Decision for dispute CAC-UDRP-106577

Case number	CAC-UDRP-106577
Time of filing	2024-06-04 09:28:18
Domain names	fashionzegnas.top, shopzegna.top, zegnastore.shop, zegnastore.top, zegna-it.shop

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	CONSITEX S.A.

Complainant representative

Organization	Convey srl

Respondents

Organization	NameSilo, LLC
Organization	NameSilo, LLC
Organization	NameSilo, LLC
Organization	NameSilo, LLC
Name	Parker Martin

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the disputed domain names <fashionzegnas.top>, <shopzegna.top>, <zegnastore.shop>, <zegnastore.top>, and <zegna-it.shop> ('the disputed domain names').

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks, amongst others:

- International trade mark registration no. 466534, registered on 21 January 1982, for the mark ZEGNA, in classes 3, 14, 18, and 28 of the Nice Classification; and
- International trade mark registration no. 899314A, registered on 28 February 2006, designating China, for the mark ZEGNA, in class 9 of the Nice Classification

(Collectively or individually referred to as 'the Complainant's trade mark', 'the Complainant's trade mark ZEGNA', or 'the trade mark

ZEGNA').

The disputed domain names were registered on the following dates:

- <fashionzegnas.top>: 1 May 2024
- <shopzegna.top>: 24 April 2024
- <zegnastore.shop>: 26 March 2024
- <zegnastore.top>: 19 April 2024
- <zegna-it.shop> 11 May 2024

At the time of writing, the disputed domain names do not resolve to active websites (for present purposes, 'the Respondent's websites').

FACTUAL BACKGROUND

A. Complainant's Factual Allegations

The Complainant is an Italian luxury fashion house founded in 1910 by Ermenegildo Zegna. The Complainant is a public company listed on the New York Stock Exchange since 2021.

The Complainant has a global presence and, in 1991, it became the first luxury brand to enter the Chinese market.

In addition to the trade marks mentioned in the above section 'Identification of Rights', and other trade marks in its portfolio, the Complainant also owns domain names bearing the trade mark ZEGNA, mostly notably <zegna.com> (registered in 1996) and <zegna.cn> (registered in 2003).

The Complainant seeks to obtain the transfer of the disputed domain names <fashionzegnas.top>, <shopzegna.top>, <zegnastore.shop>, <zegnastore.top>, and <zegna-it.shop> on the grounds set out in section A.2 below.

B. Respondent's Factual Allegations

The Respondent has defaulted in this UDRP administrative proceeding and has consequently made no factual allegations.

PARTIES CONTENTIONS

A. Complainant

A.1 Preliminary Issues

A.1.1 Application for Consolidation of Complaints against Multiple Registrants

In the Complaint, the Complainant advises that the disputed domain names are owned by the following individuals/entities:

Disputed domain name	Registrant
<fashionzegnas.top>	NameSilo, LLC
<shopzegna.top>	NameSilo, LLC
<zegnastore.shop>	NameSilo, LLC
<zegnastore.top>	NameSilo, LLC
<zegna-it.shop>	Parker Martin

The Complainant claims that the disputed domain names are subject to a common control or a single individual/entity or, at least, by a group of individuals acting in concert, thereby making the consolidation of the proceedings equitable and procedurally efficient

('the Complainant's Application for Consolidation').

The Complainant's Application for Consolidation is grounded on the following factors:

i) the disputed domain names <fashionzegnas.top>, <shopzegna.top>, <zegnastore.shop>, <zegnastore.top>, except <zegna-it.shop>, all share the same registrant and registrar (NameSilo, LLC)

ii) the disputed domain names share the same hosting provider (CloudFlare Inc.);

iii) the registrants of the disputed domain names are from the same country (USA); and

iv) the websites corresponding to the disputed domain names contain identical layouts, physical address, user registration section, contact e-mail, and products being offered.

The Complainant further alludes to paragraph 4.11.2 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ('WIPO Jurisprudential Overview 3.0'), which provides a range of factors typically considered by panels to determining whether a request for consolidation is appropriate.

For the foregoing reasons, the Complainant seeks an order that the disputed domain names and the named Respondents be consolidated into a single UDRP administrative proceeding.

For present purposes, the registrants/holders on record of the disputed domain names are hereinafter collectively referred to as 'the Respondent'.

A.1.2 Language of the Proceeding Request

With respect to the language of the proceedings, the Panel notes as follows:

• The Complaint is submitted in English and the Complainant has made a pre-emptive request that English be the language of this UDRP administrative proceeding;

• According to the registrar's verification response, the language of the registration agreements for the disputed domain names <fashionzegnas.top>, <shopzegna.top>, <zegnastore.shop>, <zegnastore.top> is English, whilst the language of the registration agreement for the disputed domain name <zegna-it.shop> is Chinese; and

• The Complainant's grounds for English to be the language of this UDRP administrative proceeding can be summarised as follows: (i) the disputed domain names contain Latin characters and English words ,such as 'shop' and 'store'; (ii) the Top-Level Domains ("TLDs") of the disputed domain names are English words, namely 'top' and 'shop'; (iii) it would be unfair to proceed in Chinese owing to the delay and costs associated with translations; and (iv) English is the primary language for business and international relations.

A.2 Substantive grounds

A.2.1 The disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant submits that the disputed domain names are confusingly similar to the Complainant's trade mark ZEGNA, in so far as they incorporate the Complainant's trade mark in its entirety. The additional non-distinctive, descriptive elements, as well as the TLDs, in this case <.shop> and <.top>, have no bearing on the confusing similarity test.

A.2.2 The Respondent has no rights or legitimate interests in respect of the disputed domain names

The Complainant avers that the disputed domain names are not being used in connection with a bona fide offering of goods or services. The disputed domain names resolve to online shops with the infringing use of the Complainant's trade mark ZEGNA, purporting to sell a variety of goods of the Complainant, at prices disproportionally below market value. The Complainant argues that this is evidence of counterfeit goods, the result of which being that the Oki Data test is inapplicable.

The Complainant claims that the Respondent is not a licensee, authorised agent of the Complainant or in any other way authorised to use the Complainant's trade mark. Moreover, the Respondent is not an authorised reseller of the Complainant and has not been authorised to register or use the disputed domain names. Besides, there is no disclaimer as to the Respondent’s lack of relationship with the Complainant on the Respondent's websites.

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain names.

A.2.3 The Respondent registered and is using the disputed domain names in bad faith

Registration

The Complainant submits that the trade mark ZEGNA long predates the registration of the disputed domain names, and that the Complainant's worldwide reputation in the sector of luxury fashion makes it reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trade mark.

The Respondent's actual knowledge of the Complainant is furthermore demonstrated by the use of the Complainant's trade mark ZEGNA and copyrighted materials on the Respondent's websites, as well as the Respondent's offering of replicas of the Complainant's goods.

Use

Under this UDRP Policy ground, the Complainant submits that the use of the disputed domain names evidences the Respondent's underlying intention to capitalise on the reputation of the trade mark ZEGNA by diverting Internet users seeking ZEGNA products to the Respondent's websites, for financial gain, by intentionally creating a likelihood of confusion with the trade mark ZEGNA as to the source, sponsorship, affiliation, or endorsements of the Respondent's websites and/or the goods offered through the Respondent's websites (paragraph 4(b)(iv) of the UDRP Policy).

Lastly, the Complainant submits that the Respondent has failed to respond to a cease-and-desist letter, and that the Panel is entitled to draw adverse inferences therefrom.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain names in bad faith.

B. Respondent

The Respondent has defaulted in this UDRP administrative proceeding and, consequently, it has failed to advance any substantive case on the merits.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP 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 UDRP Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the UDRP Policy).

PROCEDURAL FACTORS

1. Complainant's Application for Consolidation

The Complainant has made an application to consolidate its UDRP claims in respect of the five disputed domain names featuring two different registrants (identified in section A.1.1 above) into one single UDRP administrative proceeding, for the reasons articulated in the same section A.1.1.

The Panel has considered the available record, the UDRP legal framework, and the WIPO Jurisprudential Overview 3.0, paragraph 4.11.2, which enumerates circumstances underpinning the panel's consideration of a consolidation request.

Under the UDRP Rules (Rule 10(b) and Rule 10(c)), the Panel shall seek to promote procedural (cost and time) efficiency while also ensuring that the parties are treated with equality and that each party is given a fair opportunity to present its case.

The Panel is of the view that interlocutory/interim applications sought by parties in UDRP administrative proceedings require panels to apply the balance of convenience test, according to which panels would have a duty to consider who would suffer the greatest inconvenience as a result of the panel's determination.

The Panel has perused paragraph 4.11.2 of the WIPO Jurisprudential Overview 3.0, which lists a whole host of considerations which may assist panels in the determination of whether a consolidation is appropriate. Considerations conducive to a finding of common control would include commonalities and patterns in the registrant information, for example shared administrative or technical contacts, email or postal addresses, the content and layout of the website to which the domain name resolves, and any other circumstances which could point in the direction of a unity of interests, such that the registrants may be treated as a single domain name holder within the scope of Rule 3(c) of the UDRP Rules.

The Panel considers the following as the most persuasive factors to a finding in favour of the Complainant: (i) with the exception for <zegna-it.shop>, the disputed domain names <fashionzegnas.top>, <shopzegna.top>, <zegnastore.shop>, <zegnastore.top> all share the same registrar and registrant names; (ii) the disputed domain names share the same hosting provider; (iii) the registrants' identical country of origin (USA) on record; (iv) the similarities of content and layout of the websites corresponding to the disputed domain names; (v) the fact that the registrants have targeted a specific sector and mark; (vi) the naming patterns in the disputed domain names being <mark+generic term> or <generic term+mark>; and (vii) the disputed domain name <zegna-it.shop>, despite not sharing the registrar and registrant names, contains a similar string structure to the other disputed domain names, and was registered within less than two months apart.

On balance, it would therefore appear to the Panel that the disputed domain names are subject to common control. In addition, the Panel has weighed the balance of convenience and decided to grant the Complainant's Application for Consolidation. The dismissal would likely to cause the Complainant the greatest burden and interfere with the overall due expedition of this UDRP administrative proceeding.

The Panel therefore accedes to the Complainant's request for consolidation, and the Panel will refer to the registrants/holders of the disputed domain names collectively as 'the Respondent' in the remainder of the decision.

2. Complainant's Language Request

The Panel is given discretion under Rule 11 of the UDRP Rules to determine the appropriate language of the UDRP administrative proceeding. The Panel notes Rule 10 of the UDRP Rules, which vests the Panel with authority to conduct the proceedings in a manner it deems 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.

With regard to this particular matter, the Panel takes the liberty to adopt the language of proceeding test applied in CAC Case no. 104144, Writera Limited v. alexander ershov, which helpfully sets out the following six guiding factors:

(i) the language of the disputed domain name string: the Panel considers that English words are the only identifiable language in the string of each of the five disputed domain names;

(ii) the content of the Respondent's website: while the Respondent's websites are presently inactive, the Complainant has supplied evidence that the Respondent's websites hosted content in English only, which suggests to the Panel that the Respondent has knowledge of the English language;

(iii) the language(s) of the Parties: the Complainant is incorporated in Italy and the Respondent appears to be an individual/entity resident or incorporated in China. The English language would therefore be considered neutral for both Parties;

(iv) the Respondent's behaviour: the Panel notes that the Respondent has shown no inclination to participate in this UDRP administrative proceeding, nor has the Respondent responded to the Complainant's letter before action;

(v) the Panel's overall concern with due process: the Panel has discharged its duty under Rule 10 (c) of the UDRP Rules; and

(vi) the balance of convenience: while determining the language of the UDRP administrative proceeding, the Panel has a duty to consider who would suffer the greatest inconvenience as a result of the Panel's determination. On the one hand, the determination of English as the language of this UDRP administrative proceeding – a widely spoken language – is unlikely to cause the Respondent any inconvenience, not least given that the Respondent's websites hosted content in English only. The determination of Chinese as the language of this UDRP administrative proceeding, on the other hand, is very likely to cause the Complainant inconvenience, and to interfere with the overall due expedition of the proceedings under the UDRP Rules.

In view of the above factors, the Panel has decided to accept the Complainant's change of language request, such that the decision in the present matter will be rendered in English.

3. Miscellaneous

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

A. UDRP Threshold

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint based on the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy sets out the grounds which the Complainant must establish to succeed:

> i) The disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;

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 in bad faith.

It is incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP administrative proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three UDRP Policy grounds in turn.

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has UDRP-relevant rights in the registered trade mark ZEGNA since at least 1982.

The disputed domain names are <fashionzegnas.top>, <shopzegna.top>, <zegnastore.shop>, <zegnastore.top>, and <zegna-it.shop>. They were registered between March 2024 and May 2024, and each of which contains the Complainant's trade mark ZEGNA in its entirety, together with the generic words 'shop', 'fashion', and 'store', as well as the geographical abbreviation 'it'(for Italy). These adjacent words and the abbreviation have no material impact on the recognisability of the Complainant's trade mark in the strings of the disputed domain names. Moreover, the TLDs are typically disregarded by UDRP panels under this UDRP Policy ground owing to them being a standard registration requirement (see WIPO Jurisprudential Overview 3.0, paragraph 1.11).

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

C. Rights or Legitimate Interests

The Panel notes that 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 trade mark. 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.

The Complainant claims that the Respondent is not an authorised reseller of the Complainant and that the Respondent's websites do not contain disclaimers as to the parties' lack of relationship.

On this point, the Panel alludes to the jurisprudential view formed by domain name disputes under the UDRP Policy and UDRP Rules (see WIPO Jurisprudential Overview 3.0, paragraph 2.8), according to which resellers and distributors using a domain name containing a complainant's trade mark to undertake sales related to the complainant's goods or services may be making a bona fide offering of goods and services, and thus have a legitimate interest in such domain name. UDRP panels have termed this as the 'Oki Data test' (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), which comprises the following four cumulative requirements:

1. The Respondent must actually be offering the goods or services at issue;

2. The Respondent must use the website associated with the disputed domain names to sell only the trade marked goods or services;

3. The Respondent's website must accurately and prominently disclose its relationship with the Complainant; and

4. The Respondent must not try to 'corner the market' in domain names that reflect the trade mark.

The Parties are reminded that the above requirements are cumulative, so that the failure to satisfy any of them would result in a finding for the Complainant regarding this UDRP Policy ground.

The Panel has considered the evidence on the record and notes that the Respondent would have failed to meet the Oki Data test, the Panel being unable to locate a disclaimer regarding the relationship between the Respondent and the Complainant (requirement 3 above) on the Respondent's websites.

Moreover, the Panel is unconvinced that, before any notice of the dispute, the Respondent used, or made demonstrable preparations 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.

Lastly, there is evidence on the record underscoring the Respondent's attempt to mislead Internet users into a false sense of affiliation with the Complainant, as discussed in section D. below.

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute any of the allegations and evidence adduced by the Complainant in this UDRP administrative proceeding, the Panel finds that the Complainant has made prima facie showing of the Respondent’s lack of rights or legitimate interests in the Disputed Domain Names under the UDRP Policy.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

D. Registered and Used in Bad Faith

The Complainant raises a number of factors that may indicate registration and use in bad faith of the disputed domain names. Firstly, the Complainant's trade mark predates the registration of the disputed domain names by over four decades. Secondly, the disputed domain names all bear the trade mark ZEGNA in their strings, coupled with an abbreviation and generic words immaterial

to affect the recognisability of the Complainant's trade mark. Therefore, the Panel has no hesitation in finding that the Respondent registered the disputed domain names with knowledge of, and intention to target, the Complainant.

With respect to the use in bad faith, the Complainant alleges that the Respondent has engaged in a conduct which would fall within the remit of paragraph 4(b)(iv) of the UDRP Policy:

> '(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 respondent's website or location'.

As mentioned above (section 'Identification of Rights'), the disputed domain names do not presently resolve to active websites. Nonetheless, the Panel has considered the available record and found persuasive evidence that the Respondent would have attempted to exploit the Complainant's fame and goodwill for its own commercial gain, by suggesting a commercial link with the Complainant. In the Panel's view, the Respondent's websites carry a high risk of deceiving Internet users into a mistaken belief of affiliation or connection with the Complainant and the Complainant's products. The Respondent's behaviour would consequently fall in the realm of paragraph 4(b)(iv) of the UDRP Policy.

For good order, the Panel has also taken stock of paragraph 3.3 (passive holding) of the WIPO Jurisprudential Overview 3.0, according to which UDRP panels have recognised various types of evidence to support a finding of bad faith on the basis of the non-use of a domain name. In this instance, the Panel considers the following as the decisive factors swaying in the Complainant's favour: (i) the degree of distinctiveness and reputation of the Complainant's trade mark in the fashion industry; (ii) the Respondent's failure to present a credible-backed rationale for registering the disputed domain names; and (iii) the implausibility of any good faith use to which the disputed domain names may be put.

In view of the above, the Panel finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

E. Decision

For the foregoing reasons, in accordance with paragraph 4(a) of the UDRP Policy and Rule 15 of the UDRP Rules, the Panel orders that the disputed domain names <fashionzegnas.top>, <shopzegna.top>, <zegnastore.shop>, <zegnastore.top>, and <zegna-it.shop> 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. **fashionzegnas.top**: Transferred
2. **shopzegna.top**: Transferred
3. **zegnastore.shop**: Transferred
4. **zegnastore.top**: Transferred
5. **zegna-it.shop**: Transferred

PANELLISTS

Name	**Yana Zhou**

DATE OF PANEL DECISION 2024-07-02

Publish the Decision