Decision for dispute CAC-UDRP-107329

Case number	CAC-UDRP-107329
Time of filing	2025-03-06 09:55:34
Domain names	Berettafirearmshop.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

Organization	Guide Mail

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

Complainant provides evidence of many trademark registrations for the BERETTA mark worldwide, broadly covering firearms and/or firearm retail outlets, including without limitation:

- US registration No 73338356 of June 14, 1983, duly renewed;
- International registration No 1666657 of December 30, 2021;
- US registration No 1622389 of November 13, 1990.

FACTUAL BACKGROUND

Complainant states that it was founded in 1526, is a privately held Italian firearms manufacturing company operating in many countries, and the oldest active manufacturer of firearm components in the world.

Respondent – purportedly a company based in San Francisco named Guide Mail – registered the disputed domain name <berettafirearmshop.com> on May 17, 2024. Complainant states that the registration was not authorized by Complainant and it is currently resolving to a web site purporting to be an online firearms store. The site displays BERETTA trademarks, allegedly copyright images and allegedly counterfeit products, or at minimum products offered at an extreme discount price which

Complainant alleges is likely only in effort to commit fraud on would-be purchasers of Complainant's products.

PARTIES CONTENTIONS

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

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). The only difference is the addition of the generic, non-distinctive and descriptive words “firearm” and “shop”, respectively descriptive of BERETTA products and a generic term related to a shop. Such addition is not sufficient to prevent a finding of confusing similarity between the disputed domain name and Complainant's mark. Indeed, such terms enhance the likelihood of confusion of the public in considering it an official BERETTA ecommerce website.

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant has, to the satisfaction of the Panel, shown 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).

Complainant states that Respondent is not a licensee, authorized agent of Complainant or in any other way authorized to use Complainant’s trademarks. Respondent, apparently named Guide Mail, is not commonly known by the disputed domain name. The disputed domain name resolves to a commercial website where, in the absence of any disclaimer of non-affiliation, Complainant’s trademarks feature prominently, along with alleged Beretta firearms. See, e.g., Moncler S.R.L. v. World Top Sale Inc / WTS, WIPO Case No. D2012-2537 (“The websites are presented as if they are official websites of the Complainant” and such use cannot constitute a bona fide offering of goods or services."). See also, e.g., the following decisions holding that in the absence of disclaimer of non-affiliation there cannot be legitimate interest: Aktiebolaget Electrolux v. Reza Aeg-Electric Bolvare Shikh Mofid, WIPO Case No. D2011-1990; Aktiebolaget Electrolux v. Maksim, SPD CHervinchuk, WIPO Case No. D2011-0403.

Moreover, Complainant provides evidence that these products generally are sold at a steeply discounted price, using copyrighted images of Complainant. Such wilful conduct to create a highly misleading website clearly demonstrates that Respondent did not intend to use the disputed domain name in connection with any legitimate purpose. Indeed, its use cannot be considered a legitimate non-commercial or fair use without intent for commercial gain, because Respondent is undoubtedly gaining from the sales from a website bearing Complainant’s trademarks.

Complainant addresses the faint possibility that Respondent may be a firearms seller or reseller, and therefore may have nominative fair use right as to Complainant's trademark. Complainant posits that no information is provided to users about the real identity of the administrator of the website. On the contrary, the indication on the website that it is administrated by “© 2021 BERETTA FIREARMS USA”, is clearly misleading information as clearly GUIDE MAIL is not BERETTA FIREARMS USA. Thus, the Respondent is impersonating the Complainant without authorization. Further, the website lacks many of the elements associated with a legitimate ecommerce site, for example there is no privacy policy, no Terms and Conditions, and the contact e-mail indicated in the contact page, sales@berettafirearmsamerica.com, does not exist as the domain name <berettafirearmsamerica.com> does not exist.

Complainant therefore has at least made a prima facie case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. The Respondent has not responded or otherwise provided any contrary evidence supporting its rights or legitimate interests in the disputed domain name. Therefore, Complainant has satisfied the second element of the Policy.

BAD FAITH

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). It is obvious that Respondent had actual knowledge of the BERETTA trademarks at the time of registration of the disputed domain name less than one year ago. It is further obvious that Respondent registered the disputed domain name with clear intention to refer to Complainant’s mark in order to capitalize on the Complainant’s reputation by diverting Internet users seeking information about Complainant to Respondent's own commercial website. Furthermore, the disputed domain name is obviously being used to generate traffic to Respondent's own website by misleading consumers that the associated website is operated or at least authorized by the Complainant. See, e.g., Kelley Blue Book Company, Inc. v. Nikolay Golovin aka Buy-movie.net, WIPO Case No. D2005-0837 (“Because the disputed domain name is almost identical to Complainant’s mark, users searching for Complainant’s website (..) may connect to Respondent’s website, and after seeing its

content, they may believe that it is Complainant's website. The resulting confusion provides a ground for a finding of bad faith use.").

Moreover, as an additional circumstance evidencing bad faith, both in registration and use, Complainant notes that Respondent has clearly engaged in a pattern of such conduct as defined, i.a., in Telstra Corporation Limited v. Ozurls, WIPO Case No. D2001-0046. In at least four other UDRP cases that it has lost, Respondent was found to have registered and used various other domain names confusingly similar to third party trademarks, all linked to firearms, and used to create similar mirror sites to presumably scam users.

Therefore, Respondent clearly has registered and used the disputed domain name in bad faith within the meaning of the Policy.

PROCEDURAL FACTORS

The Panel upon reviewing the case file issued a Procedural order requesting additional information from Complainant. Complainant followed the request of the Panel and provided required information. Respondent remained inactive.

PRINCIPAL REASONS FOR THE DECISION

Respondent clearly has no legitimate interest in the disputed domain name, and clearly has registered and used the disputed domain name in bad faith within the meaning of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **Berettafirearmshop.com**: Transferred

PANELLISTS

Name	**Mike Rodenbaugh**

DATE OF PANEL DECISION 2025-04-18

Publish the Decision