Decision for dispute CAC-UDRP-106220

Case number	CAC-UDRP-106220
Time of filing	2024-02-07 09:49:55
Domain names	diadoraargentina-outlet.com, diadoracostarica.com, diadora-japan.com, diadora-schweiz.com, diadora-slovenija.com, diadora-uae.com, diadoraitalian.com, diadoraoutletperu.com, diadora-srbija.com, diadoraargentinastore.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Diadora S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Organization	Web Commerce Communications Limited

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 relies on its registered trademarks:

Mark	Territory	Registration No.	Application Date	Registration Date	Classes
DIADORA	WIPO Designations: CN	682095A	July 31, 1997	July 31, 1997	3, 9, 12, 14, 16, 18, 25, 28

DIADORA	WIPO Designations: FI, GB, GR, LT, UZ, AL, AM, AT, AZ, BA, BG, BX, BY, CH, CU, CZ, DE, DZ, EG, ES, FR, HR, HU, KG, KP, KZ, LI, LR, LS, LV, MA, MC, MD, ME, MK, MN, MZ, PL, PT, RO, RS, RU, SD, SI, SK, SM, SZ, TJ, UA, VN	682095	July 31, 1997	July 31, 1997	3, 9, 12, 14, 16, 18, 25, 28
DIADORA	EM	000339093	July 15, 1996	January 7, 1999	18, 25, 28
DIADORA MARCHIO FIGURATIVO	IT	0001297135	February 5, 2008	May 31, 2010	18, 25, 28
DIADORA	US	2282558	Sep. 25, 1997	Oct. 05, 1999	18, 25, 28

Further, the Complainant operates its business using its domain names <diadora.com>, registered since October 01, 1998 and <diadora.cn>, registered since May 21, 2014.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Key aspects of the Complainant's contentions are summarized below.

Complainant's Background

The Complainant is an Italian athletic footwear and apparel manufacturer that was established in 1948 by Marcello Danieli, who named the company "Diadora" based on the Greek phrase "dia dora," meaning "by means of gifts." Initially known for mountain climbing boots, the Complainant expanded its DIADORA product line to include ski boots, running shoes, tennis shoes, and football boots, collaborating with renowned athletes. In 2009, DIADORA was acquired by Mario Moretti Polegato, founder of Geox, leading to a collaboration aimed at creating comfortable and technologically advanced work shoes. The Complainant's DIADORA products have also been featured in major sports events, including the Roland-Garros tennis championship and the 2016 Olympic Games in Rio de Janeiro.

Registration of the disputed domain names

According to the Complainant, the disputed domain names <diadoraargentina-outlet.com>, <diadoracostarica.com>, <diadora-japan.com>, <diadora-slovenija.com>, <diadora-uae.com>, <diadoraitalian.com>,<diadoraoutletperu.com>,<diadora-srbija.com> were registered on June 29, 2023, <diadora-schweiz.com> was registered on March 24, 2023 and <diadoraargentinastore.com> was registered on May 25, 2023.

First UDRP Element - disputed domain name is Confusingly Similar to the Complainant's Trademark

The Complainant asserts that the disputed domain names are confusingly similar to its trademark DIADORA by incorporating the entire trademark DIADORA, along with generic commercial and geographical terms. The addition of geographical terms may exacerbate confusion among Internet users, given DIADORA's international recognition and the Complainant's global presence. The combination of DIADORA with generic and geographical terms could suggest improperly to consumers that the disputed domain names and corresponding web sites might be directly controlled or authorized by the Complainant.

Furthermore, the Complainant contends that the addition of the gTLD ".COM" is merely instrumental to the use in Internet and does not affect the confusing similarity of the disputed domain names t to the Complainant's trademark.

Second UDRP Element – The Respondent has no Rights or Legitimate Interests in the disputed domain names

The Complainant asserts that the Respondent is not known as the disputed domain names.

Further, the Respondent is not a licensee, authorized agent, or related in any way to the Complainant, nor is authorized in any way to use the Complainant's trademarks or to register or use the disputed domain names.

The Complainant claims there is no evidence of demonstrable preparations to use nor actual use of the disputed domain names in connection with a bona fide offering of goods or services. Rather, the disputed domain names currently have inactive content, although they previously resolved to websites, all with similar layouts, where the Complainant's trademarks DIADORA were published. Such wilful conduct demonstrates the Respondent did not intend to use the disputed domain names in connection with any legitimate purpose. The Complainant also claims that 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 DIADORA or the disputed domain names.

Third UDRP Element – The disputed domain names were Registered and are Being Used in Bad Faith

The Complainant asserts that its DIADORA trademark has become a well-known trademark in the sector of manufacturing footwear, and that a past domain name dispute panel has confirmed the notoriety of the trademark DIADORA. Furthermore, the actual knowledge of the DIADORA trademark by Respondent at the time of the registration of the disputed domain names is demonstrated by the Respondent's use thereof in connection with the promotion of the Complainant's trademark and products, prior to the Complainant's cease and desist letter to the Respondent.

Considering the trademark's distinctiveness and well-known character, it is inconceivable that the Respondent was unaware of the existence of the Complainant's DIADORA trademark at the time of the registration of the disputed domain names, with which they are confusingly similar.

By registering the disputed domain names at issue, confusingly similar to the trademark DIADORA, the Respondent has been engaged in a pattern of conduct preventing the Complainant from reflecting the mark in corresponding domain names. Further, the Respondent has targeted the Complainant through the registration of ten domain names including the trademark DIADORA.

The Respondent's failure to respond to the Complainant's cease and desist letter is an additional circumstance of bad faith.

Although the disputed domain names do not currently resolve to active content, the passive holding doctrine - which finds that a domain name registrant can act in bad faith absent active use of a domain name as described in WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows – applies because the trademark DIADORA is widely known and, in light of its use, has become well-known worldwide. The disputed domain names at issue are registered without indication of the actual holder and the Respondent has not replied to the cease and desist letter and they have not revealed their identity following the receipt thereof. In light of the above, it is impossible to conceive of any plausible active use of all the disputed domain names by the Respondent.

The above summarized facts and arguments asserted by the Complainant are not contested by the Respondent because no Response was filed.

PARTIES CONTENTIONS

The 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 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

LANGUAGE OF PROCEEDING

According to Rule 11 in the Rules for Uniform Domain Name Dispute Resolution Policy, (the "Rules") "...the language of 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."

According to the information on the case file, the Registrar confirmed that the Respondent is the current registrant of the disputed domain names, and that the language of the registration agreements is English.

As neither party has asked to deviate from the English language as per the registration agreements, the Panel finds that this proceeding may be properly conducted in English.

PRINCIPAL REASONS FOR THE DECISION

THREE ELEMENTS THE COMPLAINANT MUST ESTABLISH UNDER THE POLICY

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term DIADORA in numerous classes and territories around the world. Such trademark rights were created and registered long prior to March 24, May 25, and June 29 in 2023, the respective creation dates of the disputed domain names. A nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Accordingly, the Panel finds that the Complainant possesses rights in its DIADORA trademark such that it has standing under the Policy.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) ("the mere addition of the words ‚Ninjago' and ‚Kai' is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant's trademark.").

In the present case, the disputed domain names consist of the DIADORA trademark reproduced in its entirety with the addition of the geographic terms "argentina", "costa rica", 'japan'', ''slovenija'', "uae'', "peru'', "srbija", "schweiz", "italian" and the generic but related terms ,´´outlet'' and ´´store´´. In assessing confusing similarity, the Panel finds the disputed domain names are confusingly similar to the Complainant's trademark, because they incorporate the entirety of the DIADORA trademark, and differ from such mark merely by respectively adding the aforementioned geographic and generic but related terms. These additions do not prevent a finding of confusing similarity in light of the prominence of the distinctive DIADORA mark within the disputed domain names.

The TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Accordingly, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain names are confusingly similar to the Complainant's mark.

(B) THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAMES

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the disputed domain names. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it; see, for example, WIPO Overview 3.0, section 2.1 ("While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."). However, the burden of proof still remains with the complainant to make out its prima facie case on a balance of probabilities. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

Paragraph 4(a)(ii) of the Policy contemplates an examination of the available facts to determine whether a respondent has rights or legitimate interest in the domain name. Paragraph 4(c) sets out a list of circumstances through which a respondent may demonstrate that it does have such rights or interests.

The first circumstance, under Paragraph 4(c)(i), is where "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services". Here, according to screenshot evidence submitted by the Complainant, the disputed domain names currently are inactive websites. However, the disputed domain names previously resolved to copy-cat websites displaying Complainant's trademark and goods. Accordingly, the Panel finds no evidence of a bona fide offering or goods or services or demonstrable preparations to use per Policy 4(c)(i) and Respondent does not have rights or legitimate interests with respect to the disputed domain names thereunder.

The second circumstance, under Paragraph 4(c)(ii), concerns cases where the respondent is commonly known by the domain name. Here, according to the registrar verification, the Respondent name is "Web Commerce Communications Limited" and has no similarity or connection to the disputed domain names. There is no evidence that the Respondent is commonly known by the disputed domain names. As such, this second circumstance of legitimate rights or interests under the Policy is not applicable to the Respondent.

Regarding the third circumstance, under Paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's DIADORA trademark. According to the evidence in the record showing the disputed domain names are currently inactive websites and previously resolved to copy-cat websites, none of the accepted categories of fair use - such as news reporting, commentary, political speech, education etc – are found to apply and the Panel concludes there is no legitimate non-commercial or fair use on the part of the Respondent.

Lastly, the Complainant confirms that the Respondent is not licensed, nor has any relationship with or authority to represent the Complainant in any way

Accordingly, the Complainant has sufficiently made out its prima-facie case on the second element of the Policy. Thus, the burden of proof is shifted to the Respondent to rebut the Complainant's case. Here, because the Respondent has not participated in these proceedings, there is no such rebuttal to consider, and the Complainant prevails.

The Panel therefore concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest in the disputed domain names. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES

The third element requires the Complainant to show that the disputed domain names have been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g. Hallmark Licensing, LLC v. EWebMall, Inc., WIPO Case No. D2015-2202 ("The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.").

Further, Paragraph 4(b) of the Policy sets out a non-exhaustive list of four circumstances, any one of which may be evidence of the registration and use of a domain name in bad faith. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy for the reasons set out below.

There is no evidence that the Respondent is commonly known by the disputed domain names and the Complainant confirms that the Respondent has never been affiliated with nor authorized by the Complainant to use the Complainant's trademark(s) and/or register the disputed domain names. Nor is there any business or other association between the Complainant and the Respondent.

The Complainant's DIADORA trademark is distinctive and enjoys a considerable reputation in its industry as indicated by the Complainant's substantial presence on social media, with 427,000 followers of its Instagram account and 13,600 subscribers to its YouTube Channel. Further, the Complainant's reputation has been expressly confirmed by a previous panel in CAC decision No. 102087, DIADORA SPORT S.R.L. v. Gillian Grocott: "The Complainant's trademarks enjoy (at least in relevant business and customer circles) well-known status and high level of notoriety. As a result, there is only a remote chance that the Respondent has registered such complex domain name just by a chance and without having a knowledge about the existence of the Complainant's rights and business".

The same logic applies in this instant case, and this Panel finds that because of the well-established status of the Complainant, it is more probable than not that the Respondent either knew, or should have known, that the disputed domain names would be confusingly similar to the Complainant's trademarks and thus they registered the disputed domain names with the Complainant in mind.

The evidence of targeting by Respondent is compelling. The disputed domain names comprise Complainant's distinctive DIADORA mark, with the addition of the geographic terms "argentina", "costa rica", 'japan", "slovenija", "uae", "peru", "srbija", "schweiz", "italian" and the generic but related terms ,´´outlet" and ´´store´´, apparently meant to represent countries and online stores where Complainant offers its goods and with which the Complainant can therefore be closely and relevantly associated. The disputed domain names do not currently resolve to any active content that could potentially evidence an alternative purpose.

The non-active use of the disputed domain names in this case satisfies the doctrine of passive holding as described in WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows considering all of the circumstances of the case because (i) the Complainant's trademark is distinctive and has a strong reputation in its sector, (ii) the Respondent failed to respond to these proceedings and thus has provided no evidence of actual or contemplated good-faith use, (iii) it is impossible to conceive of any plausible actual or contemplated good faith use of the disputed domain names by the Respondent in this case.

Further, there is a pattern of conduct indicating the Respondent registered the ten disputed domain names in order to prevent the Complainant from reflecting the mark in corresponding domain names.

As a final point, the Panel may draw a negative inference from Respondent's failure to reply to the Complainant's cease and desist letter and silence though these proceedings.

In light of the above analysis, the Panel concludes that the Complainant has made out its case that the disputed domain names were registered and are being used in bad faith, and thus has satisfied the requirements under 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. **diadoraargentina-outlet.com**: Transferred
2. **diadoracostarica.com**: Transferred
3. **diadora-japan.com**: Transferred
4. **diadora-schweiz.com**: Transferred
5. **diadora-slovenija.com**: Transferred
6. **diadora-uae.com**: Transferred
7. **diadoraitalian.com**: Transferred
8. **diadoraoutletperu.com**: Transferred
9. **diadora-srbija.com**: Transferred
10. **diadoraargentinastore.com**: Transferred

PANELLISTS

Name	**Claire Kowarsky**

DATE OF PANEL DECISION 2024-03-14

Publish the Decision