Decision for dispute CAC-UDRP-107259

Case number	CAC-UDRP-107259
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Domain names	cyclenalini.com, nalinicycle.com

Case administrator

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

Complainant

Organization	MOA SPORT MANTOVANI VINCENZO S.R.L.

Complainant representative

Organization	Convey srl

Respondents

Name	Shen Jiangying
Name	Fu Zaichao

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 has established that it has rights in the “NALINI” trademark based on the following trademark registrations:

- International Trademark No. 609895 "NALINI" registered on November 25, 1993, extended to the People's Republic of China, in Nice Class 25;
- International Trademark No. 1706795 "NALINI" registered on December 1, 2022, extended to the People's Republic of China, in Nice Class 25.

The Complainant is also the owner of the domain name <nalini.com> registered on April 3, 1998 that it uses in connection with its goods and services.

FACTUAL BACKGROUND

The Complainant has its offices in Italy.

Its trademark “NALINI” has its roots in the late 1960s when Vincenzo Mantovani, a former cyclist who won a silver medal at the 1964 Tokyo Olympics, began designing and producing garments for himself and fellow cyclists. Later, his brother Claudio Mantovani, a goalkeeper for the Italian National Team and AC Milan, joined the business.

The Complainant, supported by its technological laboratory MOA SPORT, produces cycling garments with advanced technologies and materials. The company has been among the first producers to introduce innovative technologies in cycling clothing, particularly in the development of pads.

The “NALINI” trademark has been used in collaboration with professional cycling teams and champions, including Nibali and others, for almost 50 years. The brand has been worn by professional cyclists in numerous famous races.

To promote its brand, the Complainant extensively uses the “NALINI” denominations across internet environments, including its official website at www.nalini.com and on major social networks such as Facebook, Instagram, and YouTube.

The disputed domain names were created by the respective Respondents on the following dates:

No	Disputed Domain Name	Registration Date	Registrar
1	nalinicycle.com	June 7, 2023	Gname.com Pte Ltd
2	cyclenalini.com	December 23, 2024	Gname.com Pte Ltd

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.

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that each of the disputed domain names 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).

The Panel accepts that the Complainant has rights by reason of its ownership of the registered trademark “NALINI” which predates the registration of the disputed domain names by several decades. The question is whether each of the disputed domain names is identical or confusingly similar to the Complainant’s trademark.

Whether a disputed domain name is identical or confusingly similar to a trademark can be determined by making a side-by-side comparison with the disputed domain name. A disputed domain name is identical to the trademark when it is a character for character match. It is confusingly similar when it varies the trademark by, for example, adding generic terms to the dominant part of the trademark.

The Complainant contends that the disputed domain names are identical or confusingly similar to its registered trademark "NALINI". Each of the disputed domain names incorporates the entirety of the "NALINI" trademark, which the Panel accepts is internationally recognised and well-established in the sector in which the Complainant operates.

The Panel considers the fact that the disputed domain names include non-distinctive elements such as “cycle” does not affect the confusing similarity.

In the present case, a side-by-side comparison shows that the dominant element in each of the disputed domain names is the Complainant's "NALINI" trademark. This is likely to create the impression that they are controlled by the Complainant.

The Panel accepts the contention that the addition of the descriptive term "cycle" (either before or after the trademark) does not prevent a finding of confusing similarity. The term "cycle" is directly related to the Complainant's business in the cycling apparel sector, which may even heighten the risk of confusion by suggesting a connection to the Complainant's cycling apparel business.

The generic Top-Level Domain suffix ".com" is typically disregarded in the confusing similarity assessment as it is a technical requirement of domain name registration.

Accordingly, the Panel considers that the each of the disputed domain names is confusingly similar to the Complainant's "NALINI" trademark and this ground is made out.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown that each of the Respondents has no right or legitimate interest in respect of each of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests.

It is well-established in UDRP jurisprudence that proving a negative fact can be unduly onerous for a complainant. As noted in Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270, it is sufficient for the complainant to produce prima facie evidence in order to shift the burden of proof to the respondent.

Once such a prima facie case is made, the respondent carries the burden of demonstrating 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 Croatia Airlines d.d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455.

The Complainant has adduced evidence that it holds exclusive trademark rights to "NALINI" predating the registration of the disputed domain names.

The Panel notes that the following circumstances indicate the absence of the Respondents' rights or legitimate interests in the disputed domain names:

1. There is no evidence that each of the Respondent is a licensee or an authorised agent of the Complainant or in any other way authorised to use the Complainant's "NALINI" trademark. The Panel accepts the uncontradicted assertion that each of the Respondents is not an authorised reseller and has not been granted permission to register and use the respective disputed domain names.

2. There is no evidence that each of the Respondents is commonly known by the disputed domain names as an individual, business, or other organisation. The Respondents' name does not correspond to "NALINI" or any part of the disputed domain names.

3. Each of the Respondent has not provided any evidence of use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before notice of the dispute.
4. The evidence shows that the disputed domain names are being used for websites that display the Complainant's "NALINI" trademark and offer what appear to be counterfeit products for sale at significantly reduced prices. The evidence shows, for example, that a jacket is sold at $83.50 USD on one of the Respondent's websites compared to €128 EUR (approximately $133.23 USD) on the Complainant's official website.

5. The websites corresponding to the disputed domain names contain no disclaimer regarding each of the Respondent's lack of relationship with the Complainant.

6. The Respondents failed to respond to the cease and desist letters sent by the Complainant's representative on December 10, 2024.

The Panel accepts that the mere registration of a domain name does not establish rights or legitimate interests. See Pharmacia & Upjohn Company v. Moreonline, WIPO Case No. D2000-0134 and National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., WIPO Case No. D2000-0118.

The Panel, however, endorses the views stated by the Panel in Diadora S.p.A. v. Whoisprotection.cc (2022) CAC 104793 as also applicable in this proceeding:

> "the choice of a domain name which incorporates a complainant's trademark wholly (as in this case) or virtually wholly, and is unaccompanied or unsupported by any credible explanation as to the reason for this coincidence, could further evidence a lack of rights or legitimate interests."

The Panel also considers the sale of what is alleged to be counterfeit products cannot constitute a legitimate non-commercial or fair use without intent for commercial gain. This principle is supported by numerous Panel decisions, including Guccio Gucci S.p.A. v. Zhang Jiawen et al., WIPO Case No. D2015-2088, where the panel stated that "the websites at the Disputed Domain Names offer for sale prima facie counterfeit GUCCI products, along with products of the Complainant's competitors, which does not support a finding of rights or legitimate interests."

In the absence of any response from the Respondents to rebut this prima facie case, the Panel finds that the Complainant has satisfied the second element of the Policy, and accordingly this ground is made out.

BAD FAITH

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

Under this element, the Complainant must establish that the disputed domain names were both registered and are being used in bad faith.

The Panel finds that each of the Respondents registered and is using the disputed domain names in bad faith for the following reasons:

1. The Complainant's “NALINI” trademark registrations significantly predate the registration of both disputed domain names. International Trademark No. 609895 for "NALINI" was registered on November 25, 1993, while the disputed domain names were registered in 2023 (<nalinicycle.com>) and 2024 (<cyclenalini.com>), decades after the Complainant established its trademark rights.

2. Given the worldwide recognition of the Complainant's “NALINI” trademark in the cycling apparel sector and its extensive distribution network, it is implausible that each of the Respondents was unaware of the Complainant's trademark rights when registering the disputed domain names. The Complainant's evidence demonstrates that the “NALINI” trademark has been associated with professional cycling for almost 50 years and has collaborated with numerous professional cycling teams and champions.

3. Each of the Respondents’ actual knowledge of the “NALINI” trademark at the time of registration is demonstrated by the fact that the websites at the disputed domain names prominently display the “NALINI” trademark and offer what is alleged by the Complainant to be counterfeit “NALINI” products at significantly reduced prices. As stated in Belstaff S.R.L. v. jiangzheng ying, WIPO Case No. D2012-0793, "the Panel also notes the goods offered on the Websites are of low prices compared to the genuine goods of the complainant. In all the circumstances, the Panel is satisfied that each of the Respondents appears to be using the disputed domain names to facilitate the sale of counterfeit products."

4. The evidence adduced point to the strong inference that each of the Respondents is using the disputed domain names to intentionally attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the websites and the products offered for sale thereon. This constitutes bad faith registration and use under the Policy.
5. The websites at the disputed domain names contain no disclaimers informing users of the lack of relationship with the Complainant, thereby increasing the likelihood of confusion.

6. Each of the Respondents failed to respond to the cease and desist letters sent by the Complainant on December 10, 2024. The Panel considers that a failure to respond to a cease and desist letter can be evidence of bad faith. See HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062.

7. There is evidence suggesting that each of the Respondents provided false contact information when registering the disputed domain names, as indicated by the Google Maps searches of the addresses provided by the Respondents.
8. The registration of the disputed domain names incorporates the "NALINI" trademark with minor variations (placement of the generic term "cycle" before or after demonstrates a pattern of conduct intended to prevent the Complainant from reflecting its trademark in corresponding domain names.

9. The fact that the same visual layout, pricing strategy, and product offerings appear on both websites associated with the disputed domain names further supports a finding of bad faith registration and use as part of a coordinated attempt to trade on the Complainant's reputation.

As stated in Swarovski Aktiengesellschaft v. Jun Qiao, WIPO Case No. D2013-1617, "the fact that purported [trademark owner's] goods were offered at the relevant website indicates that the Respondent was fully aware of the [trademark's] distinct reputation and association with the Complainant. There is no reason to choose such a distinctive mark, and also to include other terms in a

domain name that are suggestive of the very business of the Complainant, other than a bad faith attempt to ride on the coattails of the trademark owner."

Given the evidence adduced and the Complainant's contentions, the Panel finds that the disputed domain names were registered and are being used in bad faith. This ground is made out.

PROCEDURAL FACTORS

Consolidation of the disputed domain names in a single dispute

The Complainant requests consolidation of the disputed domain names into a single proceeding.

Rule 10(e) empowers the Panel to decide such a request in accordance with the Policy and the Rules.

"Respondent" is defined in Rule 1 to mean "the holder of a domain-name registration against which a compliant is initiated". Rule 3(c) provides that "the complaint may relate to more than one domain, provide that the domain names are registered by the same domain-name holder".

If the registrants are in fact separate legal or beneficial entities the Policy requires a complainant to initiate separate proceedings against each registrant of the disputed domain names.

The "domain-name holder", if its identity is disclosed, is usually the beneficial owner. If its identity is not disclosed, it is then a proxy holder. Even if the identity of the beneficial owner is determined, it is only prima facie identification of the putative registrant of the domain name and is not conclusive of the real identity of the beneficial owner as aliases could be used as the alter egos of the controlling entity.

A complainant bears the onus of proof. It is, therefore, important for a complainant to adduce evidence that establishes a common ownership or control that is being exercised over the disputed domain names or the websites to which the disputed domain names resolve. See Speedo Holdings BV v Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons, WIPO Case No. D2010-0281; General Electric Company v Marketing Total S.A. WIPO Case No. D2007-1834.

The phrase "same domain-name holder" under Rule 3(c) has been construed broadly to include registrants who are not the same person, but circumstances point to the domain names being controlled by a single person or entity. See WIPO Jurisprudential Overview 3.0, Paragraph 4.11.2; Dr Ing. H.c.F. Porsche AG v Kentech Inc aka Helois Lab aka Orion Web aka Titan Net aka Panda Ventures aka Spiral Matrix and Domain Purchase, NOLDC, Inc., WIPO D2005-0890; Kimberly Clark Corporation v N/A, Po Ser and N/A, Hu Lim, WIPO D2009-1345.

Thus, the domain-name holder can either be the registrant or a person with "practical control" of the domain name.

Typically, the evidence would show that there are some matching details including entities, addresses, telephone numbers, and/or e-mail accounts.

In this case, the Complainant has presented evidence indicating that despite the different named registrants, the disputed domain names are subject to common control. Although there are no matching details, the evidence demonstrates that:

1. Both disputed domain names are registered with the same registrar, Gname.com Pte. Ltd.
2. Both registrants list their location as China.
3. Both disputed domain names use the same Top-Level Domain (.com).
4. Both disputed domain names incorporate the Complainant's "NALINI" trademark with the generic term "cycle".
5. The websites associated with both domain names display the same look and feel with identical layouts and functionalities.
6. Both websites are being used to sell what is alleged or appear to be counterfeit "NALINI" products at significantly reduced prices.
7. The Complainant has provided Google Maps evidence suggesting that the physical addresses provided by both registrants may be false.

Previous panels have accepted that consolidation may be appropriate where there is evidence that the disputed domain names or corresponding websites are subject to common control, and where consolidation would be procedurally efficient and fair to all parties.

Based on the substantial commonalities between the disputed domain names and their usage, the Panel finds sufficient prima facie evidence that the disputed domain names are subject to common control, despite being registered under different names.

The Panel finds that by the preponderance of the evidence adduced in support of consolidation and determines that consolidation into a single complaint is appropriate in this case.

Language of the proceedings

According to the information provided by the Registrar, the language of the Registration Agreement for both disputed domain names is Chinese.

Pursuant to Paragraph 11(a) of the Rules, unless otherwise agreed by the parties, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise.

The Complainant has requested that English be the language of the proceeding for the following reasons:

1. The disputed domain names contain Latin characters, including the English word "cycle".
2. The websites corresponding to the disputed domain names are in English.
3. The Respondents, operating in the cycling apparel sector, would be familiar with English as the primary language for international relations and business.
4. Translation of the Complaint into Chinese would cause additional expense and delay, contrary to the UDRP's aim of providing time and cost-effective resolution.

Previous panel have found that certain circumstances may warrant a language different from that of the Registration Agreement, particularly when the evidence suggests the respondent has sufficient understanding of the requested language.

In this case, the Panel finds that the Respondents have demonstrated familiarity with the English language through:

- The registration of domain names containing English words.
- The operation of websites with content entirely in English.
- The targeting of international customers through these English-language websites.

Additionally, requiring the Complainant to translate all submissions into Chinese would impose a substantial burden and delay, undermining the efficiency goals of the UDRP process.

For these reasons, the Panel determines that English shall be the language of this administrative proceeding.

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondents, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC’s responsibility to achieve actual notice to the Respondents.

On February 20, 2025 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

That e-mail notification, written notice, written notice to another correspondence address, contact forms on the disputed site <nalinicycle.com> were sent. Neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court.

CAC received notifications that the e-mails sent (in both English and Chinese) to postmaster@nalinicycle.com and to postmaster@cyclenalini.com were returned back as undelivered. The e-mail notice sent to fuzaichao@yerymailvip.com was delayed. The e-mail notice was also sent to shenjiangying@servicesshmail.com, but CAC did not receive any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed sites.

The Respondents never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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

The Panel determines that:

(a) The disputed domain names both incorporate the Complainant's “NALINI” trademark in its entirety. The addition of the descriptive term "cycle" (either before or after the trademark) does not prevent a finding of confusing similarity, particularly as it relates directly to the Complainant's business in the cycling apparel sector.

(b) The Complainant has established a prima facie case that the Respondents lack rights or legitimate interests in the disputed domain names. Each of the Respondents is not a licensee or authorised agent of the Complainant, is not commonly known by the disputed domain names, and has not used the disputed domain names in connection with a bona fide offering of goods or services.

Instead, the disputed domain names are being used for websites that display the Complainant's “NALINI” trademark and offer what appear to be counterfeit products at significantly reduced prices.

(c) The disputed domain names were registered and are being used in bad faith. The Complainant's “NALINI” trademark registrations substantially predate the registration of the disputed domain names. The Respondents’ actual knowledge of the “NALINI” trademark is evident from the websites' content, which prominently displays the “NALINI” trademark and offers apparent counterfeit products. The Respondents are using the disputed domain names to intentionally attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the websites and the products offered thereon.

The Panel has also determined that:

1. The consolidation of the proceedings concerning the two disputed domain names is appropriate, given the evidence of common control including identical website layouts, business models, and patterns of trademark infringement.
2. English is the appropriate language for these proceedings, despite the Registration Agreements being in Chinese, due to the evidence of the Respondents’ familiarity with English (including English-language websites) and considerations of procedural efficiency.

Accordingly, the Panel finds that:

1. The disputed domain names <cyclenalini.com> and <nalinicycle.com> are confusingly similar to the Complainant's “NALINI” trademark;
2. The Respondents have no rights or legitimate interests in respect of the disputed domain names;
3. The disputed domain names have been registered and are being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **cyclenalini.com**: Transferred
2. **nalinicycle.com**: Transferred

PANELLISTS

Name	**William Lye OAM KC**

DATE OF PANEL DECISION 2025-03-10

Publish the Decision