

ADMINISTRATIVE PANEL DECISION

Berluti v. Mjheu Khduw
Case No. D2024-0671

1. The Parties

The Complainant is Berluti, France, represented by Studio Barbero S.p.A., Italy.

The Respondent is Mjheu Khduw, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <berlutionline.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 13, 2024. On February 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 14, 2024, 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.

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 February 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 11, 2024.

The Center appointed Torsten Bettinger as the sole panelist in this matter on March 15, 2024. 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 a French fashion house established in 1895 and specialized in the manufacture of leather goods.

The Complainant is the owner of national and international trademark registrations worldwide for BERLUTI, including the following:

- International Trademark Registration No. 607983, registered on October 4, 1993
- International Trademark Registration No. 1112690, registered on November 22, 2011

specifying goods in multiple classes.

The Complainant registered numerous domain names worldwide consisting or comprising the word BERLUTI, including, inter alia, <berluti.com>, registered on January 21, 1998, <berluti.hk>, registered on March 17, 2004, and <berluti.us> registered on April 19, 2002.

The disputed domain name <berlutionline.com> was registered by the Respondent on May 24, 2022, and has been redirected to a website in English language featuring the Complainant's trademarks and images taken from Complainant's official website at "www.berluti.com" and promoting the sale of BERLUTI products.

The Complainant's representative sent a cease and desist letter to the Respondent requesting to immediately cease any use of the disputed domain name and transfer it to Complainant. The Respondent did not reply to Complainant's request.

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.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that:

- the disputed domain name incorporates the Complainant's trademark BERLUTI in its entirety and should therefore be considered confusingly similar to the Complainant's trademark;
- the fact that the disputed domain name differs from Complainant's trademark by the addition of the non-distinctive element "online" does not prevent a finding of confusing similarity under the first element;
- the addition of the generic Top Level Domain ".com" is merely instrumental to the use of Internet and shall thus be disregarded in the assessment of confusing similarity.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademark BERLUTI;
- the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name;
- the Complainant is not in possession of, nor aware of the existence of any evidence demonstrating that Respondent might be commonly known by a name corresponding to the disputed domain name as an individual, business, or other organization;

- the Respondent has not provided the Complainant with any evidence of use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before or after any notice of the dispute herein;
- there is no evidence that the Respondent might have used the disputed domain name in connection with a legitimate non-commercial or fair use of the disputed domain name;
- the disputed domain name has been redirected by the Respondent to a website displaying the Complainant's trademarks and images taken from Complainant's website, and offering for sale prima facie counterfeit BERLUTI products, without providing any disclaimer as to the Respondent's lack of relationship with Complainant;
- the lack of complete and reliable information about the entity operating the Respondent's website supports the conclusion that the Respondent has engaged in the sale of counterfeit goods.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Complainant's trademark has been extensively used for over 120 years in connection with the Complainant's advertising and sales of BERLUTI products worldwide;
- the Respondent could therefore not have possibly ignored the existence of the Complainant's trademark;
- it is inconceivable that the Respondent was not well aware of the Complainant's trademarks rights at the time of the registration of the disputed domain name;
- the use of the disputed domain name in connection with a website displaying the Complainant's trademark and images taken from the Complainant's official website and offering for sale purported BERLUTI products at discounted price indicates that the Respondent's purpose in registering and using the domain name was to intentionally attempt to attract Internet users seeking the Complainant's branded products to the corresponding website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website;
- 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;
- the Respondent did not reply to the Complainant's cease and desist letter and subsequent reminders sent to its attention;
- the Respondent has provided inaccurate contact information both in the Whois records of the disputed domain name and on the correspondent website.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (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 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.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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

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.

Based on the record the Respondent undisputedly used the disputed domain name for a website offering purported counterfeits of the Complainant’s BERLUTI products, without any disclaimer. Although Panels are generally not prepared to accept merely conclusory or wholly unsupported allegations of illegal activity, including counterfeiting, the Panel notes that in this case, the goods are purportedly offered at substantially discounted prices and the website at the disputed domain name displays the Complainant’s trademarks and images taken from the Complainant’s website. [WIPO Overview 3.0](#), section 2.13.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: sale of counterfeit goods can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 Complainant provided evidence of multiple trademark registrations for the BERLUTI mark that predate the registration of the disputed domain name.

In light of the extensive use of the Complainant's BERLUTI trademark and the fact that the disputed domain name resolves to a website that offers purported counterfeit products of the Complainant's, the Panel has no doubt that the Respondent was aware of the Complainant and the Complainant's trademark rights when registering the disputed domain name.

The Panel therefore concludes that the Respondent registered the disputed 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.

Based on the record, the Respondent registered this disputed domain name with the bad faith intent to deceive consumers with its products, that given the unclear origin, the lack of any clear disclaimer and false suggestions of affiliation on the website at the disputed domain name and given the heavily discounted product prices, it is very likely that they are counterfeit products.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: sale of counterfeit goods constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

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 <berlutionline.com> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: March 29, 2024