Decision for dispute CAC-UDRP-107431

Case number	CAC-UDRP-107431
Time of filing	2025-04-03 09:51:54
Domain names	berretta.shop, berettagunaccessories.shop, berettagearhub.shop

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.

Respondents

Name	BergeronRichard
Name	KathleenCarter

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 names.

IDENTIFICATION OF RIGHTS

The Complainant has registered trademarks with the wording "Beretta" in several countries, inter alia, the following:

- International registration No 147879 of 7 July 1950, duly renewed, in classes 8 and 13;
- International registration No 746766 of November 8, 2010, in class 9;

- European Union registration No 9743543 of February 17, 2011 in classes 08, 09, 13, 14, 18, 25 and 34.
- European Union registration No 3801537 of August 19, 2005 in class 28, duly renewed.

Moreover, Fabbrica d'Armi Pietro Beretta is the 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>.

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 3th, 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 held by Beretta family. 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 renowned for other products such as the marketing shooting clothes and accessories.

Beretta Holding closed 2021 with 958 million euros of revenue (of which 250 milion euros 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.

Complainant registered several trademarks and domain names with the wording "beretta".

The Respondent, whose contact information was originally completely redacted, registered <berretta.shop> on August 8, 2024, <berettagunaccessories.shop> on August 14, 2024 and <berettagearhub.shop> on July, 31, 2024.

The Complainant firmly believes that a single entity controls the three disputed domain names in this case and requests that the Panel exercise its discretion to allow the consolidation of all three Respondents into a single complaint. The Complainant submits that consolidation is justified based on the following factors:

The Complainant states that the Complainant did not authorize their registration; all three websites are currently redirected to websites publishing BERETTA trademarks, official images and clearly counterfeit products, as well as third parties' products.

The domain name holder is therefore in the view of Complainant using domain names with evident typo of BERETTA trademarks (<berretta.shop>) or containing entirety of the BERETTA trademarks in association with descriptive terms (<berettagunaccessories.shop> and <berettagearhub.shop>) to create mirror web sites of Beretta official website, that is used to fraud Internet Users with BERETTA products offered for sale at very discounted price as well as third parties products.

The Complainant believes that the BERETTA trademarks are recognizable within the disputed domain names and, thus, the disputed domain names are confusingly similar to the marks in which the Complainant has rights, since it incorporates the entirety of the trademark.

Comparing BERETTA trademarks and the domain name <beretta.com> with <berretta.com> the only difference is the addition of one letter: an "r"; comparing instead <berettagunaccessories.shop> and <berettagearhub.shop> -that entirely contains BERETTA trademarks - with complainant's trademarks and official website, the only difference is the addition of generic terms descriptive of BERETTA products (respectively GUN ACCESSORIES and GEAR HUB).

Such additions in the view of Complainant neither affect the attractive power of such 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 it could easily mislead the public in considering it another official BERETTA ecommerce dedicated to specific products; moreover it is a consolidated UDRP principle that an evident typo such as the addition of one letter is useful to trick Internet users.

Finally, for all three disputed domain names, as consistently found in several decisions, the top level, in this case the new gTLD ".shop", is in the view of the Complainant merely instrumental to the use of the Internet, so the disputed domain names remain confusingly similar despite their inclusion.

The Complainant contends 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.

- The disputed domain names are used to publish BERETTA trademarks and official images without authorization.

The disputed domain names <berretta.shop>, <berettagunaccessories.shop> and <berettagearhub.shop> have in the view of Complainant, been registered and are being used in bad faith.

The Complainant states that the Respondent registered the disputed domain names confusingly similar to the Complainant's well-known prior trademarks. Given the distinctiveness and reputation of BERETTA's business and trademarks worldwide, it is inconceivable in the view of the Complainant that the Respondent could have registered the disputed domain names without actual knowledge of BERETTA and its rights in such marks. Thus, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his/her website, by creating a likelihood of confusion with the Complainants and their marks.

Concerning the use in bad faith, the disputed domain names are used to publish, without any authorization from the Complainant – BERETTA trademarks and products bearing BERETTA trademarks; moreover, the Complainant states that those products are offered for sale at a very discounted price: the Complainant is therefore certain that those could not be legitimate offers. The Complainant also states that the lack of any clear information on the real seller and on the administrator of the website also proves this assumption. Finally, the website is used to publish third parties' products and products bearing BERETTA competitor's trademark.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it, the contentions of the Complainant are summarised above.

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 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 were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. Consolidation

The Panel believes that the three disputed domain names in this case are controlled by a single entity and allows the consolidation of all three Respondents into a single complaint.

Paragraph 3(c) of the Rules for Uniform Domain Name Dispute Resolution Policy provides that a "complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder."

Paragraph 10(e) of the Rules grants the Panel authority to "decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules." Similarly, paragraph 3(c) of the Rules provides that a complaint "may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder." Prior UDRP panels have treated multiple registrants controlled by a single person as one single respondent for the purposes of the Policy. See,

e.g., Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons, WIPO Case No. D2010-0281; Archipelago Holdings LLC. v. Creative Genius Domain Sales and Robert Aragon d/b/a/ Creative Genius Domain Name Sales, WIPO Case No. D2001-0729.

Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including e-mail address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>).

In the present case, although the three disputed domain names are formally registered in name of two different subjects, different elements demonstrate a common control: the three DNs are registered with the same registrar, they use the same Name Servers (ns.cloudflare.com and .ns.cloudflare.com, as per WHOIS provided) and they are used in the same way: as described in factual part, they are redirected to BERETTA mirror websites and have the same landing pages constituted by an "hold-on-button" to confirm human activities; the three domains have also other elements in common: they have WHOIS information related to US residents, written in the same way (name and surname attached), as well as an gmail email address that does not correspond to the registrant name (<berretta.shop> and <berettagunaccessories.shop> are registeted in name of BergeronRichard with the authoritative e-mail valverdedanielyan@gmail.com, while <berettagearhub.shop> is registered in name of KathleenCarter with the e-mail uhaslaurence@gmail.com).

Finally, the disputed domain names are all registered in the same gTLDs.

It is not necessary to find that the disputed domain names are registered nominally to a single entity or person. As the issue is whether the Respondents can be treated as a single domain name holder, because they are involved in a common enterprise, and whether it is procedurally fair and efficient to do so.

2. 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 <berettagunaccessories.shop> and <berettagearhub.shop> reproduce the trademarks in its totality. In particular, the first disputed domain name, <berettagunaccessories.shop> adds the descriptive term "gunaccessories" to the trademark and the term and second level domain "shop", while the second disputed domain name <berettagearhub.shop> adds the descriptive term "gearhub" and the term and second level domain ".shop".

The addition of the terms "gunaccessories" and "gearhub" is insufficient and immaterial in assessing confusing similarity under the Policy as the entire trademark is reproduced in its entirety in these disputed domain names.

The third disputed domain name is an evident typo of the BERETTA trademarks (<berretta.shop>) adding an "r" to the trademark.

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

3. 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 names, 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, "GUN ACCESSORIES and GEAR HUB.", or the use of an obvious typo domain name, 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.

4. 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 “GUN ACCESSORIES” and “GEAR HUB”. This fanciful trademark would have been easily checked online before registering the disputed domain names. This, on the balance of probability indicates that the Respondent wanted to benefit from the association of the trademark registering the disputed domain names. The disputed domain name <berretta.shop> is an obvious typo domain name, adding just a "r" to the trademark of Complainant.

In addition, the disputed domain names reproduce the Complainant’s trademarks in the 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.

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. **berretta.shop**: Transferred
2. **berettagunaccessories.shop**: Transferred
3. **berettagearhub.shop**: Transferred

PANELLISTS

Name	**Jan Schnedler**

DATE OF PANEL DECISION 2025-05-13

Publish the Decision