

ADMINISTRATIVE PANEL DECISION

Sergeferrari Group v. Tresm Mate and Name Redacted Case No. D2023-4318

1. The Parties

The Complainant is Sergeferrari Group, France, represented by Cabinet Laurent & Charras, France.

The Respondents are Tresm Mate, United States of America, and Name Redacted.¹

2. The Domain Names and Registrars

The disputed domain name <serge-ferrari.com> is registered with NameCheap, Inc. (the “Registrar 1”). The disputed domain name <sergeferrarigrp.com> is registered with Wild West Domains, LLC (the “Registrar 2”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 17, 2023. On October 18, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On October 18, 2023, the Registrars transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondents (Private, and Registration Private, Domains By Proxy, LLC), and contact information in the Complaint. The Center sent an email communication to the Complainant on October 23, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate Complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed an amended Complaint on November 13, 2023.

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”).

¹ The Respondent appears to have used the name of a third party when registering one of the disputed domain names. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondents of the Complaint, and the proceedings commenced on November 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on December 5, 2023. On December 6, 2023, the Center received a communication from a third party, indicating that "[he] tried to remove the domain from [his] business Microsoft account where some hacker illegally accessed, and paid for that domain with a stolen credit card from someone in Texas. [He did not] know the company, and [he is] not interested in the domain."

The Center appointed Edoardo Fano as the sole panelist in this matter on December 12, 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.

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

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to [the] Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a response from the Respondents.

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

4. Factual Background

The Complainant is Sergeferrari Group, a French Group operating in the field of innovative composite fabrics. The Complainant owns several trademark registrations for SERGE FERRARI, among which the following ones:

- European Union Trade Mark Registration No. 009899576 for SERGE FERRARI, registered on September 30, 2011;
- French Trade mark Registration No. 3824886 for SERGE FERRARI and design, registered on October 14, 2011;
- French Trade mark Registration No. 3796489 for SERGE FERRARI, registered on June 10, 2011.

The Complainant operates on the Internet, its website being "www.sergeferrari.com".

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain names were registered on the following dates: <sergeferrarigrp.com> on August 15, 2023, and <serge-ferrari.com> on September 6, 2023. They both direct to inactive websites, however the Complainant provided evidence that both the disputed domain names were used to conduct a fraudulent phishing activity in which the Respondents sent email communications to the Complainant's clients, impersonating the Complainant, and using the Complainant's trademark and logo.

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 names.

Notably, the Complainant states that the disputed domain names are confusingly similar to its trademark SERGE FERRARI.

Further to section 6.1 below, the Complainant argues that the disputed domain names are under common control and thus addresses the Respondents in the singular. The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names since it has not been authorized by the Complainant to register the disputed domain names or to use its trademark within the disputed domain names, it is not commonly known by the disputed domain names and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names. The disputed domain names were used by the Respondent to conduct a fraudulent phishing activity, impersonating the Complainant and sending email communications to the Complainant's clients.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, since the Complainant's trademark SERGE FERRARI is known. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain names and the Complainant contends that the use of the disputed domain names to conduct a fraudulent phishing activity, by sending email communications to the Complainant's clients impersonating the Complainant's employees, qualifies as bad faith registration and use.

B. Respondents

The Respondents have made no reply to the Complainant's contentions and are in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record. On December 6, 2023, a third party emailed the Center that he "[he] tried to remove the domain from [his] business Microsoft account where some hacker illegally accessed, and paid for that domain with a stolen credit card from someone in Texas. [He did not] know the company, and [he is] not interested in the domain."

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3.

6. Discussion and Findings

6.1 Procedural issue - Consolidation of Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. [WIPO Overview 3.0](#), section 4.11.2.

As regards common control, the Panel notes that both the disputed domain names follow a very similar naming pattern, they have been registered in the same short period of time, namely between August 15 and September 6, 2023, and they both have the same email address in the contact details.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

6.2 Substantive Issues

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

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are 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 threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names. [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 mark SERGE FERRARI is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, here "grp" and a hyphen, may bear on assessment of the second and third elements, the Panel finds the addition of such term and element does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a generic Top-Level Domain ("gTLD"), in this case ".com", is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

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, UDRP 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 names. 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 present record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

The disputed domain names were used to conduct a fraudulent phishing activity in which the Respondent sent email communications to the Complainant's clients, impersonating the Complainant and using the Complainant's trademark and logo. Panels have held that the use of a domain name for illegal activity, here phishing and impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Moreover, the Panel finds that the composition of the disputed domain names carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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.

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.

In the present case, regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant's trademark SERGE FERRARI in the field of innovative composite fabrics is clearly established, and the Panel finds that the Respondent likely knew of the Complainant and deliberately registered the confusingly similar disputed domain names.

The Panel further notes that the disputed domain names were also used in bad faith since the Respondent was trying to impersonate the Complainant, in connection to a phishing scheme, with the purpose of intentionally attempting to create a likelihood of confusion with the Complainant's trademark as to the disputed domain names' source, sponsorship, affiliation or endorsement. [WIPO Overview 3.0](#), sections 3.1.4 and 3.4.

Furthermore, the Panel considers that the nature of the inherently misleading disputed domain names, which include the Complainant's trademark in its entirety with the mere addition of the term "grp" (standing for "group", namely a part of the Complainant's company name) in one of them, and of a hyphen in the other one, further supports a finding of bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel concludes that the Respondent also registered the disputed domain name <sergeferrairgrp.com> using the identity of a third party. The use of false registration data in connection with this domain name further supports a finding of bad faith registration and use.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

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 names, <serge-ferrari.com>, and <sergeferrarigrp.com>, be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: December 26, 2023