# Decision for dispute CAC-UDRP-107326

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| Case number | CAC-UDRP-107326 |
| Time of filing | 2025-03-17 17:21:56 |
| Domain names | beretta-store.shop, beretta-discount.shop |

## Case administrator

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

## Complainant

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| Organization | Fabbrica d'Armi Pietro Beretta S.p.A. |

## Complainant representative

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| Organization | Barzanò & Zanardo Milano S.p.A. |

## Respondent

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| Name | yan gensuo |

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings relating to the disputed domain names.

IDENTIFICATION OF RIGHTS

Complainant owns the following trademark registrations:

International registration No 147879 of July 7, 1950, duly renewed;

International registration No 746766 of November 8, 2000;

European Union registration No 9743543 of June 28, 2011; and

European Union registration No 3801537 of August 28, 2005.

FACTUAL BACKGROUND

Founded in 1526 by Mastro Bartolomeo Beretta, Fabbrica d'Armi Pietro Beretta is a privately held Italian firearms manufacturing company operating in several countries and 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 October 3, 1526 for 185 arquebus barrels, for which the Republic of Venice was to pay 296 ducats to Maestro di Canne (master gun-barrel maker):

Bartolomeo Beretta (in Italian): by all accounts Beretta-made barrels equipped the Venetian fleet at the Battle of Lepanto in 1571. The original account document for the order of those barrels is now stored in the Archivio di Stato di Venezia (in Italian) in Venice.

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.

Nonetheless Beretta has been owned by the same family for almost five hundred years and is a founding member of "Les Henokiens", an association of bicentenary companies that are family owned and operated. It is still hold by Beretta family.

In 1918, the Beretta Model 1918, one of the first submachine guns in the world, was fielded by the Italian army: Beretta manufactured rifles and pistols for the Italian military until the 1943 Armistice between Italy and the Allied forces during World War II; with the Wehrmacht's control of northern Italy, the Germans seized Beretta and continued producing arms until the 1945 German surrender in Italy.

After the war, Beretta continued to develop firearms for the Italian Army and police, as well as the civilian market.

The success of Beretta is not at all limited to European market: 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, and more than 3380 employees, based not only in Europe but also in Australia, New Zealand, Russia, Turkey, USA and China.

Moreover, Fabbrica d'Armi Pietro Beretta is owner of several top-level and country code top-level domain names, constituted by the verbal element <BERETTA>, among which we cite <beretta.com>, <beretta.it>, <berettadefense.com>, <berettaholding.com>.

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

The Complainant is also widely promoted on most popular social media with channels and pages specifically dedicated to it, i.e. on Facebook, Instagram, Twitter and YouTube used also for promotional and advertising purposes.

In light of its extended use and high reputation, the trademark BERETTA is certainly well-known all around the world, conveying a prestigious image, respectful of the tradition and of undisputed quality.

Respondent registered <beretta-store.shop> on February 26, 2025 and <beretta-discount.shop> on March 19, 2025.

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PARTIES CONTENTIONS

COMPLAINANT:

1. IDENTITY OR CONFUSING SIMILARITY

Under the first UDRP element, the straightforward side-by-side comparison of the disputed domain names and the textual components of the marks on which this Complaint is based makes it evident that the Complainant's Trademarks are recognizable within the disputed domain names, since they both incorporates the entirety of the trademarks. Therefore, both domain names are confusingly similar to the marks in which the Complainant has rights.

In particular, comparing the disputed domain name <beretta-store.shop> to the Complainant's trademarks and the domain name <beretta.com> the only difference is the addition of the generic term "store" (divided from BERETTA with only the sign "-"), while <beretta-discount.shop> differs from the Complainant's trademarks and domain name only for the addition of the generic term "discount" and the sign "-".

Such additions neither effects the attractive power of the Complainant's trademark, nor is sufficient to prevent the finding of confusing similarity between the disputed domain names and such mark, but even enhances the likelihood of confusion as the domain names could easily mislead the public in considering them official BERETTA online shop.

2. RESPONDENT'S LACK OF RIGHTS AND LEGITIMATE INTERESTS

The Complainant contend that the Respondent lacks rights or legitimate interests in the disputed domain names for the following reasons:

- The Complainant (or the other related parties) has no relationship with the Respondent whatsoever;

- The Respondent has never received any approval of the Complainant (or the other related parties), expressed or implied, to use its (their) trademarks or any other mark identical or confusingly similar to such marks, nor to register any domain name identical or confusingly similar to such marks;

- There is no evidence that the Respondent has acquired any rights in a trademark or trade name corresponding to the disputed domain names;

- Both disputed domain names are used to publishing the Complainant's trademarks and official images without any authorization.

Panels have indeed found that circumstantial evidences can support a complainant's claim of illegal respondent activity and that – in particular – "evidences that the goods are offered disproportionately below market value (…), that the respondent has misappropriated copyrighted images from the complainant's website,(…) that the goods have prompted consumer complaints, or that a respondent has improperly masked its identity to avoid being contactable, have each been found relevant in this regard".

Such use of the domain names is therefore clearly not a bona fide, legitimate or fair use under the UDRP Policy.

3. REGISTRATION AND USE IN BAD FAITH

As far as registration in bad faith is concerned, the Respondent registered domain names contain a well-known third party's trademark without authorization. The Respondent could not ignore the existence of the Complainant's trademark at the time of the registration of the disputed domain names, because "BERETTA" is a well-known trademark, and because "BERETTA" is a fanciful word, therefore it is not conceivable a use of the domain name not related to the Complainant's activities. This assumption is further proved by the fact that the disputed domain names entirely contain Complainant's trademark and that it is used to publish the Complainant's trademarks and products.

Concerning the use in bad faith, as described above both domain names are used to publishing – without any authorization from the Complainant – BERETTA trademarks, official promotional images and products; moreover, those products are offered for sale at a very discounted prices: complaint is therefore certain that those could not be legitimate offers. This assumption is also proven by the lack of any clear information on the real seller and on the administrator of the website, as described in factual part.

Moreover, such finding is supported by the fact that disputed domain names has been found involved in fraudulent activities that have prompted consumer complaints. Evidence is provided of a clear-cut proof of the scamming use of the disputed domain names. Carrying out unlawful and illicit activities through the disputed domain name is to be considered evidence of the registration and use of the disputed domain name in bad faith.

In light of the above, Complainant respectfully submits that the disputed domain names were registered and is being used in bad faith in full satisfaction of paragraph 4(a)(iii) of the Policy.

The Complainant requests that the disputed domain names <beretta-store.shop> and <beretta-discount.shop> be transferred to the Complainant.

RESPONDENT

No administratively compliant Response was filed.

RIGHTS

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

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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 Policy).

BAD FAITH

To the satisfaction of the Panel, the Complainant has shown the disputed domain names have been registered and are 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 have been met, and there is no other reason why it would be unsuitable for providing the Decision.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or Confusingly Similar

First, the Panel is satisfied that the Complainant has shown it owns rights in the "BERETTA" trademarks, with registration and evidence, provided dating the trademark registration back to August 1950.

Turning to analyze whether there is a confusing similarity between the disputed domain names and the trademarks, the Panel notes, based on the record at hand, that the disputed domain names reproduce the trademarks in its totality. In particular, the first disputed domain name, <beretta-store.shop> adds a hyphen to the trademark and the term “shop”, while the second disputed domain name, <beretta-discount.shop> adds a hyphen to the trademark and the term “discount”.

The addition of the terms "store" and “discount” is insufficient and immaterial in assessing confusing similarity under the Policy as the entire trademark is reproduced in its entirety in the disputed domain names.

Consequently, the Panel determines that the Complaint has satisfied the Policy's first element set under paragraph 4(a)(i).

2. Rights or Legitimate Interests

Based on the evidence on record and acknowledging that the Respondent failed to produce any allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name, the Panel must turn to the uncontested facts.

The uncontested facts indicate that a) the Respondent is not affiliated with the Complainant; b) the Respondent has no license or authorization to use the trademarks; c) the Respondent is not authorized to carry out any activity for the Complainant or register the disputed domain names; d) Both disputed domain names are used to publishing Complainant’s trademarks and official images without any authorization and d) the Respondent is not commonly known by the disputed domain name.

In the Panel's view, these assertions and the evidence attached are enough to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name (see 2.1 of WIPO 3.0 Overview).

The above fact pattern, on the balance of probabilities, and in conjunction with the use of the terms used in the disputed domain names, namely, "store" and “discount”, indicates, if nothing else, a likely intention to confuse Internet users with a likely implied association with the Complainant by appearing to be a formal channel of the Complainant.

The evidence on record leads the Panel to conclude that the Respondent did not have rights or legitimate interests in the disputed domain names.

Consequently, the Panel determines that the Respondent has no rights or legitimate interests in the disputed domain names. Subsequently, the Complainant has fulfilled the second requirement set under paragraph 4(a)(ii) of the Policy.

3. Registered and Used in Bad Faith

Per the record and evidence at hand, the Panel finds that the Respondent was likely aware of the Complainant and had the Complainant's trademarks in mind when registering the disputed domain names. This is further reinforced by the complete reproduction of the trademark in the disputed domain names, with the addition of the terms “store” and “discount”. This fanciful trademark would have been easily checked online before registering the disputed domain name. This, on the balance of probability indicates that the Respondent wanted to benefit from the association of the trademark registering the disputed domain names.

In addition, the disputed domain names reproduce the Complainant’s trademarks in the both websites associated to the disputed domain names, without authorization from the Complainant. This has led to questions by consumers, which appear to be confused about the association of the Complainant to the disputed domain names.

All of the above leaves the Panel no other option than to conclude that the most likely intention of the Respondent was to intentionally attempt to attract, for commercial gain, Internet users to its website/disputed domain name by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or disputed domain name, as per illustrated under paragraph 3.1 of WIPO 3.0 Overview.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain names were registered and are used in bad faith according to paragraph 4(a)(iii) of the Policy.

4. Decision

For the preceding reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain names to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **beretta-store.shop**: Transferred
2. **beretta-discount.shop**: Transferred

## PANELLISTS

| Name | **Rodolfo Rivas Rea** |
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DATE OF PANEL DECISION 2025-04-16

Publish the Decision