

ADMINISTRATIVE PANEL DECISION

Calzedonia S.p.A. v. Domain Administrator, Dynadot Privacy Service
Case No. D2023-2208

1. The Parties

The Complainant is Calzedonia S.p.A., Italy, represented by Novagraaf Nederland B.V., Netherlands.

The Respondent is Domain Administrator, Dynadot Privacy Service, United States of America.¹

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 22, 2023. On May 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 23, 2023, 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 for the disputed domain name.

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 June 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 23, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on June 29, 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.

¹ The Panel notes that in the Registrar’s verification response the Registrar also disclosed “Organization (optional) Buy this domain on Dan.com”.

4. Factual Background

The Complainant is a manufacturer and marketer of underwear and beachwear. The Complainant's network of franchises includes more than 2,000 shops in over 50 countries. In Italy, there are 583 Calzedonia stores. Complainant sells products under the CALZEDONIA trademark.

The Complainant is also the owner of the figurative trademark PODERE GUARDIA GRANDE. Complainant holds a European Union trademark registration no. 018773633 for PODERE. GUARDIA GRANDE, registered for goods in class 33 (filed on 10 October 2022, and registered on March 29, 2023). The Complaint explains that the three words PODERE GUARDIA GRANDE (in Italian) means "LARGE GUARD FARM" which is not a commonly used combination of words nor does it have any meaning in relation to the goods for which it is applied for. The Complainant states that the trademark at issue is therefore highly distinctive. The trademark was registered in class 33 and is used for wine products².

The disputed domain name was registered in October 10, 2022. According to the evidence provided by the Complainant, the disputed domain name was redirecting to <dan.com> to display a website offering the disputed domain name for sale or lease. The disputed domain name is currently not in use.

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 disputed domain name.

Notably, the Complainant contends that:

- the disputed domain name is confusingly similar to its trademarks;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- the Respondent has registered and is using the disputed domain name in bad faith

B. Respondent

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

6. Discussion and Findings

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

- (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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or

² As part of the general powers of the Panel, as articulated, *inter alia*, in paragraph 10 of the Rules, the Panel has corroborated through an Internet search that the Complainant is using the trademark for wine products.

threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the PODERE GUARDIA GRANDE mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.
- the Respondent (as an individual, business, or other organization) has not been commonly known by the disputed domain name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy

establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that:

- The disputed domain name wholly incorporates the identical mark of Complainant's PODERE GUARDIA GRANDE, namely (<podereguardiagrande.com>).
- The term "podere" is an Italian word and typically refers to a small farm or rural property and the Italian words GUARDIA GRANDE identify the name of the place. In this case Guardia Grande is a land located in the Italian province of Alghero on the occidental-north cost of the island of Sardegna.
- There is no logical use that the disputed domain name can be destined for since it only refers to the farm where the Complainant produces wine.
- The Panel made a search online for the terms PODERE GUARDIA GRANDE and was able to verify that the only results found were references to the Complainant wine product.
- The Panel visited the disputed domain name at Archive.org website and was able to verify that the Wayback Machine has not archived any URL³ of the disputed domain name.

Panels have considered bad faith where the domain name was registered on the same day a complainant registered its trademark. [WIPO Overview 3.0](#), section 3.8.2, *Tosara Pharma Limited v. Super Privacy Service LTD c/o Dynadot*, WIPO Case [D2019-2536](#) and *Alstom S.A v. Super Privacy Service LTD c/o Dynadot*, WIPO Case No. [D2019-1804](#).

In this case the Panel is of the view that it is not credible that the Respondent registered the disputed domain name without knowledge that the Complainant has filed a trademark application and was also involved in the project to produce wines under that particular and distinctive name.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding.

As explained above, the disputed domain name is not in use and the Respondent defaulted. The Panel takes also into account a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name. [WIPO Overview 3.0](#), section 3.2.1.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <podereguardiagrande.com> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: July 7, 2023.

³ "https://web.archive.org/web/20230000000000*/podereguardiagrande.com"