Decision for dispute CAC-UDRP-107328

Case number	CAC-UDRP-107328
Time of filing	2025-03-05 09:20:50
Domain names	usberettashop.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

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

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	GermanRalph

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 has submitted evidence, which the Panel accepts, showing that it is the registered owner of the "BERETTA" trademarks. The Complainant's certain "BERETTA" trademarks are, inter alia, the following:

- International trademark n°147879 registered on July 7, 1950;

- International trademark n°746766 registered on November 8, 2000;

- European Union trademark n°009743543 registered on June 28, 2011;

- European Union trademark n°003801537 registered on August 19, 2005.

Moreover, the Complainant is also the owner of the domain names <beretta.it> registered on March 25, 1996, <beretta.com> registered on March 18, 1997, <berettadefense.com> registered on January 18, 2021 among many others bearing "BERETTA" trademark.

FACTUAL BACKGROUND

The Complainant is a private Italian firearms manufacturing company founded in 1526 and operating in several countries. The Complainant has supplied weapons for every major European war since 1650 and the company 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. The Complainant 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 the company and continued producing arms until the 1945 German surrender in Italy. After the war, the Complainant continued to develop firearms for the Italian Army and police, as well as the civilian market. In the 1980s, the Complainant 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, the company also started a manufacturing plant in São Paulo, Brazil, as a contract between the Complainant and the Brazilian government was signed for the production of Beretta 92s for the Brazilian Army until 1980.

The Complainant's 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, sporting arms account for three-quarters of sales, however it also operates in relation to other products such as the marketing shooting clothes and accessories.

Beretta Holding closed 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 are based not only in Europe but also in Australia, New Zealand, Russia, Turkey, USA and China.

The Complainant holds several trademark registrations for "BERETTA" dating back to 1950 in various countries and various domain names incorporating "BERETTA" trademark such as <beretta.com>, <beretta.it>, <berettadefense.com>.

On October 28, 2024; the Respondent registered the disputed domain name <usberettashop.com>. The disputed domain name is currently inactive.

PARTIES CONTENTIONS

COMPLAINANT:

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Complainant contends that the disputed domain name <usberettashop.com> is confusingly similar to its well-known and distinctive trademark BERETTA, since it incorporates the entirety of the trademark. The Complainant claims that its trademark "BERETTA" is clearly recognizable within the disputed domain name <usberettashop.com> and the addition of the generic term "shop" and geographical acronym "US" do not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademark. It was argued that this addition even enhances the likelihood of confusion as it could easily mislead the public into considering it an official BERETTA shop dedicated to the United States.

Furthermore, the Complainant states that the top level ".com" is merely instrumental to the use of the Internet so the disputed domain name remains confusingly similar despite their inclusion. Hence, the first requirement is claimed to be satisfied.

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Complainant submits that the Respondent is neither a licensee nor authorized agent of the Complainant nor in any other manner authorized to sell Complainant's products or use its trademark.

The Complainant contends that the disputed domain name is used to publishing BERETTA trademarks and oficial images without any authorization and Panels have 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".

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

Therefore, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant claims that the disputed domain name is confusingly similar to the Complainant's well-known "BERETTA" trademark. The Complainant referred to the WIPO Case No. D2024-3243 where the Panel has recognized that Complainant's trademark BERETTA is well-known (the panel has, inter alia, stated that "Respondent's registration of the disputed domain name that is clearly based on the BERETTA mark does not seem coincidental given the notoriety of the BERETTA name and mark"). The

Complainant stated that, despite the disputed domain name not being actively used, the non-use of a domain name (including a parking page as in the present case) would not prevent the finding of bad faith under the doctrine of passive holding according to established UDRP practice. Given the distinctiveness of the Complainant's trademarks and reputation, it is claimed that the Respondent has registered the domain name with full knowledge of the Complainant's trademark.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name <usberettashop.com> in bad faith.

RESPONDENT:

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

1. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of the registration of “BERETTA” trademarks.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s “BERETTA” trademark and the addition

of the non-distinctive word element “SHOP” as well as the geographical term “US” are not sufficient to vanish the similarity, if not increase it, as it can easily refer to the Complainant, which is a known firearm manufacturer.

Moreover, the addition of the gTLD “.COM” is not enough to abolish the similarity.

The Panel is of the opinion that Internet users will easily fall into the false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy are provided.

2. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

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

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complainant and any use of the trademarks “BERETTA” has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known by the disputed domain name.

In the absence of a compliant response, the Panel accepts the Complainant’s allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain dame, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. BAD FAITH

The Panel concludes that the Complainant's “BERETTA” trademark is of distinctive character and is well-known. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in well-known “BERETTA” trademarks, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant’s trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the link <usberettashop.com> is currently inactive, however, as previously held by various panels many times before, the current inactive status of the disputed domain name also does not prevent the finding of bad faith.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element 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. **usberettashop.com**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2025-04-30

Publish the Decision