Decision for dispute CAC-UDRP-107392

Case number	CAC-UDRP-107392
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Domain names	STEFANORICCISTORE.COM

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	STEFANO RICCI S.P.A.

Complainant representative

Organization	Convey srl

Respondent

Name	Ruggero Bianchini

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 of numerous registrations for the trademark "STEFANO RICCI", including the international trademark No 1402542, registered on September 7, 2017, for goods and services in classes 25, 26, 28 and 35.

The disputed domain name was registered by the Respondent on February 6, 2025.

FACTUAL BACKGROUND

The Complainant states that it is an Italian international luxury fashion and lifestyle company established in 1972 in Florence.

The Complainant submits that it employs over five hundred people worldwide.

The Complainant provides evidence of use of the disputed domain name, together with the Complainant's trademark and logo, in a phishing email.

The Complainant provides a copy of a cease-and-desist letter sent to the Respondent through the registrar's domain contact form, for notifying him of the infringement of the Complainant’s trademark, and requesting the immediate cease of any use of it.

The Complainant clarifies that the Respondent has not replied to the cease-and-desist letter.

The Complainant considers that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, because it incorporates the Complainant's trademark, and the fact that it includes the generic top-level domain ".com" does not affect the confusing similarity.
The Complainant states that the Respondent is not a licensee nor an authorized agent of the Complainant nor in any other way authorized him to use Complainant's trademarks. The Respondent adds that the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name.
The Complainant argues that the Respondent is not commonly known by the disputed domain name.
The Complainant points out that the Respondent has not provided the Complainant with any evidence of use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute.

For the above reasons, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.
The Complainant considers that the Respondent could not have ignored the existence of the Complainant's trademark, taking into account the Complainant's worldwide reputation in the sector of luxury fashion.
The Complainant argues that the Respondent is taking advantage of the Complainant's renown for its economic advantage by sending phishing e-mails.
The Complainant observes that the lack of reply to the cease-and-desist letter is an additional evidence of bad faith.

The Complainant considers that the described circumstances demonstrate that the Respondent has registered and has been using the disputed domain name in bad faith.

PARTIES CONTENTIONS

The Complainant, relying on the arguments summarised above, contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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

Language of the Proceedings

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

The language of the Registration Agreement is Italian, therefore the language of the proceedings should be Italian, unless otherwise agreed by the parties. The Complaint, however, was filed in English. The Complainant submitted a request to change the language of the proceedings into English based on the following reasons:

1) the Respondent understands English in light of the following circumstances:

a) the disputed domain name contains Latin characters, including the English word “store” as well as the English word “.com” (which is the abbreviation for the English term “commercial” as the generic top-level domain);

b) in the light of the worldwide renown of the Complainant's brand "STEFANO RICCI", the Respondent could not ignore English, that is the main language for international relations and business;

2) the translation of the Complaint into Italian would also cause additional expense and delay, making unfair to proceed in Italian.

3) it would be disproportionate to require the Complainant not to submit the Complaint in English and incur costs of translation and it would be contrary to the aim of the UDRP of providing time and cost effective means of resolving domain name disputes.

The Panel observes that it is well-established that, in deciding whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, the factors that should be taken into consideration include whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the parties (see, for example, WIPO Case No. D2008-0400).

The Panel, in line with other panels' views in similar cases (see, for example, WIPO Case No. D2021-1402), considers that the fact that the Respondent has included an English word in the disputed domain name is evidence of the Respondent's knowledge of the English language.

Furthermore, the Panel finds that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Italian. In line with other panels' views on this issue (see, for example, WIPO Case No. D2015-0070), the Panel considers that the language requirement should not cause any undue burden on the parties or undue delay.

Moreover, the Panel notes that the Respondent had the opportunity to oppose the Complainant’s request, but did not submit any response. In line with the approach taken by other Panels in similar cases (see, for example, WIPO Case No. D2023-0242), the Panel considers this as an additional argument in favor of accepting English as the language of the proceedings.

For these reasons, having carefully considered the Complainant's submission regarding the language of the proceedings and the overall circumstances of this case, the Panel accepts the Complaint in English and shall render its decision in English.

The Panel is satisfied that all procedural requirements under the Policy have been met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

(i) The disputed domain name is identical or confusingly similar to a trademark 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 name; and

(iii) The disputed domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership, among others, of the registered trademark “STEFANO RICCI”, identified in section “Identification of rights” above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant’s trademark.

The disputed domain name differs from the Complainant’s trademark “STEFANO RICCI” only by the addition of the word "store", and by the presence of the top-level domain ".COM".

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case, the addition of the word "store" has no impact on the distinctive part “STEFANO RICCI”. It is well established that

where the relevant trademark is recognizable within the domain name, the addition of other terms would not prevent a finding of confusing similarity.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark “STEFANO RICCI”.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the respondent has rights or legitimate interests in a domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the Respondent is not a licensee nor an authorized agent of the Complainant nor in any other way authorized to use Complainant’s trademarks,

- the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name,
- the Respondent is not commonly known by the disputed domain name as individual, business or other organization and his family name does not correspond to STEFANO RICCI or the disputed domain name,
- the Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain name resolves to a parking page.

The Panel considers that, on the balance of probability, the Respondent knew the Complainant's trademark and registered the disputed domain name with knowledge of the Complainant's rights. Indeed, it is not conceivable that the Respondent did not have the Complainant's trademark in mind, when registering and using the disputed domain name. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain name.

Taking into account that the Complainant's trademark registrations long predate the registration of the disputed domain name, that the Complainant has not authorized the Respondent to register the disputed domain name or to use the Complainant's trademark in any form, that the Respondent is not commonly known by the disputed domain name, that the disputed domain name resolves to a parking page, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.
Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:
(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or
(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or
(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site 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] web site or location or of a product or service on [the Respondent's] web site or location.
The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behaviour detrimental to the complainant’s trademark would also satisfy the complainant’s burden.

Taking into account the distinctiveness and reputation of the trademark "STEFANO RICCI", which long predates the disputed domain name, it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark "STEFANO RICCI" when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see WIPO Case No. D2017-0100). The Panel shares this view.

In line with the view of other Panels in similar cases (see, for example, WIPO Case No. D2024-4665), the Panel considers that the use of the disputed domain name for phishing purposes is evidence of bad faith.

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain name it would have filed a response in this proceeding and to the cease-and-desist letter.

The Panel, having taken into account the Respondent's knowledge of the Complainant's trademarks at the time of the disputed domain name's registration, the fact that the disputed domain name resolves to a parking page, the fact that the disputed domain name has been used for phishing purposes and the lack of reply to the complaint and to the cease-and-desist letter, considers that the disputed domain name was registered and is being used in bad faith.
Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **STEFANORICCISTORE.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2025-04-05

Publish the Decision