Decision for dispute CAC-UDRP-106415

Case number	CAC-UDRP-106415
Time of filing	2024-04-09 10:20:07
Domain names	zegnaargentina.com, zegnacanadaoutlet.com, zegnachile.com, zegnagreece.com, zegnahrvatska.com, zegnahungary.com, zegnaindia.com, zegnaireland.com, zegnajapan.com, zegna-london.com, zegna-outletstore.com, zegnaperu.com, zegnaportugal.com, zegnaromania.com, zegnaslovenija.com, zegnasrbija.com, zegnaturkiye.com, zegna-uae.com, zegnaus.com, zegnabelgium.com, zegnanederland.com, zegnadanmark.com, zegnanorge.com, ermenegildozegnanz.com, ermenegildozegnaoutlet.com, zegnaaustralia.com, zegna-canada.com, zegnadeutschland.com, zegnafactoryoutlet.com, zegnalondon.com, zegnamexico.com, zegna-outlet.com, zegna-outlet-store.com, zegnaparis.com, zegnasingapore.com, zegnastorenyc.com, zegnasydney.com, zegnaturkey.com, zegnauae.com, zegnauk.com, zegnausa.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	CONSITEX S.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 the following registered trademarks:

- European Union trademark no. 011679792 "ZEGNA" (word mark), filed on 22 March 2013, registered since 1 August 2013 in classes 3, 14, 18, 24, 25, 28, 35, and claiming seniority in Cyprus and the UK since 1971, in the Austria since 1993, and in Poland since 2001;
- International trademark no. 466534 "ZEGNA" (word mark), registered since 27 January 1982 in classes 3, 14, 18, 28;
- International trademark no. 899314A "ZEGNA" (word mark), registered since 28 February 2006 in class 9;
- European Union trademark no. 002516524 "ERMENEGILDO ZEGNA" (word mark), filed on 24 December 2001, registered since

14 May 2003 in classes cl. 3, 14, 18, 23, 24, 25, 35, 42, and claiming seniority in Austria, France, Germany, Ireland, Spain, Sweden and the UK since 1974, and in Finland since 1984;
- European Union trademark no. 001436716 "ERMENEGILDO ZEGNA" (figurative mark), filed on 24 July 1996, registered since 19 August 1998 in class 25;
- International trademark no. 1197199 "ERMENEGILDO ZEGNA" (word mark), registered since 11 February 2014 in class 20.

The above-mentioned marks are collectively or individually referred to as "the Complainant's trademarks", "the Complainant's ZEGNA and ERMENEGILDO ZEGNA trademarks", "the ZEGNA and ERMENEGILDO ZEGNA trademarks" or "the ZEGNA trademark", "the ERMENEGILDO ZEGNA trademark".

FACTUAL BACKGROUND

The Complainant, founded as a fabric maker in 1910 by Ermenegildo Zegna in Trivero, Italy, is a Swiss corporation, listed on the New York Stock Exchange, and owner of the ZEGNA and ERMENEGILDO ZEGNA trademarks with several international and national trademark registrations worldwide. The Complainant's trademarks are today internationally recognized as leading global luxury menswear brands.

The Complainant has also registered several domain names comprising or consisting of the ZEGNA and ERMENEGILDO ZEGNA trademarks, including <zegna.com> since 28 February 1996, <ermenegildozegna.com> since 19 August 1997, <zegna.cn> since 17 March 2003, and <zegnagroup.com> since 20 October 2008. These domain names are used by the Complainant as its official websites, promoting its activities and offering for sale its products.

The disputed domain names were registered by Web Commerce Communications Limited, located in Kuala Lumpur, Malaysia, between 9 and 16 October 2023.

The disputed domain names were used to resolve to websites mimicking the Complainant's website(s) and, thus, to impersonate the Complainant.

The Complainant sent a cease and desist letter to the Respondent through the Registrar without obtaining any response.

Currently, the disputed domain names do not resolve to any active website.

These facts are asserted by the Complainant and are not contested by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

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

In particular, the Complainant contends that the disputed domain names are confusingly similar to its trademark, since they contain the Complainant's ZEGNA and ERMENEGILDO ZEGNA trademarks in their entirety. The additional terms and the TLD do not prevent the likelihood of confusion between the disputed domain names and the Complainant's trademarks.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark, or apply for registration of the disputed domain names by the Complainant. The Respondent is not commonly known by the disputed domain names, nor has acquired any rights in a trademark or trade name corresponding to the disputed domain names.

Finally, the Complainant contends that, given the distinctiveness and reputation of its trademarks, it is unlikely that the Respondent had no knowledge of the Complainant's trademarks when he registered the disputed domain names confusingly similar to such marks. The Respondent's awareness of the Complainant's trademarks and his intention to target the Complainant are also confirmed by the use, namely the association of the disputed domain names with e-commerce sites mimicking the Complainant's website(s). Hence, the Respondent has registered and are using the disputed domain names having in mind the Complainant and its trademarks and with the clear intention to take advantage of the reputation of the same by creating a likelihood of confusion between such marks and the disputed domain names.

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.

Under paragraph 10(e) of the Rules, the Panel shall decide, on its own discretion, to consolidate multiple domain name disputes in accordance with the Policy and the Rules. At the same time, paragraph 3(c) of the 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.

In deciding consolidation, 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 shall also be taken into consideration by panels (paragraph 10(c) of the Rules: "The Panel shall ensure that the administrative proceeding takes place with due expedition").

The following circumstances of the present case have convinced the Panel to accept the Complainant's consolidation request of 41 domain names in one-single Complaint:

- The temporal proximity of the registration dates of the disputed domain names (9, 12, 13 and 16 October 2023);
- All disputed domain names were registered with the same Registrar (Alibaba.com Singapore E-commerce Private Limited) and the same privacy/proxy service (Web Commerce Communications Limited);
- The naming pattern of the disputed domain names consisting in the Complainant's ZEGNA and ERMENEGILDO ZEGNA trademarks plus geographic and/or generic and descriptive terms related to the Complainant's activities in the fashion industry ("outlet", "factoryoutlet", "store");
- All disputed domain names are currently inactive, but, prior to the dispute, resolved to websites mimicking the Complainant's website(s) (see below for more details).

Accordingly, the Panel finds that, on the balance of the probabilities, the disputed domain names are subject to common control, and the consolidation of the dispute is fair and equitable to the parties and in line with the principle of procedural efficiency.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 15(a) of the Rules, the Panel shall decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy sets out the grounds which the Complainant is required to establish to succeed in the administrative proceeding:

(i) the disputed domain names are identical or confusingly similar to a trade mark 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 names; and
(iii) the disputed domain names have been registered and are being used by the Respondent in bad faith.

Therefore, the onus of meeting the above threshold is incumbent on the Complainant. The evidentiary standard in UDRP disputes is the "balance of probabilities", meaning that a party should demonstrate to the Panel's satisfaction that it is more likely than not that a claimed fact is true.

I. THE COMPLAINANT'S RIGHTS AND THE CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S MARKS

The Complainant has established to have rights in the ZEGNA and ERMENEGILDO ZEGNA trademarks.

Based on their composition, the disputed domain names can be divided in 5 groups:

1. Group 1 - ZEGNA trademark + geographical term (33 domain names): zegnaargentina.com, zegnachile.com, zegnagreece.com, zegnahrvatska.com, zegnahungary.com, zegnaindia.com, zegnaireland.com, zegnajapan.com, zegna-london.com, zegnaperu.com, zegnaportugal.com, zegnaromania.com, zegnaslovenija.com, zegnasrbija.com, zegnaturkiye.com, zegna-uae.com, zegnaus.com, zegnabelgium.com, zegnanederland.com, zegnadanmark.com, zegnanorge.com, zegnaaustralia.com, zegna-canada.com, zegnadeutschland.com, zegnalondon.com, zegnamexico.com, zegnaparis.com, zegnasingapore.com, zegnasydney.com, zegnaturkey.com, zegnauae.com, zegnauk.com, zegnausa.com;
2. Group 2 - ZEGNA trademark + generic/descriptive term(s) (4 domain names): zegna-outletstore.com, zegnafactoryoutlet.com, zegna-outlet.com, zegna-outlet-store.com;
3. Group 3 - ZEGNA trademark + geographical term + generic/descriptive term (2 domain names): zegnacanadaoutlet.com, zegnastorenyc.com
4. Group 4 - ERMENEGILDO ZEGNA trademark + geographical term (1 domain name): ermenegildozegnanz.com
5. Group 5 - ERMENEGILDO ZEGNA trademark + generic/descriptive term (1 domain name): ermenegildozegnaoutlet.com

In UDRP disputes the test for identity or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. The addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) to a complainant's trademark does not prevent a finding of confusing similarity under the first element. The TLD is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the complainant's trademark as it is a technical requirement of registration.

The Panel finds that the disputed domain names are confusingly similar to the Complainant's trademarks, because they all contain the entirety or at least the distinctive part of the Complainant's trademarks, namely "ZEGNA" or "ERMENEGILDO ZEGNA", combined with geographical and/or generic and descriptive terms. These additional terms neither affect the attractive power of the Complainant's marks, nor are sufficient to distinguish the disputed domain names from the Complainant's ZEGNA and ERMENEGILDO ZEGNA trademarks. Rather, being the generic and descriptive terms related to the Complainant's industry (fashion), they even increase the likeliness of confusion between the disputed domain names and the Complainant's trademarks. Therefore, the Internet users might erroneously believe that the disputed domain names and/or any related web services (websites, emails, etc.,) are owned by or under the control of the Complainant.

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name are confusingly similar to the Complainant's marks.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain names. If the 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 names.

The Complainant denies any affiliation and/or association with, or authorisation for, the Respondent of any nature. There is no contractual arrangement between the parties to that effect, nor has the Complainant otherwise authorised the Respondent to make any use of the Complainant's trademarks. Moreover, there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain names.

All disputed domain names incorporate the Complainant's trademarks plus additional geographical and/or generic and descriptive terms, and, thus, are confusingly similar to the Complainant's trademarks.

UDRP panels have found that domain names identical or confusingly similar to a complainant's trademark carry a high risk of implied affiliation. A domain name consisting of a trademark plus an additional term at the second- or top-level is seen as tending to suggest sponsorship or endorsement by the trademark owner. Thus, UDRP panels have largely held that such composition cannot constitute fair use.

Although at the time of issuance of this decision the disputed domain names are not resolving to any active website, the Complainant has provided documentary evidence showing that, before any notice of the dispute, the Respondent had used the disputed domain names to impersonate the Complainant and redirect Internet users to websites mimicking a number of features of the Complainant's website(s). More precisely, all websites had the same structure, displayed the ZEGNA trademark in a prominent place (at the top of the site) as well as its copyrighted images, and offered for sale the Complainant's products.

Panels have categorically held that the use of a domain name for illegal activity (including unauthorised account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

Therefore, the Panel is unconvinced that, before any notice of the dispute, the Respondent used or prepared to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a bona fide offering of goods or services or 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 trademarks.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain names.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain names.

III. THE RESPONDENT'S BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES

The disputed domain names have been registered and are being used in bad faith for the following cumulative reasons.

Firstly, the Complainant's trademarks predate the registration of the disputed domain names by many years, in fact for over five decades. During the years, thanks to the promotion activities of the Complainant, the Complainant's trademarks have achieved notoriety worldwide. The Complainant has provided sufficient evidence to prove that its trademarks are widely well-known all over the world, confirmed also by other UDRP panels (e.g., WIPO UDRP Decision DWS2003-0001). All disputed domain names contain the ZEGNA trademark or the ERMENEGILDO ZEGNA trademark in their string, coupled with geographical and/or generic and descriptive terms which are immaterial to affect the recognisability of the Complainant's well-known trademarks. The Panel has, therefore, no hesitation in finding that the Respondent has registered the disputed domain names with knowledge of, and intention to target the Complainant and to exploit the reputation of the Complainant's trademarks by diverting traffic away from the Complainant's official website(s).

Having the Respondent registered 41 domain names, the Panel finds that the Respondent is engaged in a pattern of conduct and has registered the disputed domain names in order to prevent the Complainant from reflecting its marks in corresponding domain names (paragraph 4(b)(ii) of the Policy).

As regards the bad faith use, the Panel has considered the available record and found compelling indicia that the Respondent had purposefully used the Complainant's trademarks on his websites to deceive Internet users into a mistaken belief of affiliation or connection with the Complainant, and that the Respondent was offering for sale the products of the Complainant. Therefore, the Respondent's sole purpose with the registration and use of the disputed domain names was to impersonate the Complainant (paragraph 4(b)(iv) of the Policy).

Even though at the time of rendering this decision the disputed domain names are not resolving to any active website, considered all circumstances of the case, the Panel is dissuaded that it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain names by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's ZEGNA and ERMENEGILDO ZEGNA trademarks under trademark law.

In the view of the above, the Panel finds that the Complainant has met the third requirement of the paragraph 4(a) of the Policy and the Respondent has registered and is using the disputed domain names in bad faith.

The disputed domain names are, therefore, to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **zegnaargentina.com**: Transferred
2. **zegnacanadaoutlet.com**: Transferred
3. **zegnachile.com**: Transferred
4. **zegnagreece.com**: Transferred
5. **zegnahrvatska.com**: Transferred
6. **zegnahungary.com**: Transferred
7. **zegnaindia.com**: Transferred
8. **zegnaireland.com**: Transferred
9. **zegnajapan.com**: Transferred

10. **zegna-london.com**: Transferred
11. **zegna-outletstore.com**: Transferred
12. **zegnaperu.com**: Transferred
13. **zegnaportugal.com**: Transferred
14. **zegnaromania.com**: Transferred
15. **zegnaslovenija.com**: Transferred
16. **zegnasrbija.com**: Transferred
17. **zegnaturkiye.com**: Transferred
18. **zegna-uae.com**: Transferred
19. **zegnaus.com**: Transferred
20. **zegnabelgium.com**: Transferred
21. **zegnanederland.com**: Transferred
22. **zegnadanmark.com**: Transferred
23. **zegnanorge.com**: Transferred
24. **ermenegildozegnanz.com**: Transferred
25. **ermenegildozegnaoutlet.com**: Transferred
26. **zegnaaustralia.com**: Transferred
27. **zegna-canada.com**: Transferred
28. **zegnadeutschland.com**: Transferred
29. **zegnafactoryoutlet.com**: Transferred
30. **zegnalondon.com**: Transferred
31. **zegnamexico.com**: Transferred
32. **zegna-outlet.com**: Transferred
33. **zegna-outlet-store.com**: Transferred
34. **zegnaparis.com**: Transferred
35. **zegnasingapore.com**: Transferred
36. **zegnastorenyc.com**: Transferred
37. **zegnasydney.com**: Transferred
38. **zegnaturkey.com**: Transferred
39. **zegnauae.com**: Transferred
40. **zegnauk.com**: Transferred
41. **zegnausa.com**: Transferred

PANELLISTS

Name	**Ivett Paulovics**

DATE OF PANEL DECISION 2024-05-03

Publish the Decision