Decision for dispute CAC-UDRP-106316

Case number	CAC-UDRP-106316
Time of filing	2024-04-11 09:14:57
Domain names	berettafirearmsamerica.com

Case administrator

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

Complainant

Organization	Fabbrica d'Armi Pietro Beretta S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Organization	Domain Administrator

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 name.

IDENTIFICATION OF RIGHTS

The Complainant owns a portfolio of word and figurative trade marks consisting of or incorporating the name BERETTA, including the International trade mark BERETTA, registration number 147879, first registered on 7 July 1950 in international classes 8 and 13; the International trade mark BERETTA, registration number 746766, first registered on 8 November 2010 in international class 9; the European Union trade mark BERETTA, registration number 9743543, first registered on 17 February 2011 in international classes 9, 9, 13, 14, 18, 25 and 34; and the European Union trade mark BERETTA, registration number 3801537, first registered on 19 August 2005 in international class 28. The aforementioned trade mark registrations of the Complainant predate the registration of the disputed domain name.

Furthermore, the Complainant also owns numerous domain names which consist of or incorporate the name BERETTA, including <beretta.com>, first registered on 18 March 1997; <beretta.it>, first registered on 29 August 2014; <berettadefense.com> [sic], first registered on 18 January 2021; and <berettaholding.com>, first registered on 6 August 2012; which are connected to the Complainant's official websites through which it informs Internet users and customers about its products and services.

Finally, the Complainant also has a prominent presence on social media with channels and pages specifically dedicated to it, for example, on Facebook (https://www.facebook.com/BERETTAofficial (1.246.366 followers)); Instagram (https://www.instagram.com/berettaofficial (858.000 followers)); Twitter (https://twitter.com/Beretta_1526); and YouTube (https://www.youtube.com/user/BerettaVideos).

FACTUAL BACKGROUND

Founded in 1526, the Complainant is a prominent, privately held Italian firearms manufacturing company operating in countries around the world and the oldest active manufacturer of firearm components in the world. Nowadays, the Complainant's firearms are used worldwide for a variety of civilian, law enforcement and military purposes. Sporting arms account for three-quarters of its sales, but it is also renowned for selling other products, such as shooting clothes and accessories. In 2021, Beretta Holding earned Euro 958 million of revenue (of which Euro 250 million was generated by the Complainant. Beretta Holding has more than 3380 employees based not only in Europe but also in Australia, New Zealand, Russia, Turkey, USA and China.

The disputed domain name <berettafirearmsamerica.com> was registered on 15 July 2023. The disputed domain name resolves to an imitation website, using the Complainant's trade marks and images, and offering firearms at highly discounted prices.

PARTIES CONTENTIONS

The Complainant contends that all three elements of the UDRP have been fulfilled and it therefore requests the transfer of the disputed domain name to the Complainant.

No administratively compliant response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trade mark 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 name (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 name has been registered and is 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

With regard to the first UDRP element, the Panel finds that the disputed domain name <berettafirearmsamerica.com> is confusingly similar to the Complainant's trade mark BERETTA. Indeed, the disputed domain name incorporates the Complainant's trade mark in its entirety but adds the descriptive term "firearms" and the geographical term "[a]merica" as suffixes to the Complainant's trade mark. The Panel follows in this respect the view established by numerous other decisions that a domain name which wholly incorporates a Complainant's registered trade mark may be sufficient to establish confusing similarity for the purposes of the UDRP (see, for example, WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin <porsche-autoparts.com>). Furthermore, the Panel accepts the Complainant's submission that its trade mark BERETTA is well-known. The incorporation of a complainant's well-known trade mark in the disputed domain name has been considered to be sufficient to find the disputed domain name to be confusingly similar to a complainant's trade mark (see WIPO Case No. D2000-0138, Quixtar Investments, Inc. v. Smithberger and QUIXTAR-IBO <quixtar-sign-up.com>; and WIPO Case No. D2001-0110, Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd <ansellcondoms.com>). The Panel further considers it to be well established that the addition of a descriptive or geographical term does not allow the disputed domain name to avoid confusing similarity with a trade mark (see, for example, WIPO Case No. D2019-2294, Qantas Airways Limited v. Quality Ads <qantaslink.com>; and CAC Case No. 102137, Novartis AG v. Black Roses <novartiscorp.com>). Other panels have previously found that "[W]here the relevant trademark is recognizable within the

Disputed Domain Name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element" (see WIPO Overview 3.0, section 1.8; and, for example, WIPO Case No. D2023-2542, Merryvale Limited v. tao tao <wwbetway.com>; and WIPO Case No. D2020-0528, Philip Morris Products S.A. v. Rich Ardtea <global-iqos.com>).

Against this background, the Panel finds that the addition of the descriptive term "firearms" and the geographical term "[a]merica" is not sufficient to alter the overall impression of the designation as being connected with the Complainant's trade mark and does not prevent a likelihood of confusion between the disputed domain name and the Complainant, its trade mark and its associated domain names. To the contrary, the disputed domain name rather adds to the likelihood of confusion because the addition of the descriptive term "firearms", which relates to the Complainant's field of activity, and of the geographical term "[a]merica", which identifies the location and market at which the website accessed through the disputed domain name is targeted, in conjunction with the Complainant's trade mark BERETTA, suggests that the disputed domain name links to an official website of the Complainant, and implies that it is linked to the Complainant and its business.

With regard to the second UDRP element, the Panel notes that the disputed domain name resolves to a website impersonating the Complainant's official website, and using the Complainant's trade mark and product images. The website also includes an e-commerce functionality and offers for sale a range of products by reference to the Complainant's trade mark. The Complainant alleges that the products offered for sale are clearly counterfeit. While that allegation is not supported by any evidence, and panels are generally not prepared to accept merely conclusory or wholly unsupported allegations of illegal activity, including counterfeiting, even when the respondent is in default, the products offered for sale are clearly offered at highly discounted prices. The Panel further notes that the website accessed through the disputed domain name carries a high risk of affiliation with the Complainant, suggesting that it is either the Complainant's own website, or are at least endorsed by the Complainant, where this is not the case. The Panel accepts the Complainant's submissions that the Respondent is not affiliated with or related to the Complainant in any way, and is neither licensed nor otherwise authorised to make any use of the Complainant's trade mark, or to apply for or use the disputed domain name. Indeed, the website accessed through the disputed domain name does not identify who owns and operates it and does not clearly and prominently identify the registrant's relationship with the Complainant.

In those circumstances, the Panel accepts that the website accessed through the disputed domain name takes unfair advantage of the Complainant's trade mark for the purpose of re-directing traffic to that website for commercial gain, and also for the purpose of misleading Internet users because it seeks to impersonate the Complainant. The Panel therefore concludes that the website to which the disputed domain name resolves does not constitute a bona fide offering of goods or services.

Furthermore, the Whois information does not suggest that the Respondent is commonly known by the disputed domain name <berettafirearmsamerica.com>. Past panels have held that a respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name, as is equally not the case here (see, for example, Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).")). Neither is there any indication that the Respondent is making any legitimate non-commercial or fair use of the disputed domain name. Against this background, and absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interest in the disputed domain name.

With regard to the third UDRP element, it is reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be confusingly similar to the Complainant's trade mark, and that he registered the disputed domain name in full knowledge of the Complainant's trade mark. If the Respondent had carried out a Google search for the term "Beretta", the search results would have yielded immediate results related to the Complainant, its websites, and its connected business, products and services. Indeed, it is likely that the disputed domain would not have been registered if it were not for the Complainant's trade mark (see, for example, WIPO Case No D2004-0673 Ferrari Spa -v- American Entertainment Group Inc). The Panel notes that the Respondent seeks to attract Internet users to his own website for commercial gain, based on the Complainant's trade mark, which constitutes further evidence of bad faith (see, for example, WIPO Case No D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC ("In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve […] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.")). Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **berettafirearmsamerica.com**: Transferred

PANELLISTS

Name	Gregor Kleinknecht LLM MCIArb

DATE OF PANEL DECISION 2024-05-12

Publish the Decision