

ADMINISTRATIVE PANEL DECISION

R.C. Trademarks S.r.l., Giovanni Caldarelli, Essedi S.p.A. v. Zhang Qiang
Case No. D2024-0809

1. The Parties

The Complainants are R.C. Trademarks S.r.l., Italy, Giovanni Caldarelli, Italy, and Essedi S.p.A., Italy, represented by Spheriens Avvocati, Italy.

The Respondent is Zhang Qiang, China.

2. The Domain Name and Registrar

The disputed domain name <antonymoratosouthafrica.com> is registered with Paknic (Private) Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 22, 2024. On February 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 24, 2024, 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 (Web Domains By Proxy) and contact information in the Complaint. The Center sent an email communication to the Complainants on February 26, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on February 29, 2024.

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 February 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 21, 2024.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on March 25, 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 Complainants are Essedi S.p.A., Giovanni Caldarelli, and R.C. Trademarks S.r.l. (hereinafter “the Complainant” considering all of them are owners of intellectual property rights concerning the sign “Antony Morato” in different jurisdictions and have a common interest in obtaining the transfer of the disputed domain name). The Complainant is dedicated to producing fashion clothes under the mark ANTONY MORATO. The Complainant business was founded in 2007 by Lello Caldarelli, the company’s creative director and president.

According to the Complaint, the Complainant products under the ANTONY MORATO trademark are distributed in 60 countries, through a network of more than 1,600 multi-brand retailers. The Complainant has also 61 brand stores in 11 countries, covering four continents (Europe, Asia, Africa and the Americas) and a yearly turnover of EUR 74 million in 2022. The Complaint notes that there are two “Antony Morato” stores in South Africa.

The Complainant is the owner of the trademark ANTONY MORATO registered in many jurisdictions, among which are:

- European Union trademark registration No. 005231444, ANTONY MORATO, filed on July 31, 2006, and registered on July 5, 2007, in classes 3, 9, 18, and 25;
- Italian trademark registration No. 302007901555295, ANTONY MORATO, filed on September 12, 2007, and registered on October 16, 2007, in classes 3, 9, 18, and 25;
- International Registration No. 950721, ANTONY MORATO, filed and registered on October 16, 2007, in classes 3, 9, 18, and 25;
- South Africa trademark registration Nos. 2007/20986 in class 3, 2007/20988 in class 18, 2007/20989 in class 25 for ANTONY MORATO, registered respectively on September 13, 2020 and both on July 9, 2010.

The Complainant operates under the domain name <antonymorato.com>.

The disputed domain name was registered on June 26, 2023, and resolves to a website that purports to offer clothes using the Complainant’s trademarks and logo without its authorization.

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

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which 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 was 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 with the addition of the geographical term "southafrica". 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, like the geographical term "southafrica" may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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.

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 Panel notes that the disputed domain name reproduces the Complainant's trademark in its entirety added by the term "southafrica", a geographical region where the Complainant has two stores. In addition, the disputed domain name resolves to a website allegedly offering clothes bearing the Complainant mark without its authorization. In view of all of these circumstances, the Panel finds that the Respondent is using

the disputed domain name to impersonate the Complainant. Panels have held that the use of a domain name for illegal activity such as impersonation/passing off 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 Panel notes that:

- The Complainant has been operating in the market since the year 2007 and is currently present in four continents, while the disputed domain name was only registered on June 26, 2023.
- The disputed domain name reproduces the Complainant's ANTONY MORATO trademark in its entirety. According to the Complaint, the trademark ANTONY MORATO is "unique in the sense that there are no other identical or similar marks or names which are registered or in use by third parties".
- The Panel visited the disputed domain name and was able to verify that it resolves to a website that purports to offer for sale clothing items and looks like a website of the Complainant with no disclaimer or clarifications of any kind. In particular, the disputed domain name uses the ANTONY MORATO trademarks of the Complainant, prominently in several parts of the website, without authorization.

Panels have held that the use of a domain name for illegal activity like impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel concludes that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

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, <antonymoratosouthafrica.com>, be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: March 28, 2024