Decision for dispute CAC-UDRP-107327

Case number	CAC-UDRP-107327
Time of filing	2025-03-03 09:46:39
Domain names	BERETTA-92.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

Name	PALKINA YEVANHELINA

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 registered owner of numerous trademarks and other intellectual property rights and has registered its trademark BERETTA, in many classes of goods and services and in numerous countries, such as, inter alia, to the following:

- International registration No 147879 of 7 July 1950, duly renewed, in classes 8 and 13;
- International registration No 746766 of 8 November 2010, in class 9;
- International registration No 558880 of 27 July 1990, duly renewed, in classes 8 and 13 and valid also for Ukraine;
- European Union registration No 9743543 of 17 February, 2011 in classes 08, 09, 13, 14, 18, 25 and 34;
- European Union registration No 3801537 of 19 August, 2005 in class 28, duly renewed.

Moreover, the Complainant is also the owner of several top-level and country code top-level domain names, constituted by the verbal element <BERETTA>, among which are <beretta.com>, <beretta.it>, <berettadefense.com>, <berettaholding.com>.

The Complainant's principal website, where its products and point of sales are advertised, is https://www.beretta.com.

FACTUAL BACKGROUND

The Complainant was founded in 1526 by Mastro Bartolomeo Beretta, Fabbrica d'Armi Pietro Beretta and is a privately held Italian firearms manufacturing company operating in several countries. It is the oldest active manufacturer of firearm components in the world.

The Beretta forge was in operation from about 1500, although the first documented transaction is a contract dated 3 October, 1526. By the end of the 17th century, Beretta had become the second largest gun barrel maker and Beretta has supplied weapons for every major European war since 1650. The Complainant is still family owned.

In the 1980s, Beretta enjoyed a renewal of popularity in North America after its Beretta 92 pistol was selected as the service handgun for the United States Army under the designation of "M9 pistol". In the 1970s, Beretta also started a manufacturing plant in São Paulo, Brazil, as a contract between Beretta and the Brazilian government was signed for the production of Beretta 92s for the Brazilian Army until 1980.

The parent company, Beretta Holding, also owns Beretta USA, and acquired several domestic competitors (such as Benelli and Franchi) and some foreign companies, e.g. SAKO, Stoeger, Tikka, Uberti, and the Burris Optics company.

Nowadays Beretta firearms are used worldwide for a variety of civilian, law enforcement and military purposes: Beretta is known for the innovative technology of its products; sporting arms account for three-quarters of sales; however, it is also renown for other products such as the marketing shooting clothes and accessories.

Beretta Holding closed the 2021 with 958 million of Euro of revenue (of which 250 million of Euro has been generated by Fabbrica d'Armi Pietro Beretta, https://www.beretta.com/it-it/azienda/fabbrica-d-armi-pietro-beretta/azienda) and more than 3380 employees (https://www.berettaholding.com/en/financial-highlights), based not only in Europe but also in Australia, New Zealand, Russia, Turkey, USA and China (https://www.berettaholding.com/en/global-presence).

The Respondent, based in Ukraine, registered the disputed domain name <beretta-92.com> on 11 September 2024.

Its registration was not authorized by Complainant and it is redirected to a web site dedicated to betting services and game apps.

PARTIES CONTENTIONS

The Complainant 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

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

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According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(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.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Complainant has established rights in the name BERETTA. The disputed domain name <BERETTA-92.COM> is found to be confusingly similar to the Complainant's trademark and company name. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:
a) disregarding the top-level suffix in the domain names (i.e. ".com") in the comparison; and

1. b) finding that the simple combination of a trademark (i.e. BERETTA) and the model number of a product actually manufactured by the Complainant (i.e. 92) separated by a hyphen, would by no means be considered sufficient to distinguish a domain name from a trademark.

The disputed domain name is therefore found to be confusingly similar to the earlier rights in the name BERETTA and the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, 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.

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant and the Respondent have never had any previous relationship, nor has the Complainant ever granted the Respondent with any rights to use the BERETTA trademark in any form, including in the disputed domain name. There is no evidence before the Panel indicating that the Respondent is commonly known by the disputed domain name. The disputed domain name resolves to a pay per click site, advertising betting services and game apps. Therefore, the disputed domain name is capitalizing on the reputation and goodwill of the Complainant's mark to misdirect Internet traffic to this website. There is no available evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name, so that there is nothing that could be interpreted as rights or legitimate interests of the Respondent. Since the Respondent has not filed a response, the Respondent has also failed to put forward any arguments at all which could change this finding.

The Respondent was given an opportunity to present arguments relating to rights or legitimate interests in the disputed domain name but has failed to do so. This behavior, coupled with the absence of use of the disputed domain name in connection with a bona fide offering of goods and services, demonstrates the Respondent´s absence of rights or legitimate interests in respect of the disputed domain name.

The Panel therefore concludes that the Respondent did not refute the Complainant's prima facie case and has not established any rights or legitimate interest in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith.

The name BERETTA is distinctive and well known in numerous countries around the world for the products manufactured and sold by the Complainant.

The Respondent has copied the Complainant's trademark "BERETTA" and has combined it with a model number "92" of a product actually manufactured by the Complainant. Therefore, this registration can only be viewed as an attempt to exploit the goodwill vested in the trademark by attracting Internet users and confusing them to the extent that they would believe that a website connected to the disputed domain name offers the services of an entity that is affiliated to the Complainant.

No other reason for registering a combination of the trademark of the Complainant together with generic terms as a domain name appears feasible. Even the most basic Google search in respect of the letter combination BERETTA would have yielded obvious references to the Complainant.

Consequently, there appears to the Panel to be no possible good faith reason for the Respondent to have selected the disputed domain name, and there are demonstrable indications of bad faith present in this case.

The Panel therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BERETTA-92.COM**: Transferred

PANELLISTS

Name	**Udo Pfleghar B.A. (Melb.)**

DATE OF PANEL DECISION 2025-04-11

Publish the Decision