

ADMINISTRATIVE PANEL DECISION

Save The Duck S.p.a. v. Client Care, Web Commerce Communications Limited

Case No. D2024-0984

1. The Parties

The Complainant is Save The Duck S.p.a., Italy, represented by Studio Legale de Vietro, Italy.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <savetheduckitalia.com> and <savetheduckuk.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 5, 2024. On March 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 8, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (not identified) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 11, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 13, 2024.¹

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 March 15, 2024. In accordance with the Rules, paragraph

¹The Complainant removed one domain name from the proceeding upon receipt of the Center’s email regarding the multiple underlying registrants.

5, the due date for Response was April 4, 2024. On March 15, 2024, the Center received an email from the Respondent, however, the Respondent did not file any formal response. On March 18 and 23, 2024, the Complainant sent two emails to the Center requesting addition of the domain name <alessioforconi.com> to the proceeding. The Center notified the commencement of panel appointment process on April 5, 2024.

The Center appointed Jeremy Speres as the sole panelist in this matter on April 12, 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.

On April 16, 2024, the Panel issued Procedural Order No. 1. On April 21, 2024, the Complainant responded to Procedural Order No. 1. The Respondent did not respond to Procedural Order No. 1.

4. Factual Background

The Complainant, trading under its SAVE THE DUCK mark, is an Italian clothing company emphasizing the protection of animals and the environment. The Complainant's mark is registered in numerous jurisdictions, including European Union Trade Mark Registration No. 011333465 SAVE THE DUCK and device in class 25, with a registration date of March 25, 2013. The Complainant's primary website is available at "www.savetheduck.com".

The disputed domain names were both registered on October 18, 2023. The disputed domain name <savetheduckuk.com> resolves to a website offering clothing for sale, featuring imagery and product descriptions sourced from the Complainant's website, in addition to the Complainant's SAVE THE DUCK logo (in the form registered by the Complainant). The disputed domain name <savetheduckitalia.com> does not currently resolve to a website, but the Complainant's evidence establishes that it previously resolved to a website that was identical to that described above for the disputed domain name <savetheduckuk.com>, albeit in Italian.

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 contends that the disputed domain names were registered and used in bad faith to impersonate the Complainant's SAVE THE DUCK offering for the Respondent's commercial gain.

B. Respondent

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

6. Discussion and Findings

A. Preliminary Issue - Addition of Domain Name Following Complaint Notification

The Complainant requested the addition of the domain name <alessioforconi.com> to the Complaint after the Complaint had been notified (the "Additional Domain Name").

The Panel declines this request on the basis that the Complainant has provided no details concerning any trademark rights that the Complainant may have that meet the requirements of the Policy, paragraph 4(a)(i), in relation to the Additional Domain Name.

The Complainant relies on section 1.15 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") to argue that because the website of the Additional Domain Name clearly targets the Complainant, the Additional Domain Name should be found confusingly similar to the Complainant's trademarks under the first element.

However, as section 1.15 of the [WIPO Overview 3.0](#) makes clear, the content of the website, if relevant, has been cited by prior panels to confirm confusing similarity, not to found it altogether in the absence of any similarities of the domain name with the complainant's mark. The test remains a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

B. 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.

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, minus the design elements, is reproduced within the disputed domain names. To the extent that the design elements of the Complainant's mark are incapable of representation in domain names, these elements are generally disregarded for purposes of assessing identity or confusing similarity. [WIPO Overview 3.0](#), section 1.10. Accordingly, the disputed domain names are 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 "uk" and "italia", 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 names 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.

C. 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 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 general impression created by the websites to which the disputed domain names have resolved is one of impersonation of the Complainant. UDRP panels have categorically held that the use of a domain name for illegal activity (here impersonation) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#) at section 2.13.1. To the extent that the disputed domain names' websites might be

considered those of a reseller of the Complainant's products, they do not meet the requirements of the well-known "Oki Data" test given that the site does not accurately and prominently disclose the Respondent's relationship with the Complainant. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); and [WIPO Overview 3.0](#) at section 2.8.

The Panel finds the second element of the Policy has been established.

D. 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.

Panels have held that the use of a domain name for illegal activity, here impersonation, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Considering the indicators of impersonation apparent on the Respondent's websites, highlighted in the Factual Background section above, it is clear that the Respondent intended to impersonate the Complainant. The composition of the disputed domain names, featuring the Complainant's mark plus the geographic terms "uk" and "italia", strengthens this conclusion. [WIPO Overview 3.0](#) at section 3.2.1. Paragraph 4(b)(iv) of the Policy is thus eminently applicable.

The Panel draws an adverse inference from the Respondent's failure to take part in the present proceeding where an explanation is certainly called for. [WIPO Overview 3.0](#) at section 4.3.

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 <savetheduckitalia.com> and <savetheduckuk.com> be transferred to the Complainant.

/Jeremy Speres/

Jeremy Speres

Sole Panelist

Date: April 27, 2024