

ADMINISTRATIVE PANEL DECISION

MALO S.p.A. v. Nicolas Malo
Case No. D2023-5063

1. The Parties

The Complainant is MALO S.p.A., Italy, represented by Porta & Consulenti Associati S.p.A., Italy.

The Respondent is Nicolas Malo, France, represented by John Berryhill, Ph.d., Esq., United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <malo.com> (the "Domain Name") is registered with OVH (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on December 5, 2023. On December 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 6, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Name which differed from the named Respondent (UNKNOWN FOR PRIVACY / REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 11, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on December 15, 2023.

On December 11, 2023, the Center informed the parties in French and English, that the language of the registration agreement for the Domain Name is French. On December 15, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 10, 2024. Pursuant to paragraph 5(b) of the Rules, the due date for Response was extended to January 14, 2024. The Response was filed with the Center on January 12, 2024.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on January 18, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a manufacturer of high-end clothing and accessories, including cashmere knitwear. It is a successor of the Manifatture Associate Cashmere S.p.A. producing clothing and accessories under the MALO brand since 1972.

The Complainant is the owner of several MALO trademark registrations, including:

- the European Union Trademark Registration for MALO (word) No. 000108258, registered on May 11, 1998; and
- the European Union Trademark Registration for MALO (figurative) No. 001193143, registered on June 11, 2003.

The Complainant is also the owner of the domain name <malo.it> incorporating the MALO trademark.

The Respondent is an expert in the field of digital analytics, book author, professor at the University of Lille, and the founder of a digital analytics consulting company.

The Domain Name was registered on November 7, 1999.

The Domain Name resolved in the past to a website featuring information that was used for the purpose of the project “to join people who are called 'Malo' (Last Name)”.

At the time of submitting the Complaint and as of the date of this Decision, the Domain Name has resolved to a parking WordPress webpage.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

First, the Complainant contends that the Domain Name is identical to the MALO trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

In this regard, the Complainant submits that the Complainant did not authorize the Respondent to use its MALO trademark in the Domain Name. Moreover, the Complainant contends that there is no association

between the Complainant and the Respondent. Finally, the Complainant alleges that the Respondent has never actively used the Domain Name.

Third, the Complainant submits that the Domain Name was registered and is being used in bad faith.

In this regard, the Complainant contends that the Domain Name has been registered for the purpose of selling, renting, or otherwise transferring the Domain Name registration to a third party. Moreover, according to the Complainant, the registration of the Domain Name prevented the Complainant from reflecting the MALO trademark in a corresponding domain name. Furthermore, the Complainant suspects that the Respondent gained economic advantage from a pay-per-click (“PPC”) system at the website connected to the Domain Name. Finally, the Complainant reiterates that the Domain Name has been held passively since its registration.

B. Respondent

The Respondent contends that the Complainant has not satisfied the elements required under the Policy for a transfer of the Domain Name.

First, the Respondent submits that he had registered the Domain Name before the Complainant registered most of its MALO trademarks. Moreover, according to the Respondent, the Complainant’s MALO trademark registrations cover primarily production of cashmere clothing.

Second, the Respondent submits that the Domain Name is composed of his surname Malo. According to the Respondent, he has been commonly known by this surname. Moreover, the Respondent demonstrates that in the past he actively used the Domain Name for the purpose of his personal project. The Respondent also points out that the Complainant attempted to buy the Domain Name from the Respondent several years prior to filing of the Complaint.

Third, the Respondent denies that the Domain Name has been registered and is being used in bad faith.

6. Discussion and Findings

6.1. Preliminary Matters – Language of the Proceeding

The language of the Registration Agreement for the Domain Name is French. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requests that the language of the proceeding be English for several reasons. First, the Complainant submits that it is an Italian company. The Complainant’s staff is fluent in English and is not fluent in French. Second, the Complainant notes that the communications regarding the Domain Name with the Registrar were held in English. Third, the Complainant contends that English is the language traditionally used in the Internet environment.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs. See section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

The Panel finds that substantial additional expense and delay would likely be incurred if the Complainant had to be translated into French. Moreover, the Panel notes that the Respondent filed a Response in English.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Substantive Matters – Three Elements

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met. At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2 of the [WIPO Overview 3.0](#).

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid MALO trademark registrations. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to that trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The Top-Level Domain (“TLD”) “.com” in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element test. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is identical to the Complainant’s MALO trademark for purposes of the Policy. Thus, the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent may establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that he has used or made 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 prior to the dispute; or
- (ii) that he is commonly known by the Domain Name, even if he has not acquired any trademark rights; or
- (iii) that he is making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

In the present case, the Respondent has produced concrete credible evidence demonstrating that he is commonly known by the name corresponding to the Domain Name.

For the Respondent to demonstrate that he has been commonly known by the Domain Name or a name corresponding to the Domain Name, it is not necessary for the Respondent to have acquired corresponding trademark or service mark rights. However, the Respondent must be “commonly known” (as opposed to

merely incidentally being known) by the relevant moniker (e.g., a personal name) apart from the Domain Name. Such rights, where legitimately held/obtained, would prima facie support a finding of rights or legitimate interests under the UDRP. See section 2.3 of the [WIPO Overview 3.0](#).

The Panel finds that the Respondent's claim to be commonly known by the surname Malo corresponding to the Domain Name is legitimate. The Respondent presented a government-issued ID showing that his surname is Malo. Moreover, the Respondent referred to his other personal domain name incorporating the Respondent's surname, as well as to the Respondent's social media accounts. In addition, the Respondent pointed out his professional publications under the surname Malo.

Thus, it appears that the Respondent registered the Domain Name in order to be identified by his surname. The Respondent presented evidence that in the past, at least between 2000 and 2014, he actively used the Domain Name for the purpose of a project "to join people who are called 'Malo' (Last Name)". At the time of submitting the Complaint and as of the date of this Decision, the Domain Name has resolved to a parking WordPress webpage. There is no evidence before the Panel indicating that the Respondent attempted to divert consumers or tarnish in any way the Complainant's trademark at any point since the registration of the Domain Name nearly 25 years ago. See *Dr. W. Kupper and E. von Karajan v. Karajan Pty Ltd.*, WIPO Case No. [D2000-1578](#).

In sum, the Panel finds that the Respondent succeeded in proving that he has rights and legitimate interests in the Domain Name. The Panel concludes that the second element of the Policy has not been established.

C. Registered and Used in Bad Faith

Given that the Panel has found that the Respondent has rights and legitimate interests in the Domain Name, the issue of bad faith does not need to be addressed. In any event, the Panel does not consider that the Domain Name has been registered and is being used in bad faith.

The Panel notes that the evidence in the case file does not indicate that the Respondent's aim in registering the Domain Name was to profit from or exploit the Complainant's trademark. It rather appears that the Respondent had no intention to use the Domain Name for commercial purposes, but for private ones. As indicated above, the Domain Name resolved in the past to a website featuring information that was used for the purpose of the project "to join people who are called 'Malo' (Last Name)". There is no evidence in the case file proving the Complainant's allegation that the Respondent used the Domain Name to generate profit from the PPC system.

At the time of submitting the Complaint and as of the date of this Decision, the Domain Name has resolved to a parking WordPress webpage. The Panel does not find that passive holding of the Domain Name amounts to bad faith of the Respondent in the circumstances of this case, as there are no facts in this dispute supporting such a finding. See *Kelin S.r.l. v. Privacy Service provided by Withheld for Privacy ehf / Vincent Cammarata*, WIPO Case No. [D2022-0746](#).

Given the above, the Panel finds the third element of the Policy has not been established.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking ("RDNH") or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute RDNH. [WIPO Overview 3.0](#), section 4.16.

The Respondent has not directly sought a finding of RDNH. However, the Panel so finds and will briefly address this issue.

The Panel believes that the Complainant should have appreciated at the outset that its Complaint could not succeed. In particular, the Complainant has not demonstrated any circumstances indicating that it was being targeted via the Domain Name and that it would be able to prove registration in bad faith. It appears to the Panel that the Complainant only launched the Complaint after unsuccessfully attempting to acquire the Domain Name in the past. The Complainant suggests the importance of the Domain Name for its business claiming that “a business activity in a global world makes a TLD “.com” useful for global business”. In the Panel’s opinion, these circumstances point in the direction of a finding of RDNH.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: January 31, 2024