

ADMINISTRATIVE PANEL DECISION

Sardegna resorts S.r.l. – società unipersonale v. Kim Hyeonsuk
Case No. D2024-1317

1. The Parties

The Complainant is Sardegna resorts S.r.l. – società unipersonale, Italy, represented by GriffeShield S.r.l., Italy.

The Respondent is Kim Hyeonsuk, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <romazzino.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 27, 2024. On March 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 28, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 3, 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 April 5, 2024. The Respondent sent email communications to the Center on April 3, 4, and 10, 2024, including a request for the documents to be sent in Korean language. The Center sent an email regarding the language of the proceeding on April 10, 2024, with reference to paragraph 11(a) of the Rules.

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 April 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 30, 2024. The Respondent did not submit any formal response.

Accordingly, the Center sent the Commencement of Panel Appointment Process on May 7, 2024.

The Center appointed Ian Lowe as the sole panelist in this matter on May 10, 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.

In light of the email from the Respondent to the Center requesting documents to be sent in the Korean language, the Panel issued a Procedural Order on May 31, 2024. This gave the Respondent the opportunity 1) to use a publicly available machine-translation tool to translate Section VI Factual and Legal Grounds of the Complaint into Korean; and 2) provide comments in English on the matters raised by June 5, 2024, again using machine translation from a draft in Korean if necessary. The Respondent did not submit any response to the Procedural Order.

4. Factual Background

The Complainant is an Italian subsidiary company of Smeralda Holding Group, owned by Qatar's sovereign wealth fund, Qatar Investments Authority. The Complainant's core business is the management of hotels, restaurants and bars, as well as commercial establishments such as golf clubs. In addition, it is active in the purchase, construction, sale and lease of property and real estate. The Complainant is the owner of a number of luxury hotels, including Hotel Romazzino, one of the most exclusive hotels in Sardinia. This is set along Romazzino Beach in the Romazzino region of the Province of Sassari, Sardinia. The hotel was designed in 1965 and further expanded between 2011 and 2013. Since February 2023, it has been managed by Belmond, part of the luxury group LVMH. The Complainant owns several domain names including <romazzinohotel.com> (created on May 28, 2004).

The Complainant is the owner of a number of registered trademarks comprising ROMAZZINO including Italy trademark number 1261118 HOTEL ROMAZZINO registered on March 15, 2010, European Union trademark number 013463666 HOTEL ROMAZZINO registered on June 25, 2015, and the comparable United Kingdom trademark number 913463666, created following the United Kingdom's exit from the European Union, and also treated as registered on June 25, 2015. The Complainant also claims to be the owner of Italy trademark number 580607 HOTELS ROMAZZINO registered on November 17, 1992 in the name of Costa Smeralda Hotels.

The Domain Name was registered on March 16, 2005. It currently resolves to a blank web page, but at the time of preparation of the Complaint it resolved to a Sedo parking page comprising links to web pages of pay-per-click links to the websites of third parties including competitors of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to its HOTEL ROMAZZINO trademark, that the Respondent has no rights or legitimate interests in respect of the Domain Name, and that the Respondent registered and is using the Domain Name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. In particular, the Complainant relies on the following:

- a) HOTEL ROMAZZINO is such a famous trademark that it would be disingenuous for the Complainant to claim that it was unaware that the registration of the Domain Name would violate the Complainant's rights;
- b) shortly after the Domain Name was registered the Domain Name resolved to a web page indicating that the Domain Name was for sale;
- c) the Domain Name has not been used for an active website;
- d) the Domain Name has more recently been used for pay-per-click links;

- e) the Respondent has been the unsuccessful respondent in two previous UDRP complaints involving well-known trademarks.

B. Respondent

The Respondent did not reply formally to the Complainant's contentions. On April 3, 2024, the Respondent sent an email to the Center with alternative contact details and on April 4, a further email asking that the documents be sent in the Korean language. The Center responded (in English and Korean) by pointing out that the Registration Agreement of the Domain Name was in English and that, pursuant to paragraph 11(a) of the Rules, the language and communications of the proceedings would be in English, subject to the discretion of the Panel. As stated above, the Panel issued a Procedural Order on May 31, 2024 reminding the Respondent of the option to use publicly available machine translation tools to translate key parts of the Complaint into the Korean language and giving the Respondent the opportunity of further time to provide comments in English. However, the Respondent did not reply to the Procedural Order.

6. Discussion and Findings

6.1. Language of the Proceedings

Paragraph 11(a) of the Rules provides that: "Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

As indicated above, the language of the Registration Agreement is English. Save for the request (in English) in the email of April 4, 2024 for the documents to be provided to the Respondent in the Korean language, there have been no further submissions by the Respondent as to the language of the proceedings. There is no agreement on the part of the Complainant to the language of the proceedings being other than as provided for in the Registration Agreement.

In the circumstances, the Panel sees no reason to exercise its discretion and confirms that the language of these administrative proceedings shall be English.

6.2. Substantive Issues

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name the Complainant must prove that:

- (i) the 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 Domain Name; and
- (iii) the 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 uncontested rights in the trademark HOTEL ROMAZZINO, both by virtue of its trademark registrations and as a result of the goodwill and reputation acquired through use by the Complainant of the mark over a number of years. Ignoring the generic Top-Level Domain ("gTLD") ".com",

the Domain Name comprises the Complainant's mark without the word "hotel". In the Panel's view, this does not prevent a finding of confusing similarity between the Domain Name and the Complainant's mark for the purposes of the first element under the Policy. Accordingly, the Panel finds that the Domain Name is confusingly similar to a mark in which the Complainant has rights.

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. Accordingly, 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.

The Panel considers that the Complainant has made out a prima facie case that the Respondent could have no rights or legitimate interests in respect of the Domain Name. The Respondent has not used it for a bona fide offering of goods or services. There is no question of the Respondent being known by the Domain Name. The Panel notes that "romazzinu" (or possibly also "romazzino") means "rosemary" in the Gallurese dialect spoken in Sardinia, that "Romazzino" is the name of the bay and beach in Sardinia where the Complainant's hotel is well-established, as well as the small surrounding region, but in any event, there has been no submission by the Respondent explaining or justifying the registration of the Domain Name.

Having reviewed the available evidence, the Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the 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 Domain Name such as those enumerated in the Policy or otherwise.

Accordingly, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel considers the issue of bad faith finely balanced. Although there has been no formal response to the Complaint, the Complainant must nevertheless prove its case.

The Domain Name was first registered on March 16, 2005, some 19 years ago, and while there are certain elements pointing towards the possibility of the Respondent's acquisition of the Domain Name occurring at a later stage, the Panel notes such later acquisition would not have altered the Panel's conclusion. The Complainant has produced evidence from the Internet Archive that shortly after registration the Domain Name was offered for sale without a price being mentioned.

More recently, perhaps from around 2021, the Domain Name has led to pay-per-click links generated by the association of the term "Romazzino" with the Complainant's apparently very well-known hotel in Sardinia. This is not surprising since a search through Google produces in the first 50 odd search results, using a United Kingdom based browser, references only to the Complainant's Hotel Romazzino, save for two references to an Italian restaurant named Romazzino in Nantwich, England. A United States of America proxy server again produces search results with all but two of the first 50 odd results referring to the hotel.

Panels have generally accepted that to find registration in bad faith they must be satisfied either that the respondent had the complainant and its rights in a relevant mark in mind at the time of registration or that at least the respondent should have been aware of the complainant's mark. In this case, the Complainant's case would have benefitted from further evidence as to the notoriety of its HOTEL ROMAZZINO mark at the time of registration of the Domain Name such as for example the hotel's turnover prior to 2005, the number of guests it typically received at that time, the extent of its Internet footprint and/or advertising, media coverage, or even the nationality of its guests.

By the time of registration of the Domain Name, the Complainant's hotel had been established for many years.

The Complainant's evidence is that the selection of "Romazzino" as a Domain Name is most likely to be taken to be a reference to the hotel. The Panel notes that the Respondent, based in Korea, has failed to advance any evidence as to how or why it came to register the Domain Name, despite being given a further opportunity to make submissions by the Procedural Order. However, the Domain Name is not only the name of a well-established hotel, but is also the name of a small region in Sardinia and its largest bay and beach.

The Panel does take into account the Respondent's albeit limited history of registering domain names comprising well-known marks (see Volkswagen Group of America, Inc. v. Kim Hyeonsuk a.k.a. Kim H. Suk, Domain Bar, Young N. and Kang M.N., WIPO Case No. [D2014-1596](#), involving <audiplus.com>, <auditex.com>, <ducatisti.com>, <golfiv.com>, <gsgolf.com>, <tsgolf.com>, <vwmania.com> and <vwservice.com>).

However, finely balanced as matters are, the Panel is not satisfied that the Complainant has proven that the Respondent is more likely than not to have had in mind the Complainant and its rights in the HOTEL ROMAZZINO mark when it registered the Domain Name. The Panel is not satisfied on the evidence put forward by the Complainant that the Respondent's aim in registering the Domain Name was to profit from or exploit the Complainant's trademark; given that it is also a geographic area and dictionary term (and putting aside the question of when it was acquired), this would have required a substantial fact-based showing on the Complainant's part.

The Panel recognizes that even though the pay-per-click links to third party websites produced by the Domain Name were likely to have been generated automatically, panels have found that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name. [WIPO Overview 3.0](#), section 3.5. However, even if such activity were to be taken to amount to use in bad faith, that is not in itself enough to satisfy the Complainant's overall burden in this proceeding.

The Panel finds the third element of the Policy has not been established.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Ian Lowe/

Ian Lowe

Sole Panelist

Date: June 22, 2024