

ADMINISTRATIVE PANEL DECISION

Mr. Vincenzo Attolini v. MTZ International s.r.l.
Case No. D2022-1450

1. The Parties

The Complainant is Mr. Vincenzo Attolini, Italy, represented by FPB Legal (Ferrari Pedefferri Boni), Italy.

The Respondent is MTZ International s.r.l., Italy, represented by FIAMMENGHI-FIAMMENGHI, Italy.

2. The Domain Name and Registrar

The disputed domain name <vincenzoattolini.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 22, 2022. On April 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 26, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 May 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 26, 2022. The Response was filed with the Center on May 23, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on June 3, 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Mr. Vincenzo Attolini, an Italian designer and businessman operating in the fashion field.

According to the Whois records, the disputed domain name was registered on November 8, 2005 and it redirects to the website at "www.cesareattolini.com".

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is identical to his name and surname "Vincenzo Attolini".

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use his name and surname within the disputed domain name and it is not commonly known by the disputed domain name.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's personal name is distinctive and internationally known in the field of fashion. Therefore, the Respondent targeted the Complainant's personal name at the time of registration of the disputed domain name and the Complainant contends that the redirection of the disputed domain name to the official website of the Complainant's brothers, operating in the same field of fashion for men and against which there is a pending lawsuit, qualifies as bad faith registration and use.

B. Respondent

The Respondent states that the Complainant has not been able to demonstrate that the use in commerce of his name and surname can establish unregistered trademark rights.

The Respondent asserts to have rights or legitimate interests in respect of the disputed domain name since it owns several trademark registrations for ATTOLINI and CESARE ATTOLINI.

Finally, the Respondent submits that the disputed domain name has been registered in good faith in order to commemorate and honor Vincenzo Attolini, which is not only the personal name of the Complainant but also the personal name of the grandfather of the Complainant, Vincenzo Attolini, and of his brothers, Massimiliano and Giuseppe Attolini. The disputed domain name redirects to the official website of the fashion company CESARE ATTOLINI S.p.A., named after Cesare Attolini, the son of Vincenzo Attolini (the grandfather) and the father of the three brothers Vincenzo (the Complainant), Massimiliano and Giuseppe, and run by Massimiliano and Giuseppe Attolini.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

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

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

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

A. Identical or Confusingly Similar

As regards UDRP-relevant rights in a personal name, according to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.5.2:

“The UDRP does not explicitly provide standing for personal names which are not registered or otherwise protected as trademarks. In situations however where a personal name is being used as a trademark-like identifier in trade or commerce, the complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case where the name in question is used in commerce as a distinctive identifier of the complainant’s goods or services”.

The Panel considers that in the fashion field it is very common that the personal name of a fashion designer is treated as his/her trademark, although unregistered. While the Complainant appears to have established in this case that his personal name “Vincenzo Attolini” has been used in commerce in a way likely to establish unregistered trademark rights in that name for purposes of standing to file a UDRP case, this Panel is not making a final determination under this element in view of the Panel’s ruling under the “registration in bad faith” element.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

“(i) before any notice to you of the dispute, your 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) you (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) you are 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.”

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is always more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in its Complaint asserts that the Respondent, who has not been authorized by the Complainant to register the disputed domain name or to use his personal name within the disputed domain name, is not commonly known by the disputed domain name and is not making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name: the disputed domain

name is redirected to a website where fashion items are sold in direct competition with the Complainant's business.

The Respondent claims to have registered the disputed domain name in order to commemorate and honor the grandfather Vincenzo Attolini.

While it is not clear to the Panel why the Respondent uses a domain name that is an identical match of the Complainant's personal name to redirect to a competing website at "www.cesareattolini.com" without the Complainant's consent, the Panel is not making a final determination under this element in view of the Panel's ruling under the "registration in bad faith" element.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that "for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) that [the 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 [the respondent has] engaged in a pattern of such conduct; or
- (iii) that [the 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, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location".

Regarding the registration in bad faith of the disputed domain name, being the parties members of the same Attolini family, the Panel finds that the Respondent knew of the Complainant and deliberately registered the disputed domain name. However, it is not clear in this case whether the Respondent registered the disputed domain name in bad faith back in 2005. The Panel notes that on the same date, November 8, 2005, all three Attolini brothers personal names were registered under the gTLD .com, namely not only the disputed domain name <vincenzoattolini.com>, but also <massimilianoattolini.com> and <giuseppeattolini.com>, while after a few days, on another identical date, November 14, 2005, the same personal names were registered under the ccTLD .it, namely <vincenzoattolini.it>, <massimilianoattolini.it> and <giuseppeattolini.it>, as part of something looking very much like a common family strategy.

As regards to the use of the disputed domain name, pointing to the competing website at "www.cesareattolini.com", it appears that the Respondent is taking advantage from user confusion. The Policy does not apply to all types of trademark infringement *per se*, it applies to the bad faith registration and use of a domain name (being a conjunctive requirement) which is confusingly similar to a party's trademark and in which the domain name registrant has no rights or legitimate interests. The fact that the Respondent here may currently be infringing on Complainant's trademark does not by itself result in a determination of the disputed domain name being registered in bad faith.

However, the proceeding under the Policy does not prevent the Complainant from submitting the dispute to a court of competent jurisdiction for independent resolution after this proceeding is concluded, and the Complainant is free to seek other more suitable remedies which may be available in the competent

jurisdiction.

In light of the above, the Panel finds that the Complainant has failed to prove that the Respondent has registered the disputed domain name domain name in bad faith, in accordance with paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: June 24, 2022