

ADMINISTRATIVE PANEL DECISION

Miroglio Fashion S.R.L. v. Privacy Service Provided by Withheld for Privacy ehf / Marvin Turner and Melinda Ulbrecht
Case No. D2022-0423

1. The Parties

Complainant is Miroglio Fashion S.R.L., Italy, represented by Studio Barbero, Italy.

Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Marvin Turner, Spain and Melinda Ulbrecht, United States of America.

2. The Domain Names and Registrar

The disputed domain names <oltreit.shop> and <oltroulet.online> (the “Domain Names”) are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 8, 2022. On February 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On February 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on February 14, 2022, providing the registrants and contact information disclosed by the Registrar, and requesting Complainant to amend the Complaint adding the Registrar-disclosed registrants as formal Respondents and provide relevant arguments or evidence demonstrating that all named Respondents are, in fact, the same entity and/or that the Domain Names are under common control; and/or file a separate complaint for any domain name(s) for which it is not possible to demonstrate that all named Respondents are in fact the same entity and/or that the Domain Names are under common control and indicate (by short amendment or reply email) which domain name(s) will no longer be included in the current Complaint. Complainant filed an amended Complaint on February 15, 2022.

On February 16, 2022, the Center noted that there appears to be at least *prima facie* grounds sufficient to warrant accepting the Complaint for the Panel’s final determination of the consolidation request on appointment.

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 Respondent of the Complaint, and the proceedings commenced on February 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 15, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 16, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on March 24, 2022. 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. Procedural Issue: Consolidation of Multiple Respondents

The Panel has considered the possible consolidation of the Complaint for the Domain Names. According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.11.2, “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”.

The Panel notes the following features of the Domain Names and arguments submitted by Complainant in favor of the consolidation of the Domain Names:

- the Domain Names share the same structure, as they include the trademark OLTRE along with non-distinctive elements, namely the abbreviation of the geographical term Italy (“it”) and a misspelled version of the dictionary term “outlet”, “oulet”, respectively, along with new generic Top Level Domains, namely “.shop” and “.online”;
- the Domain Names were registered at close dates, namely July and September 2021;
- the Domain Names are both registered with the same Registrar;
- the Domain Names used the same privacy service provided by Withheld for Privacy ehf;
- as Complainant demonstrated, the Domain Names were used to host websites (the Websites) in the Italian language, with several misspelled words in their text, with a highly similar layout, featuring Complainant’s trademarks and official images and offering for sale purported OLTRE products at very low prices. The Websites include a very similar title of the home page at the top of the browser, namely an identical title differing only in the addition of the relevant Domain Name after the words “Oltre Shop Online Abbigliamento: Donna -”. No complete contact information is provided on the Websites, while the entire text published in the “About Us” section (at https://www.oltreit.shop/help/about_us and https://www.oltroulet.online/it/about_us.html?uvid=202112221208127289) is identical.
- similarities appear also in the Whols information, since both Domain Names are registered with the indication of Gmail addresses as registrant’s email and of locations based in the United States of America (“United States” or “US”).

In view of all the above, the Panel finds that the consolidation of the Domain Names is fair to the Parties, and Respondents have been given an opportunity to object to consolidation through the submission of pleadings to the Complaint (if indeed there is more than one Respondent for these Domain Names), but have chosen not to rebut the consolidation (see [WIPO Overview 3.0](#), sections 4.11.1 and 4.11.2; *Virgin Enterprises*

Limited v. LINYANXIAO aka lin yanxiao, WIPO Case No. [D2016-2302](#)). Based on the Complaint, the Panel finds that it is more likely than not that the Domain Names are in common control of one entity; hence, the Panel grants the consolidation for the Domain Names (and will refer to these Respondents as “Respondent”).

5. Factual Background

Complainant is part of the Miroglio Group, which designs, manufactures and distributes internationally women’s clothes under *inter alia* the brand OLTRE. Complainant’s OLTRE brand was created in 2001 as a lifestyle brand. OLTRE products are sold offline and online via 143 directly operated stores based in Italy, 23 affiliates (out of which 20 are located in Italy, 2 in Macedonia and 1 in Romania) and 11 outlets located in Italy. Complainant’s revenues from the sale of OLTRE products amounted to 92 million Euro in 2019 and 55 million Euro in 2020. Complainant’s investments in advertising amounted to 3.6 million Euro in 2019 and 3 million Euro in 2020.

Complainant is the owner of many domain names incorporating the trademark OLTRE, including the domain name <oltre.com>, registered on August 24, 1998. Complainant’s website “www.oltre.com” provides information about Complainant’s OLTRE products and an online store where Complainant’s OLTRE apparel products are advertised and offered for sale.

Complainant is the owner of numerous trademark registrations for OLTRE (word mark), including the following:

- Italian Trademark Registration No. 362020000079084, filed on May 14, 2000 and registered on June 25, 2000, for goods in international classes 24 and 25;
- European Union Trademark Registration No. 007065907, filed on July 14, 2008, registered on May 11, 2009 for goods and services in international classes 9, 14, 18, 24, 25 and 35;
- International Trademark Registration No. 748502, registered on November 21, 2000, for goods and services in international in classes 24 and 25;
- International Trademark Registration No. 904929, registered on September 27, 2006, for services in international class 35;
- International Trademark Registration No. 788588, registered on September 4, 2002, for goods in international classes 9, 14 and 18.

The Domain Name <oltreit.shop> was registered on September 18, 2021, and the Domain Name <oltroulet.online> was registered on July 6, 2021. Both Domain Names lead respectively to the Websites in Italian language prominently displaying Complainant’s trademark OLTRE and the OLTRE logo of Complainant’s website “www.oltre.com”, publishing official images taken from Complainant’s website “www.oltre.com” and related Complainant’s social media accounts (such as the Facebook page “www.facebook.com/oltrefashion”) and purportedly offering for sale OLTRE products at discounted prices, without providing any disclaimer as to Respondent’s lack of relationship with Complainant and any information on the entity actually operating the Websites. Based on the very low prices at which the alleged OLTRE products are offered for sale on the Websites, per Complainant, it cannot be excluded that the products offered for sale on the Websites are counterfeit. Per Complaint, Complainant has received several reports about the Websites due to the confusion caused with Complainant and its official website. Complainant sent a cease and desist letter on October 8, 2021 and reminders on October 14, 2021, October 21, 2021, October 28, 2021 and November 19, 2021 to which Respondent did not reply.

In addition, per Complaint, Mail eXchanger records have been set up for the Domain Names, meaning that currently or in the future the Domain Names may be used for email communications. Indeed, the fact that the cease and desist letter sent by Complainant to [...]@oltroulet.online was apparently delivered, which suggests that mailboxes are configured at least for the Domain Name <oltroulet.online>.

6. Parties' Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Names.

B. Respondent

Respondent did not reply to the Complainant's contentions.

7. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Names:

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

A. Identical or Confusingly Similar

The Domain Names incorporate Complainant's OLTRE trademark in its entirety, except for the deletion of the last letter "e" in the second Domain Name. This is sufficient to establish confusing similarity (*Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#)).

The addition of the abbreviation of the geographical term Italy ("it") and a misspelled version of the dictionary term "outlet", "oulet", in each of the Domain Names respectively, does not prevent a finding of confusing similarity, as the OLTRE trademark as regards the first Domain Name its first and main part OLTR as regards the second Domain Name, remain clearly recognizable ([WIPO Overview 3.0](#), section 1.8).

The generic Top-Level Domains ("gTLD") ".shop" and ".online" are disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Names are confusingly similar to Complainant's OLTRE trademark.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

(i) before any notice to Respondent of the dispute, Respondent's use of, or 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) Respondent (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or

(iii) Respondent 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 or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Domain Names. As per Complainant, Respondent was not authorized to register the Domain Names.

Respondent has not demonstrated any preparations to use, or has not used the Domain Names or a trademark corresponding to the Domain Names in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Names were used to host the Websites to impersonate Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the Websites originate from Complainant. Such use demonstrates neither a *bona fide* offering of goods nor a legitimate interest of Respondent (*Arkema France v. Aaron Blaine*, WIPO Case No. D2015-0502).

A distributor, reseller or service provider, can make a *bona fide* offering of goods or services and thus have a right or legitimate interest in a domain name only if the following cumulative requirements are met (*Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); [WIPO Overview 3.0](#), section 2.8.1): (i) respondent must actually be offering the goods or services at issue; (ii) respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) respondent must not try to "corner the market" in domain names that reflect the trademark.

These requirements are not cumulatively fulfilled in the present case. The Domain Names falsely suggest that they are the official website of Complainant or of an entity affiliated to or endorsed by Complainant. The Websites reproduce, without authorization by Complainant, Complainant's trademarks, without any disclaimer of association (or lack thereof) with Complainant.

In view of the very low prices at which the purported OLTRE products are offered for sale on the Websites, it cannot be excluded, per Complaint, that the goods are counterfeit.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Names.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Names in bad faith.

Because the OLTRE mark had been widely used and registered by Complainant before the Domain Names registrations, the Panel finds it more likely than not that Respondent had Complainant's mark in mind when registering the Domain Names (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. D2000-0226).

Respondent should have known about Complainant's rights, as such knowledge is readily obtainable through a simple browser search and also due to Complainant's nature of business, provided also online, namely online sales (see *Caesars World, Inc. v. Forum LLC*, WIPO Case No. [D2005-0517](#); *Compart AG v. Compart.com / Vertical Axis Inc.*, WIPO Case No. [D2009-0462](#)).

Furthermore, the content of the Websites gives the impression that they originates from Complainant, prominently displaying OLTRE signs on the Website, official Complainant images and OLTRE logo, thereby giving the false impression that the Websites emanates from Complainant's group. This further supports registration in bad faith reinforcing the likelihood of confusion, as Internet users are likely to consider the Domain Names as in some way endorsed by or connected with Complainant ([WIPO Overview 3.0](#), section 3.1.4).

The above further indicates that Respondent knew of Complainant and chose the Domain Names with knowledge of Complainant and its industry (*Safepay Malta Limited v. ICS Inc.*, WIPO Case No. D2015-0403).

Furthermore, Respondent could have conducted a trademark search and should have found Complainant's prior registrations in respect of OLTRE (*Citrix Online LLC v. Ramalinga Reddy Sanikommu Venkata*, WIPO Case No. [D2012-1338](#)).

As regards bad faith use, Complainant demonstrated that the Domain Names were employed to host the Websites which appeared falsely to be those of Complainant.

Furthermore, the Domain Names have been operated by intentionally creating a likelihood of confusion with Complainant's trademark and business. This further supports the finding of bad faith use (*Arkema France v. Aaron Blaine, supra*; *Aktiebolaget Electrolux v. Priscilla Quaiotti Passos*, WIPO Case No. [D2011-0388](#) and [WIPO Overview 3.0](#), sections 3.1.4 and 3.2.1).

As a further circumstance evidencing Respondents' bad faith, Respondent did not only availed of a privacy service to shield the identity and contact details in the public Whois records but, according to the information disclosed by the Registrar to the Center after the filing of the Complaint, Respondent also apparently provided fictitious contact information to the Registrar at the time of registration.

Under these circumstances and on this record, the Panel finds that Respondent registered and used the

Domain Names in bad faith.

Complainant has established Policy, paragraph 4(a)(iii).

8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names <oltreit.shop> and <oltroulet.online> be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: April 7, 2022