

ADMINISTRATIVE PANEL DECISION

Pomellato S.p.A. v. 吴晓亮 (wu xiao liang)

Case No. D2023-4229

1. The Parties

The Complainant is Pomellato S.p.A., Italy, represented by ADV IP S.r.l., Italy.

The Respondent is 吴晓亮 (wu xiao liang), China.

2. The Domain Name and Registrar

The disputed domain name <pomellato.store> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on October 11, 2023. On October 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 12, 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.

On October 16, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On October 17, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Chinese of the Complaint, and the proceedings commenced on October 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 17, 2023.

The Center appointed Jonathan Agmon as the sole panelist in this matter on December 15, 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 Pomellato S.p.A., a part of the Kering group, is an Italian jewelry company. The brand was founded by Pino Rabolini in Milan in 1967 and currently ranks among the top five European jewelers by sales.

The Complainant is the owner of over 200 POMELLATO trademark registrations worldwide, including the following:

- 1) International trademark registration no. 338401 for POMELLATO (Figurative), registered on October 3, 1967;
- 2) United States of America trademark registration no. 0866311 for POMELLATO, registered on March 11, 1969;
- 3) European Union Trade Mark registration no. 000872945 for POMELLATO (Figurative), registered on October 5, 1999;
- 4) International trademark registration no. 1049984 for 宝曼兰朵, registered on April 30, 2010.

The Complainant is the registrant of numerous domain names consisting of the POMELLATO trademark under a range of generic Top-Level Domains (“gTLDs”), including its Chinese domain name <pomellato.cn>, which was registered on April 2, 2007.

The Respondent registered the disputed domain name <pomellato.store> on August 17, 2023.

At the time of the filing, the disputed domain name resolved to an inactive webpage.

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:

1. The disputed domain name is identical to the Complainant’s POMELLATO trademark with the addition of the gTLD “.store”.
2. The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not known by the name of “pomellato” or “pomellato.store” and does not hold any trademark consisting of “pomellato” or “pomellato.store”. The Respondent is not a licensee of the Complainant or affiliated with the Complainant in any way. The Complainant has not granted any authorization for the Respondent to make use of the POMELLATO trademark, in a domain name or otherwise. 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.

3. The disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name utilizing a combination of the Complainant's POMELLATO mark and the gTLD ".store", which demonstrates not only the Respondent's knowledge of the Complainant's POMELLATO trademark, but also the Respondent's intention to exploit the reputation of the Complainant's trademark to attract traffic to his website. Further, the non-use and passive holding of the disputed domain name has been held in past UDRP decisions to be a sign of bad faith.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that:

- (i) the Respondent's email address is associated with the registration of a series of domain names that share an identical structure with the disputed domain name, as they consist of well-known trademarks and a generic term in the English language;
- (ii) The Respondent's email address is associated with the registration of numerous other domain names composed exclusively of terms in the English language;
- (ii) the disputed domain name possesses a new gTLD comprising of the word "store" which is a word in the English language denoting.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [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 disputed domain name consists of the Complainant's POMELLATO trademark in its entirety, with the addition of the gTLD ".store". The Panel finds the entirety of the 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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available 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 such as those enumerated in the Policy or otherwise.

The Complainant’s registration of its trademark(s) predates the registration of the disputed domain name. The disputed domain name is currently inactive. There is no objective evidence showing that the Respondent is using or has made any preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use purpose.

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.

In the present case, the Panel notes that the Respondent registered the disputed domain name long after the Complainant registered its POMELLATO trademark. Given the distinctiveness of the Complainant’s mark and their good will, it is highly unlikely that the Respondent did not know of the Complainant and its POMELLATO marks prior to the registration of the disputed domain name.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available 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. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of

false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel also draws an adverse inference from the Respondent's failure to file any Response or to rebut the Complainant's assertions and agrees that the circumstances constitute evidence of bad faith registration and use under the Policy.

The Panel also notes that the documents from the Center were successfully shipped to the Respondent, but he refused delivery of the same, claiming *inter alia*, that the documents were not required. The Panel therefore draws an adverse inference accordingly.

Based on the available record, the Panel finds that the Complainant has established 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 <pomellato.store> be transferred to the Complainant.

/Jonathan Agmon/

Jonathan Agmon

Sole Panelist

Date: December 29, 2023