. **loropianafrance.net**: Transferred
65. **loropianaschweiz.net**: Transferred
66. **loropianasouthafrica.net**: Transferred

67. **loropianasuomi.net**: Transferred
68. **loropianaisrael.net**: Transferred
69. **loropianajapan.net**: Transferred
70. **loropianauae.net**: Transferred
71. **loropianaperu.net**: Transferred
72. **loropianasrbija.net**: Transferred
73. **loropianasverige.net**: Transferred

PANELLISTS

Name	**Peter Müller**

DATE OF PANEL DECISION 2023-10-24

Publish the Decision