

ADMINISTRATIVE PANEL DECISION

Coccinelle S.p.A. v. linda123 linda123

Case No. D2022-4625

1. The Parties

The Complainant is Coccinelle S.p.A., Italy, represented by Studio Legale Tributario (Milan), Italy.

The Respondent is linda123 linda123, United States of America.

2. The Domain Name and Registrar

The disputed domain name <coccinelleonline.shop> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 2, 2022. On December 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 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 December 6, 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 December 9, 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 December 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 9, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on January 19, 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.

On January 13, 2023, the Complainant sent an email message to the Center asking if it would be possible to add four domain names to the pending dispute, encompassing the COCCINELLE trademark together with generic words such as “outelet”, “saldi”, etc., and linked to the same contents of the disputed domain name. At that occasion, the Complainant did not indicate the specific domain names that it would like to include in the current dispute.

On January 16, 2023, the Center sent an email message to the Complainant stating that the Rules do not explicitly provide for a Complaint to be amended after the commencement of proceeding to include additional domain names, and that it is for the Panel to determine when appointed whether or not to accept the addition of new domain names to the Complaint and order further procedural steps, if any.

On February 3, 2023 the Panel issued the Procedural Order No. 1, determining that the Complainant should inform the Center within five days the specific domain names it would like to add to the present case.

On February 8, 2023, the Complainant answered the Procedural Order No. 1 informing that no additional domain names should be added to the present case.

4. Factual Background

The Complainant is Coccinelle S.p.A., the producer and distributor of bags, small leather goods and luxury accessories under the brand COCCINELLE, which was founded in Italy, in 1978.

The Complainant is the owner of numerous trademark registrations incorporating the term “coccinelle” across various jurisdictions, including the Italian Trademark Registration number 0000761402, registered on November 16, 1998; and the United States Trademark Registration number 2,177,812, registered on August 4, 1998.

The Complainant is also the owner of several domain names also incorporating the COCCINELLE trademark, such as <coccinelle.com> and <coccinelle.it>, respectively registered on November 17 and 25, 1997.

The Respondent registered the disputed domain name <coccinelleonline.shop> on June 8, 2022.

The Panel accessed the disputed domain name on January 23, 2023, at which time the disputed domain name was pointing to a commercial website reproducing the Complainant’s COCCINELLE trademark and logo to offer for sale products under such brand.

5. Parties’ Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) The disputed domain name is identical or confusingly similar to the Complainant’s trademark.

The Complainant previously registered numerous trademarks and domain names including the term “coccinelle”. The disputed domain name has been registered by the Respondent twenty-five years later from the registration of the Complainant’s official domain name. It is obvious that the Respondent had knowledge of the Complainant’s right over the word “coccinelle” at the time of the registration of the disputed domain name. The disputed domain name incorporates the entirety of the Complainant’s company name and the trademark COCCINELLE. The presence of the term “online”, a purely descriptive term, cannot lead to a different conclusion. Moreover, the addition of the gTLD (“generic top-level domain”) suffix – in this case “.shop” – cannot be considered to analyze the identity

or similarity of the disputed domain name with the Complainant's trademark, because it is a necessary component of the disputed domain name and does not give any distinctiveness. The disputed domain name drives Internet users to be convinced that either there is a commercial relationship between the parties, or that the disputed domain name belongs to the Complainant. This misunderstanding surely ruins the reputation of the Complainant's trademark and the company image. The Respondent is – therefore – clearly exploiting the goodwill of the Complainant's trademark, by using such trademark as a dominant part of the disputed domain name.

- (ii) The Respondent has no legitimate interests in the disputed domain name.

None of the circumstances listed on paragraph 4 (c) of the Policy to demonstrate a right or a legitimate interest is identified in the present case. In particular: the Respondent is not known by the disputed domain name; the Complainant's domain names and trademark registrations incorporating the term "coccinelle" are valid and subsisting and are exclusively and extensively used by the Complainant and/or authorized licensees; the Complainant's trademark registrations are conclusive evidence of the Complainant's exclusive right to use the marks in connection with its luxury goods; the Respondent has no rights nor has claimed any rights in respect to the disputed domain name; the Respondent is not, and never has been, a representative or licensee of the Complainant, nor is the Respondent otherwise authorized to use the mark COCCINELLE; there is no affiliation between the Complainant and the Respondent; the Respondent does not use the disputed domain name for a *bona fide* offering of goods or services and is not making a legitimate noncommercial or fair use of it (the disputed domain name is used in connection with a website that closely mimics the Complainant's official website, even copying images from the Complainant's official website); the website linked to the disputed domain name unquestionably trades on the fame of the COCCINELLE trademark and as such does not constitute a *bona fide* use of the disputed domain name; even if the goods being sold at the Respondent's website were genuine COCCINELLE merchandise (and there is no evidence that this is the case), the Respondent's use of the disputed domain name would still not be *bona fide*, because for a reseller to make a *bona fide* use of a trademarked term in a domain name the Respondent should *inter alia* (i) sell only the trademarked goods or services; and (ii) accurately disclose the Respondent's relationship with the trademark owner.

- (iii) The Respondent registered and is using the disputed domain name in bad faith.

The COCCINELLE trademark is famous or widely known and such trademark could not be awarded to the Respondent. This circumstance is also confirmed by the fact that the website linked to the disputed domain name mimics the Complainant's official website. Moreover, creating a website that appears to be the Complainant's website, is likely fraudulent and indicates the Respondent's intent to deceive or, at a minimum, to act in bad faith with the intent for commercial gain. The Respondent's aim is therefore clearly to mislead consumers into the website linked to the disputed domain name by using the Complainant's trademark and obtaining an undue profit. In fact, on July 4, 2022 the Complainant purchased a bag on the website linked to the disputed domain name, but such product was never delivered by the Respondent. Additionally, no contact data is informed by the Respondent at the website linked to the disputed domain name. Therefore, the Complainant has sent a cease-and-desist letter to the Respondent through the registrar of the disputed domain name. This communication remained unanswered.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, the Complainant shall prove the following three elements:

- (i) The disputed 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 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

The Panel has no doubt that “coccinelle” is a term directly connected with the Complainant’s fashion goods.

Annex 07 to the Complaint shows registrations for COCCINELLE trademark owned by the Complainant in different regions of the world since at least 1986.

The trademark COCCINELLE is wholly encompassed within the disputed domain name.

The disputed domain name differs from the Complainant’s trademark basically by the addition of the suffix “online”, as well as of the gTLD “.shop”.

Previous UDRP decisions have found that descriptive additions (such as “online”) do not distinguish a domain name, so as to avoid confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a gTLD extension such as “.shop” is irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds the disputed domain name to be confusingly similar to the Complainant’s trademark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate a right or legitimate interest in a domain name:

- (i) Before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) The respondent has been commonly known by the domain name; or
- (iii) The 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 at issue.

Based on the Respondent’s default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed nor authorized the use of its trademark to the Respondent, and the Panel finds no indication that the Respondent is commonly known by the disputed domain name.

The Respondent has not indicated any reason to justify why he has chosen such well-known trademark to

compose the disputed domain name, together with a merely descriptive addition, and pointing to a website that reproduces the Complainant's brand and official website.

Therefore, the use of the Complainant's trademark in the context of the disputed domain name cannot qualify as a *bona fide* offering of services.

Consequently, the Panel is satisfied that the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or 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 that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) The respondent 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) The respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent in 2022, the term "coccinelle" was already well known for decades and directly connected to the Complainant's bags and accessories.

The disputed domain name encompasses the previously registered trademark COCCINELLE.

According to the [WIPO Overview 3.0](#) of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Actually, the Panel considers that in the present case the addition to the Complainant's trademark of descriptive term "online" and of the gTLD ".shop" may even enhance the risk of confusion, suggesting that the disputed domain name refers to official online store of the Complainant.

This circumstance is emphasized by the fact that the website linked to the disputed domain name presents reproductions of the Complainant's trademark and logo, and offers unauthorized goods for sale under the COCCINELLE brand.

Also, the Complainant brought evidence that products sold at the website linked to the disputed domain name are not being delivered by the Respondent, what is another evidence of bad faith use of the disputed domain name, possibly to perform consumer frauds.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied the third element 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 <coccinelleonline.shop> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: February 16, 2023