Decision for dispute CAC-UDRP-106663

Case number	CAC-UDRP-106663
Time of filing	2024-07-08 09:27:34
Domain names	VITTORIAUP.COM

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Vittoria S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	jie zhu

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 is the owner, among others, of the following registrations for the trademarks “VITTORIA” and “VITTORIA & device”:

- International trademark registration no. 479734 “VITTORIA”, registered on October 19, 1983 and duly renewed in class 12;
- International trademark registration no. 1160114 “VITTORIA device”, registered on March 14, 2013 and duly renewed in class 12, also covering China and USA;
- EU trademark registration no. 11541554 “VITTORIA & device”, registered on June 13, 2013 and duly renewed in class 12;
- EU trademark registration no. 018584162 “VITTORIA & device”, registered on March 19, 2022 in class 12;
- EU trademark application no. 018726663 “VITTORIA & device”, filed on June 30, 2022 in classes 9, 35 and 41, pending;
- USA trademark application no. 97498867 “VITTORIA & device”, filed on July 12, 2022 in classes 9, 35 and 41, pending.

The Complainant is also the owner, among the others, of the following domain names: <VITTORIA.COM>, <VITTORIA.IT>, <VITTORIA.EU>, <VITTORIA.CN>, <VITTORIA.DE>, <VITTORIA.TIRES>, <VITTORIA.GREEN>, <VITTORIAUSA.COM> and <VITTORIA2GO.COM>.

FACTUAL BACKGROUND

A. Complainant's Factual Allegations

The Complainant is an Italian bicycle tire manufacturer established in 1953. It has more than 1000 employees around the world and, with an annual production of over 7 million tires. It is among the largest operators in the sector. The Complainant's mission is to make the most advanced bicycle tires in the world.

The Complainant supplies 37 professional cycling teams all over the world and 4 National Cycling Federations. Moreover, it pursues its mission through the support of 16 ambassadors from anywhere. The Complainant produces and sells mainly road and mountain bike tires. Moreover, the Complainant's commercial offer includes also bicycle accessories. All these products are characterized by the trademarks "VITTORIA" and "VITTORIA & device" and they are advertised on the Complainant's website.

B. Respondent's Factual Allegations

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

The Respondent is Jie ZHOU based at the address of DaZhongZhenXinTuanCun2Zu45Hao, Yancheng, Jiangsu, China.

The disputed domain name was registered on November 17, 2023 by the Respondent, as confirmed by the Registrar.

As at the time of filing of the Complaint, the disputed domain name resolved to a website that offers goods and/or services that compete with the Complainant's own offerings.

PARTIES CONTENTIONS

A. COMPLAINANT

Language of the Proceedings

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

- The Complaint is written in English;
- According to the registrar's verification response ('the RVR'), the language of the registration agreement for the disputed domain name is Chinese;
- Following the RVR, and at the request of CAC, the Complainant submitted a request for English to be the language of this administrative proceedings, on the following grounds:

First of all, the Complainant is an Italian company, while the Respondent is a Chinese citizen and the language of the registration agreement is Chinese.

Given the above, the present Complaint was written in English, a third international language comprehensible to a wide range of Internet users worldwide, including the ones living in Italy and in China.

Since the spirit of Paragraph 11 of the Rules seems to be to ensure fairness in the selection of language by giving full considerations to the parties' level of comfort with each language, English seemed to be the fair language in the present proceeding.

Furthermore, it is true that there is no evidence of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English. However, it is not possible to ignore that the present dispute has been started because the Respondent deliberately registered a domain name which is identical to a well-known registered trademark legitimately owned and used by the Complainant in several countries, including China (using the same in connection with an English language website offering for sale bicycle tires and bicycle accessories, for whom the Complainant's trademarks are registered and used, and reproducing the layout and colors of Complainant's official website).

The Complainant's contentions can be summarized as follows:

I. The disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant contends that the disputed domain name "VITTORIAUP.COM" is identical or confusingly similar to the Complainant's trademarks. It exactly reproduces the well-known trademark "VITTORIA", with the mere addition of the acronym "UP", meaning something directed or moving towards a higher place or position.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name on the grounds: i) The Respondent is not authorized by the Complainant to register or use the disputed domain name; ii) The disputed domain name does not correspond to the name of the Respondent; iii) The Respondent is not commonly known as "VITTORIAUP"; iv) The Respondent has not any fair or non-commercial uses of the domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

Registration

The Complainant claims that the Respondent registered the disputed domain name in bad faith, because: i) The Complainant's

trademarks “VITTORIA” and “VITTORIA & device” are distinctive and well known all around the world. The Respondent had knowledge of the Complainant’s trademarks at the time of registration of the disputed domain name; ii) If the Respondent had carried even a basic Google search in respect of the wording “VITTORIA”, above all in relation to tires, the same would have yielded obvious references to the Complainant and the Respondent would have knowledge of the Complainant’s trademarks. It is highly unlikely that the Respondent was unaware of the Complainant’s trademark at the time of registering the disputed domain name.

Use

The Complainant contends that the Respondent is using the disputed domain name in bad faith. The disputed domain name is connected to a website offering for sale of bicycle tires and bicycle accessories, using the trademarks “VITTORIA”and “VITTORIA & device” and reproducing the layout and colors of Complainant’s official website. The Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant’s marks as to the source, sponsorship, affiliation, or endorsement of his web site (paragraph 4(b)(iv) of the Policy).

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

B. RESPONDEENT

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 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 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 language of the registration agreement is Chinese. The Complainant has requested that the language of proceedings be English. The Respondent did not respond on the issue of the language of the proceedings and did not reject the Complainant’s request.

The Panel is given discretion under Paragraph 11 of the Rules to determine the appropriate language of the administrative proceeding. Paragraph 10 of the Rules mentions that the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case. Based on the following factors, the Panel has decided that it would be fair and equitable to all parties to have the language of the proceedings be English:

- Complaint was written in English, an international language comprehensible to a wide range of internet users worldwide, including the ones living in Italy and in China;
- The Respondent’s website is an English language website, offering for sale of bicycle tires and bicycle accessories in English language;
- While determining the language of the administrative proceedings, 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 administrative proceedings – a widely spoken language – is unlikely to cause the Respondent any inconvenience. The determination of Chinese as the language of this administrative proceedings, 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 Rules (See Burberry Limited v Fei Cheng, CAC-UDRP-106643).
- The Complainant has requested that the language of proceedings be English. The Respondent did not respond to reject the Complainant’s request.

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

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, the Complainant shall prove the following three elements:

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) The registrant 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.

Based on the above regulations under the Policy, what the Panel needs to do is to find out whether each and all of the above-mentioned elements are established. If all the three elements are established, the Panel will make a decision in favor of the Complainant. If the three elements are not established, the claims by the Complainant shall be rejected.

The Respondent did not submit the Response of any argument against what the Complainant claimed and to show his intention to retain the disputed domain name as required by the Policy and the Rules. If the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint. In view of the situation, the Panel cannot but make the decision based primarily upon the contentions and the accompanying exhibits by the Complainant, except otherwise there is an exhibit proving to the contrary.

I. Identity or Confusing Similarity

Pursuant to Paragraph 4(a) (i) of the Policy, a Complainant must prove that the domain name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights.

(1) Complainant should have rights in a trademark or service mark

The Complainant has provided evidence of ownership of valid trademark registrations for trademarks “VITTORIA ” and “VITTORIA & device”, which were registered in 1983 and 2013 in class 6, covering China, EU and USA. The trademarks are still valid and their registration dates are much earlier than the registration date of the disputed domain name, i.e. November 17, 2023. The Complainant therefore has rights in the trademarks “VITTORIA ” and “VITTORIA & device”.

(2) The domain name should be identical or confusingly similar to the trademark or service mark

The disputed domain name contains the Complainant's trade mark “VITTORIA” in its entirety, together with the generic word “UP”. Numerous UDRP Panel decisions have established that the addition of words or letters to a mark used in a domain name does not alter the fact that the domain name is confusingly similar to the mark. WIPO Jurisprudential Overview 3.0, paragraph 1.8 mentions: “Where 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”.

The trademark “VITTORIA device” of the Complainant contains designs, which are not the dominant portion of the trademarks. Design elements are incapable of representation in domain names and largely disregarded for purposes of assessing identity or confusing similarity (See WIPO Jurisprudential Overview 3.0, paragraph 1.10).

As to the generic Top Level Domain “.com”, it is viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity (See WIPO Jurisprudential Overview 3.0, paragraph 1.11.1).

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights according to paragraph 4(a)(i) of the Policy. Accordingly, the Complainant has proven that the first element required by paragraph 4(a) of the Policy is established.

II. Rights or Legitimate Interests of the Respondent

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name on the grounds: i) The Respondent is not authorized by the Complainant to register or use the disputed domain name; ii) The disputed domain name does not correspond to the name of the Respondent; iii) The Respondent is not commonly known as “VITTORIAUP”; iv) The Respondent has not any fair or non-commercial uses of the domain name.

Once 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 name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element (See WIPO Jurisprudential Overview 3.0, paragraph 2.1).

Paragraph 4(c) of the Policy lists a number of circumstances which can be taken to demonstrate a respondent’s rights or legitimate interests in a domain name. However, the Respondent has failed to meet that burden. The Respondent did not submit any evidence to demonstrate any of the above circumstances.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has proven that the second element required by paragraph 4(a) of the Policy is established.

III. Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the disputed domain name has been registered and is being used in bad faith.

A. The disputed domain name has been registered in bad faith

The Panel finds that the Respondent had knowledge of the Complainant's trademarks at the time of registration of the disputed domain name, considering the following circumstances:

- WIPO Jurisprudential Overview 3.0 mentions that noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. The Panel believes that before registration of the disputed domain name, the Respondent had made searches for the wording "VITTORIA" and known it is the trademark of the Complainant.
- The Complainant claims that trademarks "VITTORIA" and "VITTORIA & device" are distinctive and well known all around the world. The Complainant carried Google search in respect of the wording "VITTORIA", which revealed much information on the Complainant and its trademarks. The Respondent had knowledge of the Complainant's trademarks.
- The disputed domain name resolved to the Respondent's website that offers bicycle tire that compete with the Complainant's own offerings, which means that the Respondent and the Complainant are in the same business sector. The Respondent had knowledge of the Complainant's trademarks.

In view of the above circumstances, the Panel holds that the Respondent had knowledge of the Complainant's trademarks at the time of registration of the disputed domain name. As the domain name would cause confusion to internet users, it should have avoided the registration, which is considered as good faith, rather it registered the disputed domain name. The Respondent deliberately sought to cause such confusion. Accordingly, the Panel finds that the disputed domain name has been registered in bad faith.

B. The disputed domain name is being used in bad faith

Paragraph 4(b) (iv) of the Policy states that the following circumstances in particular shall be evidence of registration and use of a domain name in bad faith: By using the domain name, the respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

According to the above paragraph 4(b)(iv) of the Policy, the Complainant contends that the disputed domain name is being use in bad faith. The Panel supports the Complainant's contention, based on the following factors:

- The Complainant is an Italian bicycle tire manufacturer established in 1953 and its trademarks are well-known. The disputed domain name resolved to the Respondent's website that offers bicycle tire that compete with the Complainant's own offerings;
- Complainant's trademarks "VITTORIA" and "VITTORIA & device" are on the top of the webpage. Promotional words are in the dominant portion of the homepage, e.g. "Vittoria Premium Road Bike Tires", "Elevate Your Ride with Vittoria's Premium Road Bike……";
- Samples of bicycle tires bearing the Complainant's trademark "VITTORIA & device" are shown on the webpages together with product names, e.g. "Vittoria Corsa Pro Road Bike Tire", "Vittoria Martello Mountain Bike Tire", etc.;
- The layout and colors of the Respondent's website are confusingly similar to those of the Complainant's website.

The Panel notices that the sales prices are shown on the webpages, which means that the website is for commercial gain.

The Complainant claims that internet users, while searching for information on the Complainant's products and services, are confusingly led to the websites of the Respondent and wrongly induced to buy products that are not made by the Complainant, which might consequently suffer serious economic damages. The Respondent intentionally diverts traffic away from the Complainant's website and to gain advantage from Complainant's activity, investments and reputation. The Panel agrees with the Complainant's claim.

Considering the above factors, the Panel finds that the disputed domain name is being used in bad faith, which meets the circumstance mentioned in Paragraph 4(b) (iv).

Regarding the Complainant's contention on bad faith, the Respondent should rebut it, but it did not make any response, which strengthened the Panel's findings on its bad faith.

In view of all above, the Panel finds that the disputed domain name has been registered and is being used in bad faith according to paragraph 4(a)(iii) of the Policy. Therefore, the Complainant has proven that the third element required by paragraph 4(a) of the Policy is established.

Decision

For all the foregoing reasons, in accordance with paragraph 4(a) of the Policy and Rule 15 of the Rules, the Panel orders that the disputed domain name <VITTORIAUP.COM> 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. **VITTORIAUP.COM**: Transferred

PANELLISTS

Name	**Yunze Lian**

DATE OF PANEL DECISION 2024-08-19

Publish the Decision