Decision for dispute CAC-UDRP-106254

Case number	CAC-UDRP-106254
Time of filing	2024-02-16 09:17:14
Domain names	castelliapparel.com, castelliclothing.com, castellioutlet.com, cyclesportful.com, cycling-castelli.com, soldesportful.com, castellicycle.com, castellipromo.com, castellisales.com, castellishops.com, cyclingcastelli.com, cyclingsportful.com, scontosportful.com, sportfulsale.com, sportfulshop.com, sportfulsoldes.com, sportfulcycling.com, outletkarpos.com

Case administrator

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

Complainant

Organization	MANIFATTURA VALCISMON S.P.A.

Complainant representative

Organization	Convey srl

Respondents

Name	Han Zhengzhong
Name	Fan Gaojie
Name	Chi Hong
Name	Zhou Guocai
Name	Libi Li
Name	Yilu Zhang
Name	Guifang47 Wei
Name	Haiyan Wu
Name	yuzhen dai
Name	Mbfhe Tbuee
Name	Liguhj Hongji
Name	Jinfu He
Name	Snjj Ygdeue

Name	**ZhengLianhe**
Name	**WangSujuan**
Name	**Hbvdgb Tvbdbn**
Name	**Ji Chunguang**

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, MANIFATTURA VALCISMON S.P.A. having its registered offices in Via G. Marconi, 81/83, FONZASO (BELLUNO) (IT), which is the owner of numerous international and national trademark registrations, which either consist of or contain the denominations “SPORTFUL”, “CASTELLI” and other devices of which trademark rights are owned by the latter, such as:

- International Trademark no. 545010 - “SPORTFUL” - Cl: 25;

- International Trademark no. 1197630 - “SPORTFUL”- Cl: 9, 25, 28;

- Italian Trademark no. 2016000013867 - “SPORTFUL” - Cl: 25;

- International Trademark no. 1129027 - “CASTELLI” - Cl: 18, 25;

- International Trademark no. 644265 - CASTELLI (figurative) - Cl: 25;

- European Union Trademark no. 000413708 - CASTELLI (figurative) - Cl: 12, 25, 28;

- International Trademark no. 943228 - KARPOS (figurative) - Cl: 25.

The Respondent has not submitted anything in relation to identification of rights.

FACTUAL BACKGROUND

MANIFATTURA VALCISMON S.P.A. was created in 1946 by Olindo and Irma Cremonese which have set up a spinning mill for wool yarns. Over the years, the production shifted towards quality underwear, first for the Italian market, then also for the United States.

In 1972 Giordano Cremonese took over his parents’ company and decided to create a revolutionary garment made of stretch fabrics that offer unprecedented freedom of movement. This is the birth of the SPORTFUL brand and the beginning of the production of ski clothing for cross-country skiing and cycling.

On these premises the SPORTFUL brand grew and became one of the biggest players in terms of sport garments development, making a great impact on Nordic skiing and cycling performance, dressing champions on their most astonishing accomplishments.

Currently SPORTFUL trademark is diffused in more than 35 countries and produces increasingly innovative clothing for any athlete. It equips various professional cycling teams as BORA – Hansgrohe, MMR Factory Racing Team and Exploro Cycling Club.

In 2003 MANIFATTURA VALCISMON S.P.A. acquired the cycling clothing brand CASTELLI. Armando CASTELLI joined Gianni Vittore’s staff and in 1939 purchased the company by maintaining, among the clients, cycling heroes as Gino Bartali and Fausto Coppi. Some years later Maurizio, Armando’s son, was created an early version of the CASTELLI scorpion logo fashioned. CASTELLI brand is renowned for several innovations listed as examples: the sublimation dye process, Giro elastic band, the ‘Radiation’ insulation system, the bib short with Body Paint, the Gabba WS jersey first all-weather aerodynamic jersey, the Nano-Flex water repellent fabrics shed water and the Sanremo Speed Suit, the first ever skinsuit made for road racing.

In 2007 the Complainant has created the KARPOS trademark which is dedicated to technical outdoor clothing.

Today the group is a joint-stock company with a production of over three million garments, present in 75 countries around the world with 3 proprietary brands.

On the occasion of the 75th anniversary of its foundation, MANIFATTURA VALCISMON S.P.A. has launched MVC Group: the new

corporate image, which reflects its international dimension and maintains its roots and culture in the Dolomites. In addition to hosting retail corners for the SPORTFUL and CASTELLI brands, the MVC Group has developed a hub, between the Dolomites and Monte Grappa, which includes showers and changing rooms, a lounge bar, and e-bike recharging stations for amateur cyclists and other athletes.

In order to protect and promote its brand, the Complainant has been extensively using the SPORTFUL, CASTELLI and KARPOS trademarks on all internet environments including and not limited to the complainant's official websites https://www.mvcgroup.com/ - https://www.sportful.com/ - https://www.castelli-cycling.com/ and its official accounts on the major social networks such as Facebook, Instagram and Youtube.

The disputed domain names were registered in 2022 and 2023.

The Complainant alleges that disputed domain names infringed its rights in accordance with relevant UDRP policies and rules.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

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

Language of the Case:

The Complainant requests that the language of this administrative proceeding be English pursuant to UDRP Rule 11(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.

Paragraph 10 of the UDRP Rules vests a Panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios were summarized into WIPO Jurisprudential Overview 3.0, 4.5.1. In this particular instance, the Complainant tried to request change of languages of proceedings in light of Chinese language Registration Agreement by showing that 1) the websites corresponding to the domain names are in English; and 2) the disputed domain names contain Latin characters and the English words such as "cycling", "sale" and "shop". Both suggest that Respondents possess a certain level of mastery of the English language. In addition, among eighteen disputed domain names, English is the default language in the language registration agreements of eleven disputed domain names.

In light of the scenarios and equity, the Panel is of the view that conducting the proceeding in English is unlikely to heavily burden the Respondent, and it is likely that the Respondent can understand the English language based on a preponderance of evidence test. Without further objection from the Respondent on the issue, the Panel will proceed to issue the decision in English.

Consolidation:

The Complainant further requests that the domain names and the named Respondents be consolidated in a single UDRP proceeding. In accordance with paragraph 10(e) of the Rules for Uniform Domain Name Dispute Resolution Policy, "[a] Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules."

In the application of UDRP, panels have reached consensus in that "[w]here a complaint is filed against multiple respondents, 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" (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 4.11.2).

In the case at hand, the Complainant based its consolidation arguments on a combination of factors listed below:

Disputed domain names share the same hosting provider, have the same gTLD, share similar designed websites layouts, share the Complainant's Castelli and Sportful logos in corresponding headers of the webpages, share the same opening hours of the shops, share the same footer of the websites including same payment ways, and share the same products offered, etc. These evidence, according to the Complainant, demonstrate that the disputed domain names "are under the control of a single individual or entity or, at least, reflective of a group of individuals acting in concert."

The Respondent has not made any submission on the validity of the consolidation.

When assessing whether the consolidation against multiple respondents is appropriate, UDRP panels typically take into account various factors, that might be present in some combination in each case, including but not limited to domain names registered using same email address (Meow Wolf, Inc. v. Nick Ramirez, WIPO Case No. D2022-3354), similarity of composition in the domain names (Splice Video Editor S.R.L v. Sergey Zdrilyuk, WPO Case No. D2022-3292), and domain names link to websites with similar design (Banco BPM S.P.A. v. Roman LEBON, WIPO Case No. D2022-383). These factors are similarly present in this case. In addition, the fact that all disputed domain names were targeting the Complainant's trademarks resolving to almost identical websites and that the information disclosed for the Respondents bearing similarities to ways that displayed for the other Respondents, warrant for this Panel's decision to allow the consolidation.

PRINCIPAL REASONS FOR THE DECISION

1. Disputed domain names are confusingly similar to trademarks in which the Complainant has rights.

The Complainant, MANIFATTURA VALCISMON S.P.A, was created in 1946 in Italy. Over the years, the production shifted towards sports garment made of stretch fabrics. The SPORTFUL brand owned by the Complainant is one of the biggest players in terms of sport garments development, and the Castelli brand owned by the Complainant other innovative wears used in racing and cycling. In 2007 the Complainant has created the KARPOS trademark which is dedicated to technical outdoor clothing. All of these three brands owned by the Complainants acquired trademarks in a handful of countries, and the Complainant has been extensively using the SPORTFUL, CASTELLI and KARPOS trademarks on all internet environments including and not limited to its official websites https://www.mvcgroup.com/ - https://www.sportful.com/ - https://www.castelli-cycling.com/, besides its official accounts on the major social networks.

The disputed domain names incorporate the whole of the Complainant's trademarks CASTELLI, SPORTFUL, or KARPOS, and the fact that they include non-distinctive elements, such as "cycling", "apparel", "shop" does not affect the confusing similarity. In addition, it is a well-established principle that domain names that wholly incorporate trademarks, in particular ones as famous in the cycling sector as SPORTFUL, CASTELLI and KARPOS are found to be confusingly similar for the purposes of the Policy. The addition of generic words to a trademark in domain names is also insufficient in itself to negate confusing similarity between a trademark and a domain name. gTLDs such as ".com" are commonly viewed as a standard registration requirement, and as such they are disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11).

The Panel therefore concludes that the disputed domain names are confusingly similar to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. The Respondent does not have rights or legitimate interests in the disputed domain names.

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in the present case has not licensed or authorized the Respondent to register or use its trademark or the disputed domain names. There is no evidence that the Respondent is known by the disputed domain names or owns any corresponding registered trademarks. The Complainants did not grant any license or authorization to the Respondent to register or use the disputed domain names, nor the use of the Complainants' trademarks on pages of the disputed websites. Moreover, there are no disclaimer as to the Respondent's lack of relationship with the Complainant.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant

response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names within the meaning of paragraph 4(a)(ii) of the Policy.

3. The disputed domain names were registered and are being used in bad faith.

The use and registration of the disputed domain names by the Respondent has been done in bad faith.

First of all, the registration of the disputed domain names by the Respondent were done in bad faith. UDRP panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous trademark by an unaffiliated entity can by itself create a presumption of bad faith. With the reputation of the “SPORTFUL” “CASTELLI” and "KARPOS" trademarks, the presumption arises that the disputed domain name was registered with the intention to attract Internet users by creating a likelihood of confusion with the well-known “SPORTFUL”, “CASTELLI” and "KARPOS" trademarks.

Secondly, the use of the disputed domain names was in bad faith. The Complainant primarily relies its argument on paragraph 4(b)(iii) and 4(b)(iv) of the Policy. The Complainant notes that the “The use of the Domain Names in connection with commercial websites where the Complainant’s trademarks are misappropriated and where counterfeit SPORTFUL, CASTELLI and KARPOS branded items are offered for sale clearly indicates that the Respondent’s purpose in registering the Domain Names were to capitalize on the reputation of the Complainant's trademarks by diverting Internet users seeking SPORTFUL, CASTELLI and KARPOS products to his websites for financial gain.” According to paragraph 4(b)(iv) of the Policy, “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location”, if found by the panel, shall be considered evidence of registration and use of the domain name in bad faith. In addition, the Complainant notes that such use of the disputed domain names to promote and sell prima facie counterfeit products can only be used to disrupt Complainant's business.

Moreover, a cease-and-desist letter was sent to the Respondent on 15 December 2023 and the Respondent never responded. Prior panels have also held that a failure to respond to a cease-and-desist letter can be evidence of bad faith (see e.g., HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062).

Therefore, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the disputed domain names were registered and are being used in bad faith within the meaning of 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. **castelliapparel.com**: Transferred
2. **castelliclothing.com**: Transferred
3. **castellioutlet.com**: Transferred
4. **cyclesportful.com**: Transferred
5. **cycling-castelli.com**: Transferred
6. **soldesportful.com**: Transferred
7. **castellicycle.com**: Transferred
8. **castellipromo.com**: Transferred
9. **castellisales.com**: Transferred
10. **castellishops.com**: Transferred
11. **cyclingcastelli.com**: Transferred
12. **cyclingsportful.com**: Transferred
13. **scontosportful.com**: Transferred
14. **sportfulsale.com**: Transferred
15. **sportfulshop.com**: Transferred
16. **sportfulsoldes.com**: Transferred
17. **sportfulcycling.com**: Transferred
18. **outletkarpos.com**: Transferred

PANELLISTS

Name	Carrie Shang

DATE OF PANEL DECISION 2024-03-26

Publish the Decision