

ADMINISTRATIVE PANEL DECISION

Locatelli S.P.A v. Niels Gerritsen

Case No. D2022-4416

1. The Parties

The Complainant is Locatelli S.P.A, Italy, represented by Dr. Modiano & Associati S.p.A., Italy.

The Respondent is Niels Gerritsen, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <airoh-shop.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 18, 2022. On November 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 21, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 2022, 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 November 23, 2022.

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 November 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 19, 2022. On December 28, 2022, the Center granted the Respondent a five-day extension, e.g., through January 3, 2022. The Respondent did not reply to the Complainant's contentions.

The Center appointed Taras Kyslyy as the sole panelist in this matter on January 17, 2023. 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 an Italian company in the field of motorcycle safety helmets since 1986 and nowadays has distributors and resellers in over 80 countries. The Complainant operates under the brand AIROH, which is registered as a trademark in various jurisdictions, including, European Union Trade Mark registration No. 010542991, registered on June 2, 2012.

The Complainant has its official website at “www.airoh.com”. The Complainant also owns a number of other domain names featuring its trademark.

The disputed domain name was registered on July 28, 2021, and resolved to a website prominently featuring the Complainant’s trademark, containing link to the Complainant’s official website and purportedly offering for sale goods branded with the Complainant’s trademark. At the time of the Decision, the disputed domain name resolves to a webpage stating “Forbidden. You don’t have permission to access this resource”.

5. Parties’ Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant’s trademark. The disputed domain name contains the Complainant’s trademark in its entirety, with the sole addition of the generic term “shop”. The generic term “shop” increases confusion in the minds of the public, misleading consumers into believing that the disputed domain name and related website may be a legitimate online shop authorized or owned by the Complainant. The combination of the term “shop” with the Complainant’s trademark for a website where helmets under the sign AIROH are sold further increases confusion.

The Respondent has no rights or legitimate interests in the disputed domain name. No agreements, authorizations or licenses have been granted to the Respondent to use the Complainant’s trademarks. The registration and/or use of the disputed domain name containing the Complainant’s entire trademark makes it difficult to infer a legitimate use of the disputed domain name by the Respondent. The Complainant’s trademark is far from being a generic term, thus the Respondent could not plausibly claim to use the disputed domain name for any legitimate purpose unrelated to the Complainant and its products. There is no evidence that the Respondent has trademarks or company activities registered under the AIROH brand. The disputed domain name is used for a website where products under the Complainant’s trademark are offered for sale, and the entity NGR Racing Products is promoted. Since the registration of the disputed domain name the Respondent has never made any *bona fide* use of the disputed domain name. The Respondent has never been known under the AIROH name.

The disputed domain name was registered and is being used in bad faith. The Complainant’s trademark is far from being a generic term, thus the Respondent could not plausibly claim to have chosen the disputed domain name without being aware of the Complainant’s trademark. This is particularly true given the fact that the Complainant’s trademark, purported the Complainant’s goods and links to the Complainant’s official website are displayed on the website associated with the disputed domain name. The Respondent also cannot claim to use the disputed domain name for any legitimate purpose unrelated to the Complainant and/or its products. No plausible explanation exists as to why the Respondent selected the name AIROH as part of the disputed domain name other than to trade on the goodwill of the Complainant. The Respondent registered the disputed domain name after many years of use and promotion by the Complainant in Italy and abroad of its trademarks. The disputed domain name contains the Complainant’s trademark in its entirety, combined with the generic term “shop”, and is used for a website selling purported AIROH helmets, *i.e.* the

goods produced by the Complainant. Therefore, it is evident that the disputed domain name was registered with the Complainant's trademark in mind. Regarding whether the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor, the Complainant is being hindered and penalized by the use of the disputed domain name which is misleading Internet users and creating a likelihood of confusion with the Complainant's trademarks and domain names. As regards the use of the disputed domain name to attract Internet users by creating a likelihood of confusion with the Complainant itself, the Respondent has never received any authorization to sell products or services under the Complainant's trademark in any form.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") the applicable generic Top-Level Domain ("gTLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards the gTLD ".com" for the purposes of the confusing similarity test.

According to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. The Panel finds that in the present case the disputed domain name incorporates the entirety of the Complainant's trademark.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The Panel finds that in the present case the addition of a hyphen "-" and "shop" does not prevent finding confusing similarity of the disputed domain name and the Complainant's trademark.

Considering the above the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

According to section 2.8.1 of the [WIPO Overview 3.0](#) resellers, distributors using a domain name containing the complainant's trademark to undertake sales related to the complainant's goods may be making a *bona fide* offering of goods and thus have a legitimate interest in such domain name. Outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the "Oki Data Test"), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods at issue;
- (ii) the respondent must use the site to sell only the trademarked goods;
- (iii) the site must accurately and prominently disclose the registrant's relationship with trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names reflecting trademark.

The Panel finds that the Respondent failed to satisfy at least the third above requirement and did not in any way disclose its actual relationship with the Complainant, and thus failed to pass the *Oki Data* Test. The Respondent's use of the disputed domain name misleads consumers into thinking that the website is operated by or affiliated with the Complainant. As such, the Respondent's use of the disputed domain name cannot be considered *bona fide*.

The Respondent has no rights or legitimate interests in the disputed domain name currently resolving to an inactive website (see, e.g., *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#)).

Considering the above, the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent's use of the disputed domain name to purport to sell the Complainant's products shows that at the time of the registration of the disputed domain name the Respondent clearly knew and targeted the Complainant's prior registered and famous trademark, which confirms the bad faith (see, e.g., *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

According to paragraph 4(b)(iv) 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: by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location. In this case, the disputed domain name was resolving to a website featuring the Complainant's trademark and falsely pretended to be either authorized or owned by the Complainant to intentionally attract Internet users by creating likelihood of confusion with the Complainant's trademark as to the source of the website and its products. The Panel finds the above confirms the disputed domain name was registered and used in bad faith.

Although at the time of this Decision the disputed domain name resolves to inactive webpage, its previous bad faith use and lack of explanation of possible good faith use from the Respondent makes any good faith use of the disputed domain name implausible. Thus, the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy (see section 3.3 of the [WIPO Overview 3.0](#)). Moreover, considering the change in use, the current passive holding of the disputed domain name suggests that the Respondent had no credible good faith explanation for its prior use of the disputed domain name to host the copycat web store.

Considering the above, the Panel finds the disputed domain name was registered and is being used in bad faith. Therefore, the Complainant has established its case under paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <airoh-shop.com>, be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: January 24, 2023