

ADMINISTRATIVE PANEL DECISION

Corneliani S.p.A. v. Noah Chapman
Case No. D2024-1594

1. The Parties

The Complainant is Corneliani S.p.A., Italy, represented by Società Italiana Brevetti S.p.A., Italy.

The Respondent is Noah Chapman, Germany.

2. The Domain Name and Registrar

The disputed domain name <cornelianijapan.com> is 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 April 16, 2024. On April 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 19, 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 (individual, Alibaba.com Singapore E-commerce Private Ltd.) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 19, 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 22, 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 April 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 16, 2024.

The Center appointed Andrew F. Christie as the sole panelist in this matter on May 23, 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 an Italian company in the fashion industry, founded in the 1930s in Mantua. The period from the 1970s to 2010 saw the company consolidate into a larger production plant (1974), open its own headquarters in the United States of America ("United States") (1985), and win a number of awards.

The Complainant owns a number of registrations for the word trademark CORNELIANI, including European Union Trademark No. 000123323 (filed April 1, 1996; registered March 22, 1999), International Trademark No. 452894 (registered June 18, 1980), and Japan Trademark No. 4850865 (filed December 12, 2003; registered March 25, 2005). The Complainant also is the registrant of the domain name <corneliani.com>.

The disputed domain name was registered on August 15, 2023. The Complainant has provided screenshots, taken on April 11 and 12, 2024, showing the disputed domain name resolved to a website displaying the Complainant's trademark and various of the Complainant's products, and purporting to offer in Japanese the Complainant's products for sale. As of the date of this decision, the disputed domain name resolves to a website that appears to be the same as the website shown in the Complainant's screenshots.

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.

The Complainant contends that the disputed domain name is confusingly similar to a trademark in which it has rights on the following grounds, among others. The disputed domain name is composed of the exact reproduction of its CORNELIANI trademark, to which has been added the geographical term "japan". A domain name consisting of a trademark and a descriptive or geographical term is viewed as confusingly similar to a complainant's trademark where the relevant trademark is recognizable within the disputed domain name. When confronted with the disputed domain name, Internet users and consumers will inevitably focus their attention on the term CORNELIANI and immediately associate it with the Complainant's identical trademark.

The Complainant contends that the Respondent does not have any rights or legitimate interests in the disputed domain name on the following grounds, among others. The Complainant has not authorized or given its consent to the Respondent to register or use the disputed domain name. The Respondent is not making a fair use of the disputed domain name since the disputed domain name points to a website reproducing the trademark and the products of the Complainant, and offering for sale the products of the Complainant, without the Complainant's authorization.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith on the following grounds, among others. At the time of the Respondent's registration of the disputed domain name, the Complainant's business and CORNELIANI trademark were well established. It is clear that the Respondent knew or should have known about the existence of the Complainant's trademark. The disputed domain name exploits the reputation of the Complainant's trademark. The disputed domain name resolves to a scam website, which reproduces the Complainant's official website, and which has been created by the Respondent primarily for the purpose of disrupting the business of a competitor. By using the disputed domain name, 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 trademark 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.

B. Respondent

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

6. Discussion and Findings

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. It is the owner a number of trademark registrations for the word trademark CORNELIANI.

The entirety of the Complainant's trademark is reproduced within the disputed domain name, succeeded by the word "japan". Although the addition of other terms may bear on assessment of the second and third elements, the Panel finds the addition of the word "japan" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the Complainant's trademark is recognizable 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.

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 considers that the composition of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1. Also, the evidence establishes that the Respondent has used the disputed domain name to resolve to a website which seeks to impersonate the Complainant by reproducing the Complainant's trademark and products. Panels have held that the use of a domain name for illegal activity such as impersonation 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: (i) the Respondent registered the disputed domain name more than four decades after the Complainant first registered its CORNELIANI trademark; (ii) the disputed domain name incorporates the Complainant's trademark in its entirety, and merely adds the name of a country (in this case, Japan) which is one in which the Complainant has registered and uses its trademark; and (iii) the Respondent used the disputed domain name to resolve to a website falsely giving the impression it is associated with the Complainant. It is clear the Respondent registered the disputed domain name with knowledge of the Complainant's trademark.

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.

The evidence shows that the Respondent has used the disputed domain name in an intentional attempted to attract, for commercial gain, Internet users to a website by creating a likelihood of confusion with the Complainant's trademark. 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 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 <cornelianijapan.com> be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: June 10, 2024