Decision for dispute CAC-UDRP-106212

Case number	CAC-UDRP-106212
Time of filing	2024-02-02 17:05:47
Domain names	diadora-singapore.com, diadoraenmx.com, diadora-canada.com, tenisdiadoracolombia.com, diadorashoesnz.com, diadoratrainers.com, tiendadiadoracl.com, diadora-turkiy.com, belgiediadoraheritage.com, diadorachiletiendaonline.com, diadorashoesphilippines.com, tiendadiadoramexico.com, diadoranederlandsale.com, diadora-argentina.com, diadoragermany.com, diadora-malaysia.com, diadora-mx.com, diadora-australia.com, diadora-belgie.com, diadora-ireland.com, diadoraisrael.com, diadora-philippines.com, diadorasg.com, diadoracl.com, diadora-denmark.com, diadorafi.com, diadora-hu.com, diadora-norge.com, diadora-paris.com, diadora-peru.com, diadora-romania.com, diadora-sverige.com, diadoraturkiyetr.com, diadorauruguay.com, diadora-greece.com, diadora-hrvatska.com, diadoramilano.com, diadorapl.com, diadora-pt.com, diadora-india.com, diadorauk-sale.com, diadoralisboa.com, diadoraturkiyeoutlet.com, diadoragreece.com, diadorasneakersusa.com, diadorauae.com, lojasdiadoraportugal.com, diadoraschweiz.com, diadoranederland.com, diadoraskodanmark.com, tiendadiadorachile.com, diadora-turkiyes.com, diadorapolska.com, diadoraargentinaoutlet.com, diadora-turkiye.com, diadora-ayakkabi.com, diadoraportugals.com, diadorasmexico.com, diadorasturkiyetr.com, diadoranorge.com, diadorasverige.com, diadora-chile.com, diadora-ro.com, diadoraamsterdam.com, diadora-belgium.com, diadoragr.com, diadoraeesti.com, diadoraisraelsale.com, diadorakuwait.com, diadorauaeonline.com, diadorabulgaria.com, diadoragreecesale.com, diadorahungaryoutlet.com, diadoralatvija.com, diadoralietuva.com, diadoraromania.com, diadoracolombia.com, diadorachilestore.com, diadoraczoutlet.com, diadorahrvatskasale.com, diadoramexicoonline.com, diadoraperuoutlet.com, diadoraslovenijastore.com, diadorasrbija.com, diadorauruguayshop.com, diadoraaustraliaoutlet.com, diadoracanadastore.com, diadorairelandsale.com, diadorauk.com, diadorabelgique.com, diadorabelgiumsale.com, diadorabrasil.com, diadoradanmarkoutlet.com, diadoranederlandonline.com, diadoranorgesale.com, diadoraportugalshop.com, diadoraschweizsale.com, diadorasouthafrica.com, diadorasuomistore.com, diadorajapansale.com

Case administrator

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

Complainant

Organization	Diadora S.p.A.

Complainant representative

Organization	Convey srl

Respondents

Organization	Web Commerce Communications Limited

Name	**Zachary Elliott**
Name	**Erin Kennedy**
Name	**Mohammed May**
Name	**Zak Burns**
Name	**Gabriel Bentley**

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 Diadora S.p.A., a legal corporate entity registered in Italy and owner of the company name and trademark DIADORA with several international and national trademark registrations worldwide, including the following:

IR n° 682095A of July 31, 1997, in classes 3, 9, 12, 14, 16, 18, 25, 28;

IR n° 682095 of July 31, 1997, in classes 3, 9, 12, 14, 16, 18, 25, 28;

EUTM TM. n° 000339093 of January 07, 1999, in classes 18, 22 and 25;

IT trademark registration n° 0001297135 of May 31, 2010 in class 18, 25, 28;

US trademark registration n° 2282558 of October 5, 1999 in classes 18 and 25.

FACTUAL BACKGROUND

The Complainant is a manufacturer of athletic footwear and apparel, founded in 1948 by Marcello Danieli who called his company "Diadora". The Complainant initially manufactured mountain climbing boots. During the 1950s, the company grew and became a familiar name throughout the Italian market. During the economic boom of the 1960s, DIADORA began to manufacture ski boots and the first apres-ski boots. Subsequently, Diadora introduced running shoes and shortly thereafter, tennis shoes.

During the 1970s, Diadora's shoes became more technologically advanced, also due to the cooperation with sports champions such as Guillermo Vilas, Martin Mulligan and Björn Borg. The 1970s also marked Diadora's entry into football, aided by Roberto Bettega, who acted as a consultant. AC Milan striker Marco van Basten became the face of the company in the late 1980s and launched his own personalized football boots, the San Siro Van Basten. The Complainant had and currently has a number of high-profile football players under their sponsorship such as: George Weah, Roberto Baggio, Giuseppe Signori, Francesco Totti, Roy Keane and Antonio Cassano.

Following the acquisition of the trademark Invicta, an outdoor athletics equipment company in 2009, the Italian shoe-making company Geox's founder and chairman Mario Moretti Polegato reached an agreement to buy the assets of Diadora. The collaboration between Diadora and Geox has been established to create comfortable, light work shoes. The Complainant's products have also been worn in connection with major sports events including by Gustavo Kuerten at the Roland-Garros international tennis championship and by the Italian Olympic team during the 2016 Olympic Games in Rio de Janeiro, Brazil.

Overall, the Complainant has spent considerable effort in promoting this mark, thereby acquiring the trademark's goodwill.

In order to protect and promote its brand also on the Internet, the Complainant registered several domain names consisting of or comprising the trademark DIADORA under several different TLDs, including <diadora.com>, which was registered on October 19, 2013, <diadora.cn>, registered on May 21, 2014. The web sites diadora.com and diadorautility.com 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 Complainant is also active on the main Social Media like Instagram and Youtube. The official Complainant's Instagram account counts over 427.000 fans worldwide.

The disputed domain names were registered by the Respondent(s), without authorization of Complainant, between January 2022

and November 2023 - as highlighted in the WHOIS records and have been redirecting to websites offering for sale the Complainant's products. They were all registered after the registration of the earlier rights of the Complainant.

As soon as the Complainant became aware of the Respondent's registration and use of the disputed domain names, which are confusingly similar to its registered and well-known trademark DIADORA, it instructed its representative to address to the owner of the disputed domain names a cease-and-desist letter in order to notify him of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer, of the disputed domain names to the Complainant.

Therefore, a cease-and-desist letter was sent to Respondent via the relevant Registrar e-mail contact address domainabuse@service.aliyun.com. The Respondent did not reply.

The disputed domain names are currently or have been redirected by the Respondent to websites with similar layouts where the Complainant's trademarks DIADORA are being used in order to sell prima facie counterfeit DIADORA branded products. The counterfeit nature is evidenced by the fact that the goods are sold at half the retail sale price of the Complainant and that the Respondent has misappropriated copyrighted images from the Complainant's website.

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. The Complainant has put forward arguments and evidence to support his contentions.

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

CONSOLIDATION OF THE PROCEEDINGS

The Complainant has requested that the disputed domain names and the named Respondents be consolidated in a single UDRP proceeding.

The consolidation of multiple registrants as respondents in a single administrative proceeding may be appropriate under certain circumstances under paragraph 3(c) or 10(e) of the Rules, provided that the Complainant can demonstrate that the disputed domain names or the web sites to which they resolve are subject to common control, and the panel, having regard to all of the relevant circumstances, determines that consolidation would be procedurally efficient and fair and equitable to all parties. Once a case is admitted on a prima facie basis, the Respondent is given the opportunity to make its submissions on the validity of the consolidation together with its substantive arguments.

As expressed in WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.11.2, the consensus on this matter is as follows: "Where 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."

When assessing whether multiple domain names may be found to be under common control, the following circumstances have been evaluated, amongst others, in prior UDRP decisions:

Circumstances indicating that different registrants were alter egos of the same beneficial holder (See Backstreet Productions, Inc. v. John Zuccarini, CupcakeParty, Cupcake Real Video, Cupcake-Show and Cupcakes-First Patrol, WIPO Case No. D2001-0654), as may be:

- Cases where respondents had common administrative contact or technical contact, or other instances of commonality in the registration information, such as the same postal address or e-mail address (See ISL Marketing AG, and The Federation Internationale de Football Association v. J.Y. Chung, Worldcup2002.com, W Co., and Worldcup 2002, WIPO Case No. D2000-0034, in which the disputed domain names had the same administrative contact; Caesars World, Inc. v. Starnet Communications and Atlantic West Gaming Entertainment, Ltd., WIPO Case No. D2002-0066, decision rendered against multiple respondents where the same person was indicated as the administrative contact, billing contact; and Adobe Systems Incorporated v. Domain OZ, WIPO Case No. D2000-0057, decision rendered against multiple respondents where respondents shared the same post office box number and email address in their registration information); or

- Circumstances indicating that a single person or entity had registered multiple domain names using fictitious names. See Guccio Gucci S.p.A. v. Huangwensheng, Shirley, wangliang, xiaomeng xiexun, jiangxiuchun, WIPO Case No. D2012-0342; Yahoo!, Inc v. Somsak Sooksripanich and Others, WIPO Case No. D2000-1461 (decision rendered against multiple Respondents which seemed to be fronts for the real respondent); Yahoo! Inc. v. Yahoosexy.com, Yahoo-sexy.com, Yahoosexy.net, Yahousexy.com and Benjamin Benhamou, WIPO Case No. D2001-1188 (domain names <yahoosexy.com>, <yahoo-sexy.com>, <yahoosexy.net> and <yahoo-sexy.net>); Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070; General Electric Company v. Marketing Total S.A, WIPO Case No. D2007-1834.

- Substantial commonalities in the web sites to which the disputed domain names resolved and the use of the same domain name servers. See, i.a., Nintendo of America Inc. v. Administrator Lunarpages, Alan Smith, Neoconsoles Inc., Liu Hai, Linda Wong, and Wong, supra, Apple Inc. v. Fred Bergstrom, LottaCarlsson, Georges Chaloux and Marina Bianchi, WIPO Case No. D2011-1388, Sharman License Holdings, Limited v. Dustin Dorrance/Dave Shullick/Euclid Investments, WIPO Case No. D2004-0659; and Balenciaga v. Ni Hao, Shen Dan, Wu Dan, Zhu Qin, Yan Wei, WIPO Case No. D2011-1541.

- The incorporation of complainants' trademark in its entirety together with a descriptive term. See Ecco Sko A/S v. tian yu, Karei, Wuxiaoman, xiao tian, WIPO Case No. D2011-1606 (incorporation of the complainant's trade mark ECCO in its entirety together with the descriptive term, "shoe(s)" being indicative that the domain names <eccoshoeuk.net> and <eccoshoeuk.com> were subject to common control by the same person or company), Camper, S.L. v. zhengmiansen, jolin kelly, zy, WIPO Case No. D2011-1750 and Balenciaga v. Ni Hao, Shen Dan, Wu Dan, Zhu Qin, Yan Wei, supra.

In the case at hand, the disputed domain names, which all incorporate the trademark DIADORA in their entirety, meet the requirements for finding that they are under the control of a single individual or entity or, at least, the control of a group of individuals acting in concert.

The one hundred disputed domain names all share the following similarities:

- sharing the presence of country names along with the trademark "diadora" and the TLD ".com";
- same Registrar: ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED.

On the basis of further commonalities, the disputed domain names have been divided into three groups:

Group 1:

<diadora-argentina.com>, <diadoracl.com>, <diadora-denmark.com>, <diadorafi.com>, <diadoragermany.com>, <diadora-hu.com>, <diadora-malaysia.com>, <diadora-mx.com>, <diadora-norge.com>, <diadora-paris.com>, <diadora-peru.com>, <diadora-romania.com>, <diadora-sverige.com>, <diadoraturkiyetr.com>, <diadorauruguay.com>, <diadora-australia.com>, <diadora-belgie.com>, <diadora-greece.com>, <diadora-hrvatska.com>, <diadora-ireland.com>, <diadoraisrael.com>, <diadora-philippines.com>, <diadorasg.com>, <diadoramilano.com>, <diadorapl.com>, <diadora-pt.com>, <diadora-singapore.com>, <diadorasturkiyetr.com> - share the following similarities

These share:
- the same Registrant State/Province: Kuala Lumpur;
- the same Registrant Country: MY;
- the same favicon of the websites;
- the same footer of the websites;
- the same lay-out of the websites;
- the presence of "Social Media Follow Us" section in each webpage;
- the presence of the trademark "Diadora" in the upper central section of each homepage;
- the presence of the sections "Mens", "Womens" and "Outlet" referring to the respective categories of products offered for sale and written in the idiom corresponding to the default language set in each website;
- the presence of country flag icon on the right part of the headers of the corresponding websites.

Within this first group, the domain names <diadora-singapore.com> and <diadorasturkiyetr.com>, which are now offline, were redirected to websites identical to the ones where the disputed domain names of Group 1 are pointed prior to the Cease-and-Desist Letter.

Group 2:

<diadora-india.com>, <diadoranederland.com>, <diadoraskodanmark.com>, <diadorasneakersusa.com>, <diadora-turkiy.com>, <diadorauae.com>, <diadorauk-sale.com>, <lojasdiadoraportugal.com>, <tiendadiadorachile.com>, <diadoraargentinaoutlet.com>, <diadora-ayakkabi.com>, <diadora-canada.com>, <diadora-chile.com>, <diadoranorge.com>, <diadoraportugals.com>, <diadoraschweiz.com>, <diadorashoesnz.com>, <diadorashoesphilippines.com>, <diadorasmexico.com>, <diadorasverige.com>, <diadoratrainers.com>, <diadora-turkiye.com>, <tenisdiadoracolombia.com>, <diadoraeesti.com>, <diadoraisraelsale.com>, <diadorakuwait.com>, <diadorauaeonline.com>, <diadora-ro.com>, <diadoraamsterdam.com>, <diadora-belgium.com>, <diadoragr.com>, <diadoralisboa.com>, <diadoracolombia.com>, <diadora-turkiyes.com>, <diadorabulgaria.com>, <diadoraczoutlet.com>, <diadoradanmarkoutlet.com>, <diadoragreecesale.com>, <diadorahrvatskasale.com>, <diadorairelandsale.com>, <diadorajapansale.com>, <diadoramexicoonline.com>, <diadoranederlandonline.com>, <diadoranorgesale.com>, <diadoraportugalshop.com>, <diadoraschweizsale.com>, <diadorasrbija.com>, <diadorauk.com>, <diadorapolska.com>, <belgiediadoraheritage.com>, <diadorachiletiendaonline.com>, <diadoraenmx.com>, <diadoranederlandsale.com>, <tiendadiadoracl.com>, <tiendadiadoramexico.com>, <diadoraturkiyeoutlet.com>, <diadoragreece.com>

All the domain names in this cluster have Kuala Lumpur and MY as Registrant State/Province and Registrant Country in the Whois, sharing these with the ones in Group 1 and share the following similarities:

- the same favicon of the websites;
- the same lay-out of the websites;
- the presence of “Social Media Follow Us” section in each webpage;
- the presence of the trademark "Diadora" in the upper left section of each homepage;
- the presence of country flag icon on the top of each webpage.

Within the second group, the domain names <diadora-india.com>, <diadora-turkiy.com>, <diadora-canada.com>, <diadorashoesnz.com>, <diadoratrainers.com>, <tenisdiadoracolombia.com>, <diadoraeesti.com>, <diadoraisraelsale.com>, <diadora-ro.com>, <diadoraamsterdam.com>, <diadora-belgium.com>, <diadoragr.com>, <diadoralisboa.com>, <diadora-turkiyes.com>, <diadoraenmx.com> and <diadoraturkiyeoutlet.com> are no longer redirecting to active contents following the cease and desist letter but were active prior to the letter.

Group 3:

<diadorabelgique.com>, <diadorabelgiumsale.com>, <diadorabrasil.com>, <diadoracanadastore.com>, <diadorachilestore.com>, <diadorahungaryoutlet.com>, <diadoralatvija.com>, <diadoralietuva.com>, <diadoraperuoutlet.com>, <diadoraromania.com>, <diadoraslovenijastore.com>, <diadorasouthafrica.com>, <diadorasuomistore.com>, <diadorauruguayshop.com>, <diadoraaustraliaoutlet.com> are currently not redirecting to active websites. All of these domain names, when active, apart from the common domain structure (the presence of country names along with the trademark "DIADORA" and the TLD ".com") and the same Registrar, shared the following similarities in the corresponding websites:

- same favicon of the websites;
- presence of the logo “Optimal” within the upper section of each homepage;
- same footer of the websites;
- same lay-out of the websites.

Following the Cease-and-Desist Letter, the websites corresponding to the domain names have been deactivated, as was the case for some domain names in the Group 2.

All of the disputed domain names are registered in the name of registrants that have e-mail addresses created with cxtmail.com that it is uncommon for residents of Italy, Spain or Germany. Additionally, it is telling that most of the addresses given are incomplete (the street addresses are missing). The sum of evidence when viewed jointly indicates prima facie that different aliases are being used by the same person or entity or that the disputed domain names are commonly controlled.

In light of the above, the Complainant requested that the disputed domain names and the named Respondents be consolidated in a single UDRP proceeding. The Respondent has not in any way challenged the prima facie evidence provided by the Complainant as no administratively compliant Response was filed.

The evidence provided by the Complainant, including that of the same registrar, the same structure of the domain names (geographical and/or generic terms along with the trademark DIADORA) and same products offered for sale are sufficient to convince the Panel of the existence of common control over these domain names. For that reason, the Panel finds that the consolidation of the dispute to be equitable and procedurally efficient.

The Panel is therefore 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

In view of the Respondent's failure to submit a response, the Panel shall decide this matter on the basis of the Complainant's

undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory.

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 the 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 conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Complainant has established rights in the name DIADORA. The disputed domain names:

<belgiediadoraheritage.com>, <diadora-argentina.com>, <diadora-australia.com>, <diadora-ayakkabi.com>, <diadora-belgie.com>, <diadora-belgium.com>, <diadora-canada.com>, <diadora-chile.com>, <diadora-denmark.com>, <diadora-greece.com>, <diadora-hrvatska.com>, <diadora-hu.com>, <diadora-india.com>, <diadora-ireland.com>, <diadora-malaysia.com>, <diadora-mx.com>, <diadora-norge.com>, <diadora-paris.com>, <diadora-peru.com>, <diadora-philippines.com>, <diadora-pt.com>, <diadora-ro.com>, <diadora-romania.com>, <diadora-singapore.com>, <diadora-sverige.com>, <diadora-turkiy.com>, <diadora-turkiye.com>, <diadora-turkiyes.com>, <diadoraamsterdam.com>, <diadoraargentinaoutlet.com>, <diadoraaustraliaoutlet.com>, <diadorabelgique.com>, <diadorabelgiumsale.com>, <diadorabrasil.com>, <diadorabulgaria.com>, <diadoracanadastore.com>, <diadorachilestore.com>, <diadorachiletiendaonline.com>, <diadoracl.com>, <diadoracolombia.com>, <diadoraczoutlet.com>, <diadoradanmarkoutlet.com>, <diadoraeesti.com>, <diadoraenmx.com>, <diadorafi.com>, <diadoragermany.com>, <diadoragr.com>, <diadoragreece.com>, <diadoragreecesale.com>, <diadorahrvatskasale.com>, <diadorahungaryoutlet.com>, <diadorairelandsale.com>, <diadoraisrael.com>, <diadoraisraelsale.com>, <diadorajapansale.com>, <diadorakuwait.com>, <diadoralatvija.com>, <diadoralietuva.com>, <diadoralisboa.com>, <diadoramexicoonline.com>, <diadoramilano.com>, <diadoranederland.com>, <diadoranederlandonline.com>, <diadoranederlandsale.com>, <diadoranorge.com>, <diadoranorgesale.com>, <diadoraperuoutlet.com>, <diadorapl.com>, <diadorapolska.com>, <diadoraportugals.com>, <diadoraportugalshop.com>, <diadoraromania.com>, <diadoraschweiz.com>, <diadoraschweizsale.com>, <diadorasg.com>, <diadorashoesnz.com>, <diadorashoesphilippines.com>, <diadoraskodanmark.com>, <diadoraslovenijastore.com>, <diadorasmexico.com>, <diadorasneakersusa.com>, <diadorasouthafrica.com>, <diadorasrbija.com>, <diadorasturkiyetr.com>, <diadorasuomistore.com>, <diadorasverige.com>, <diadoratrainers.com>, <diadoraturkiyeoutlet.com>, <diadoraturkiyetr.com>, <diadorauae.com>, <diadorauaeonline.com>, <diadorauk-sale.com>, <diadorauk.com>, <diadorauruguay.com>, <diadorauruguayshop.com>, <lojasdiadoraportugal.com>, <tenisdiadoracolombia.com>, <tiendadiadorachile.com, <tiendadiadoracl.com>, <tiendadiadoramexico.com>

are all found to be confusingly similar to the Complainant’s Trademarks and company name.

This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of
a) disregarding the top-level suffix in the domain names (i.e. “.com" in this case) in the comparison; and
b) holding:

(1) that the addition of generic or generally non-distinctive elements such as geographical denominations to the protected trademark (in this case the names of countries or cities or country abbreviations) as an indication of a country in which products may or may not be made available for sale by the Complainant;

(2) the combination of a trademark and a generic term referring to the goods offered by the trademark’s proprietor under that very name (e.g. trainers);

(3) the combination of the Complainant's mark with another product identifier used by the Complainant (e.g. Heritage); or

(4) the combination of the Complainant's mark together with a word for retail or a retail outlet (such as e.g. sale, online, tienda, outlet or store);

(5) the combination of the Complainant's mark together with a sport for which the Complainant's goods are being marketed (such as e.g. tenis, the Spanish word for “tennis”);

would by no means be considered sufficient to distinguish a domain name from a trademark.

On the contrary, the one distinctive feature shared by all these domains is the trademark in which the Complainant has established earlier rights, i.e. DIADORA.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the respondent lacks rights or legitimate interests is placed on the complainant. However, once such a prima facie case is made, it is the respondent's burden to demonstrate rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Respondent (in this decision, reference to the "Respondent" shall be deemed to include all those individuals named in the complaint as respondents jointly and severally) has no rights or legitimate interests in the disputed domain names. The Complainant has not authorized the use of the DIADORA trademark and the Respondent is not commonly known under the disputed domain names.

The well-known nature of the DIADORA trademarks is accepted by the Panel. The Respondent is using the disputed domain names which are currently being or have been redirected by the Respondent to websites with similar layouts where the Complainant’s trademarks DIADORA are used to attract customers in order to sell what are prima facie counterfeit DIADORA branded products. The prima facie counterfeit character is established by the fact that the goods are sold disproportionately below market value (at half the Complainant’s prices). Additionally, the Respondent has misappropriated copyrighted images from the Complainant’s website.

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. On the contrary, this conduct clearly demonstrates that Respondent did not intend to use the disputed domain names in connection with any legitimate purpose.

Furthermore, 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 clearly attempting to gain profit from the sales of goods which must be considered counterfeit products. It is the Respondent’s intention 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 summary, the Panel concludes that the Respondent did not establish any rights or legitimate interest in the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain names were registered by the Respondent and are being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain names in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. The Respondent is also in no way commonly known under the disputed domain names. This prima facie evidence was not challenged by the Respondent.

The Complainant’s trademark DIADORA is distinctive and well known all around the world as a result of extensive marketing activities. The fact that the Respondent has registered at least one hundred domain names that are confusingly similar to the earlier rights indicates that the Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain names. No other reason for registering a large number of combinations of the trademark of the Complainant together with geographic and other generic terms appears even remotely feasible. Any, even the most basic Google search in respect of the wording DIADORA, would have yielded obvious references to the Complainant.

The disputed domain names are not used for any bona fide offerings. Instead, by using all of the disputed domain names for a single purpose, the Respondent has intentionally attempted to attract, for commercial gain, internet users to his websites, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of his websites. The disputed domain names are or were all connected to websites replicating the names and trademarks of the Complainant and offered counterfeit products under the Complainant's trademarks for sale. Therefore, Internet users searching for information on the Complainant’s goods are confusingly and purposefully led to the Respondent’s websites.

The Respondent has intentionally attempted to attract, for commercial gain, internet users to its websites, by creating a likelihood of confusion with the Complainant’s marks. The Respondent, through the use of misleading information on its websites, and copying the trademark and product images of the Complainant's official DIADORA websites, is passing itself off as the authorized distributor of DIADORA products in numerous locations, which it is in fact not.

Other factors indicating bad faith include the Respondent's lack of response to the Complainant's representative's Cease-and-Desist Letter which has been submitted to the Respondent's Registrar. No response was received. However, some of the domain names were disconnected or reconnected to other targets. This is an indication that the domain names may be registered and in use contrary to Paragraph 4(a)(iii) of the Policy.

The Panel is convinced that the disputed domain names were registered in full awareness of the Complainant's earlier rights and are being used for attracting internet users to its websites for commercial gain by creating a likelihood of confusion with the Complainant's marks.

The Panel therefore concludes that the Respondent has registered and is using the disputed domain names in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement 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. **diadora-singapore.com**: Transferred
2. **diadoraenmx.com**: Transferred
3. **diadora-canada.com**: Transferred
4. **tenisdiadoracolombia.com**: Transferred
5. **diadorashoesnz.com**: Transferred
6. **diadoratrainers.com**: Transferred
7. **tiendadiadoracl.com**: Transferred
8. **diadora-turkiy.com**: Transferred
9. **belgiediadoraheritage.com**: Transferred
10. **diadorachiletiendaonline.com**: Transferred
11. **diadorashoesphilippines.com**: Transferred
12. **tiendadiadoramexico.com**: Transferred
13. **diadoranederlandsale.com**: Transferred
14. **diadora-argentina.com**: Transferred
15. **diadoragermany.com**: Transferred
16. **diadora-malaysia.com**: Transferred
17. **diadora-mx.com**: Transferred
18. **diadora-australia.com**: Transferred
19. **diadora-belgie.com**: Transferred
20. **diadora-ireland.com**: Transferred
21. **diadoraisrael.com**: Transferred
22. **diadora-philippines.com**: Transferred
23. **diadorasg.com**: Transferred
24. **diadoracl.com**: Transferred
25. **diadora-denmark.com**: Transferred
26. **diadorafi.com**: Transferred
27. **diadora-hu.com**: Transferred
28. **diadora-norge.com**: Transferred
29. **diadora-paris.com**: Transferred
30. **diadora-peru.com**: Transferred
31. **diadora-romania.com**: Transferred
32. **diadora-sverige.com**: Transferred
33. **diadoraturkiyetr.com**: Transferred
34. **diadorauruguay.com**: Transferred
35. **diadora-greece.com**: Transferred
36. **diadora-hrvatska.com**: Transferred
37. **diadoramilano.com**: Transferred
38. **diadorapl.com**: Transferred
39. **diadora-pt.com**: Transferred
40. **diadora-india.com**: Transferred
41. **diadorauk-sale.com**: Transferred

42. **diadoralisboa.com**: Transferred
43. **diadoraturkiyeoutlet.com**: Transferred
44. **diadoragreece.com**: Transferred
45. **diadorasneakersusa.com**: Transferred
46. **diadorauae.com**: Transferred
47. **lojasdiadoraportugal.com**: Transferred
48. **diadoraschweiz.com**: Transferred
49. **diadoranederland.com**: Transferred
50. **diadoraskodanmark.com**: Transferred
51. **tiendadiadorachile.com**: Transferred
52. **diadora-turkiyes.com**: Transferred
53. **diadorapolska.com**: Transferred
54. **diadoraargentinaoutlet.com**: Transferred
55. **diadora-turkiye.com**: Transferred
56. **diadora-ayakkabi.com**: Transferred
57. **diadoraportugals.com**: Transferred
58. **diadorasmexico.com**: Transferred
59. **diadorasturkiyetr.com**: Transferred
60. **diadoranorge.com**: Transferred
61. **diadorasverige.com**: Transferred
62. **diadora-chile.com**: Transferred
63. **diadora-ro.com**: Transferred
64. **diadoraamsterdam.com**: Transferred
65. **diadora-belgium.com**: Transferred
66. **diadoragr.com**: Transferred
67. **diadoraeesti.com**: Transferred
68. **diadoraisraelsale.com**: Transferred
69. **diadorakuwait.com**: Transferred
70. **diadorauaeonline.com**: Transferred
71. **diadorabulgaria.com**: Transferred
72. **diadoragreecesale.com**: Transferred
73. **diadorahungaryoutlet.com**: Transferred
74. **diadoralatvija.com**: Transferred
75. **diadoralietuva.com**: Transferred
76. **diadoraromania.com**: Transferred
77. **diadoracolombia.com**: Transferred
78. **diadorachilestore.com**: Transferred
79. **diadoraczoutlet.com**: Transferred
80. **diadorahrvatskasale.com**: Transferred
81. **diadoramexicoonline.com**: Transferred
82. **diadoraperuoutlet.com**: Transferred
83. **diadoraslovenijastore.com**: Transferred
84. **diadorasrbija.com**: Transferred
85. **diadorauruguayshop.com**: Transferred
86. **diadoraaustraliaoutlet.com**: Transferred
87. **diadoracanadastore.com**: Transferred
88. **diadorairelandsale.com**: Transferred
89. **diadorauk.com**: Transferred
90. **diadorabelgique.com**: Transferred
91. **diadorabelgiumsale.com**: Transferred
92. **diadorabrasil.com**: Transferred
93. **diadoradanmarkoutlet.com**: Transferred
94. **diadoranederlandonline.com**: Transferred
95. **diadoranorgesale.com**: Transferred

96. **diadoraportugalshop.com**: Transferred
97. **diadoraschweizsale.com**: Transferred
98. **diadorasouthafrica.com**: Transferred
99. **diadorasuomistore.com**: Transferred
100. **diadorajapansale.com**: Transferred

PANELLISTS

Name	**Udo Pfleghar B.A. (Melb.)**

DATE OF PANEL DECISION 2024-04-04

Publish the Decision