

## **ADMINISTRATIVE PANEL DECISION**

**INVESTINDUSTRY SRL v. Kwangpyo Kim, Mediablue Inc**  
**Case No. D2024-2224**

### **1. The Parties**

The Complainant is INVESTINDUSTRY SRL, Italy, represented by Bugnion S.p.A., Italy.

The Respondent is Kwangpyo Kim, Mediablue Inc, Republic of Korea.

### **2. The Domain Name and Registrar**

The disputed domain name <araldi.com> (the “disputed domain name”) is registered with GoDaddy Online Services Cayman Islands Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 30, 2024. On May 31, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 1, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 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 June 7, 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 June 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 30, 2024. Further to the Respondent’s request, in accordance with paragraph 5(b) of the Rules, the Center extended the decision due date to July 4, 2024. The Response was filed with the Center on July 4, 2024.

On July 10, 2024, the Complainant submitted a supplemental filing.

On July 13, the Respondent submitted a supplemental filing.

The Center appointed Andrew D. S. Lothian, Nicholas Weston, and Diane Cabell as panelists in this matter on August 13, 2024. The Panel finds that it was properly constituted. Each member of 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 limited company (Società a responsabilità limitata).

On or about September 12, 2023, the Complainant acquired the trademark ARALDI 1930 HAND MADE IN ITALY, registered in various jurisdictions, at judicial auction arising from the insolvency of W.A. Group S.r.l., a company formed by the merger on October 12, 2016 of Araldi 1930 S.r.l. and William S.r.l. The said merged companies were associated with the Pierpaoli family, which founded an artisan tradition of leatherworking dating back to the end of the 19th century. The said insolvency gave rise to bankruptcy proceedings which opened in 2018 and remain pending.

Among others, the Complainant is the owner of International Registered Trademark Number 1006218 for a device mark consisting of the words ARALDI 1930 HAND MADE IN ITALY in a stylized typeface and arranged into a composition in the shape of an ellipse where the word "ARALDI" is slightly concave and forms the top of the ellipse, the numerals "1930" form the middle of the ellipse, and the words "HAND MADE IN ITALY" are slightly convex and form the bottom of the ellipse, registered on March 31, 2009 in Classes 18 and 25, and designated in respect of Japan and China.

Araldi 1930 S.r.l. (one of the two constituent entities that merged to form W.A. Group S.r.l.) is the listed owner of Republic of Korea Registered Trademark Number 4011883910000 for the mark ARALDI in a stylized typeface, registered on July 5, 2016 in Classes 18 and 25. This mark does not appear to have been acquired by the Complainant in the said judicial auction, insofar as it is not mentioned in the report of the judicial auction dated September 12, 2023. Furthermore, the Panel notes that said trademark is not specifically mentioned in the bankruptcy inventory in respect of W.A. Group S.r.l.

The Curator's appraisal report to the Italian Court in respect of the said insolvency notes that the mark ARALDI 1930 HAND MADE IN ITALY is present on the market in the Republic of Korea in respect of belts, bags and small leather goods with a price point that is about 30 per cent lower than luxury brands. An independent press article dated September 24, 2013, noted that the Complainant's predecessor in interest was increasingly turning its attention abroad, with two new stores of 80 to 150 square meters planned to open in Seoul, Republic of Korea, among others elsewhere. The evidence does not show whether the planned stores were opened.

The disputed domain name was registered on May 9, 2000. Historic Whois entries show that the disputed domain name was registered in the name of the son of the founder of the Complainant's trademark and executive director of the corresponding family companies (and in the name of one of said companies) between at least May 9, 2008 and February 22, 2020. Archived website entries show that the disputed domain name was used to represent the Complainant's predecessor in interest, including in connection with the sale and advertisement of leather fashion products from March 2002.

The Respondent is an investor in domain names. It acquired the disputed domain name in an expired domain name auction on June 20, 2020 for the sum of USD 449.

According to screenshots produced by the Complainant dated January 8, 2024, the disputed domain name was pointed at that date to a website including various Pay-Per-Click ("PPC") links, some of which related to the business of the Complainant, namely links that redirect to websites promoting the sale of clothing, bags and accessories. Later screenshots also taken by the Complainant did not appear to show this pattern,

featuring a variety of links relating to DNA origins testing, airline tickets, CAD and graphic design software, and the auction website “www.ebay.it”. The disputed domain name is also offered for sale on a website provided by the Registrar subject to a minimum offer level of USD 58,500.

While each case must be taken on its own merits, the Respondent has been the respondent in at least 16 previous cases under the Policy. It has been successful in the majority of these, while in five cases, transfer of the domain name concerned was ordered. In three of such transfer cases, namely *Deutsche Lufthansa AG v. Whois Privacy Services Pty Ltd / Mediablue Inc, Kwangpyo Kim*, WIPO Case No. [D2013-1844](#), and *Administracion Nacional de Telecomunicaciones (Antel) v. Privacydotlink Customer 3691928/Kwangpyo Kim, MEDIABLUE INC*, WIPO Case No. [D2020-1212](#), and *High Scope Educational Research Foundation v. Kwangpyo Kim / Mediablue inc*, Forum Claim No. FA2108001960035, the Respondent was found to have used the domain names concerned in connection with PPC advertising which targeted the business of the complainant. In those cases involving PPC links where the Respondent was successful, the panel typically found that the PPC links concerned did not target the complainant’s business, see for example, *Rolyn Companies Inc. v. Mediablue Inc.*, WIPO Case No. [D2018-0072](#), in which the Respondent similarly claimed that it acquired the domain name concerned because it was a valuable first or last name, and in which it had pointed the domain name to PPC relative to the surname value of the term. The panel in that case determined that the PPC links (categorized as “Baby or Infant” naming, “First Names” and “Genealogy”) amounted to “negative keywords” negating the complainant’s assertion of targeting.

## **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 most dominant and distinctive element of the Complainant’s trademark is the word ARALDI, while asserting that the elements 1930 HAND MADE IN ITALY have a descriptive character, and cannot be considered sufficient to exclude similarity to the disputed domain name.

The Complainant asserts that the Respondent is not affiliated with the Complainant, nor has been authorized to register or use any domain name incorporating the Complainant’s mark, adding that it does not know the Respondent, nor does it hold any contractual or commercial relationship, or license agreement, with it. The Complainant notes that its searches did not disclose any trademark rights or legitimate business activities in or under the Respondent’s name.

The Complainant notes that the disputed domain name is used in connection with sponsored links, some of which reference clothing and accessories, and submits that the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name. The Complainant adds that the Respondent has not made any bona fide offering of goods or services via the disputed domain name, and has not been commonly known thereby.

The Complainant contends with reference to the third party article, the Curator’s valuation report, and the information available online regarding the insolvency that its trademark has enjoyed a degree of recognition among the public, adding that it is unlikely that the Respondent was not aware of the existence of said mark, including in the Republic of Korea, before the Respondent registered the disputed domain name. The Complainant speculates that the disputed domain name was acquired during the bankruptcy processes relating to its predecessor in interest from 2018. The Complainant contends that it was the Respondent’s responsibility when it acquired the disputed domain name to ascertain that it did not infringe third party rights, adding that in other cases in which the Respondent has been respondent, it has stated that it is involved in the business of buying and selling domain names, whereby it has a more positive obligation to avoid the registration and use of a domain name which could result in a violation of the Policy.

The Complainant notes that a Google search for “araldi” produces references to the Complainant among the first results, adding that the Complainant’s trademarks are easily detected on the relevant databases. The Complainant states that the disputed domain name is available for sale at a minimum bid price of USD 58,500, concluding that it was acquired by the Respondent primarily for the purpose of selling it to the owner of the said trademark for valuable consideration exceeding the Respondent’s related out of pocket costs. The Complainant contends that there is no reason that the asking price is so high other than to speculate on a domain name containing the trademark of a third party.

## **B. Respondent**

The Respondent contends that the Complainant has not satisfied the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Respondent asserts it purchased the disputed domain name at auction on June 20, 2020 while the former registrant of some four years’ standing was in the process of bankruptcy and had allowed it to expire. The Respondent asserts that it had no knowledge of the Complainant until it filed the Complaint, adding that it acquired the disputed domain name because it believed this to represent a valuable first or last name and “aged domain” to which it believed that no party had exclusive rights, further asserting that it has used the disputed domain name in connection with PPC links in good faith and without any targeting of the Complainant.

The Respondent asserts that it operated in the Republic of Korea when the disputed domain name was registered and has continually operated there since then, having never lived in Italy or anywhere in Europe. The Respondent denies that it registered the disputed domain name to sell it to the Complainant or to confuse consumers looking for the Complainant’s website. The Respondent submits that it is a domain name investor which registers commercially valuable easy to remember descriptive common words, three or four letters domain names, or those representing first or last names, having registered hundreds of these since 2002. The Complainant lists some 28 domain names which it says it has registered representing words and last names.

The Respondent asserts that “over the past decade” it has hosted the disputed domain name with many different domain name parking services that have displayed shared revenue PPC advertisements powered by their software, and based on the provider’s search algorithm and generic links, adding that the Respondent did not select those links with intent to profit from the Complainant’s trademark. The Respondent asserts that it did not have any links related to the Complainant or its business on the website associated with the disputed domain name, adding that the links relate to “common general business”, and that “Araldi” is used as a first or last name in Italy, Europe, and the United States of America. The Respondent lists the links published as “Qbo online”, “Email Blast Services”, “Masters Marriage Family Therapy”, “Tiktok for Business”, and “Best Dna Test for health”. The Respondent submits that the website associated with the disputed domain name has been generally guided to well-known websites “www.ebay.com” and “www.etsy.com”, and that keywords related to the Complainant were typed into the parking screen search box in order to achieve the Complainant’s screenshots.

The Respondent notes that there are ample historical records of the use of the name “Araldi” as a first or last name on an ancestry website, multiple third party Twitter users with this name as a handle, and examples of the use of the name in both a male and female context available from a Google search. The Respondent adds that the sale of domain names containing a first name is well documented, with a price range of between USD 500 and USD 310,250, while in the case of last names, the range is USD 911 to in excess of USD 100,000.

The Respondent accepts the validity of the Complainant’s trademarks while asserting that it did not act in bad faith or target the Complainant. The Respondent asserts that the descriptive use of the term “Araldi” should be found to be legitimate, adding that the use of a descriptive term in a domain name to attract Internet traffic without intending to take advantage of a complainant’s rights in that term may give rise to rights or legitimate interests under the Policy according to previous cases. The Respondent submits that if

there is any doubt that the Respondent registered the disputed domain name solely based upon its descriptive nature, the Panel should consider the Respondent's other non-trademark descriptive word domain names, adding that the only reasonable inference arising from such pattern is that the Respondent does not target trademarks. The Respondent asserts that its legitimate interest is bolstered by its use of PPC links which relate to "common general business", which use is not illegitimate.

The Respondent notes that the Complainant's trademark rights are dead/cancelled in the United States of America, adding that third parties have applied to register the term "Araldi" as a trademark. The Respondent repeats that it registered the disputed domain name because it incorporated a first or last name, adding that it is not a cybersquatter looking for trademarks upon which to prey, and noting that it has likewise purchased such domain names when they were available or offered for sale by their prior owner. The Respondent notes that previous cases under the Policy have held that the expiration of a domain name raises the presumption that any trademark rights in such domain name have been abandoned, signaling to prospective registrants that it is available and can be registered in good faith. The Respondent submits that bad faith registration cannot be established absent specific proof of intent to profit from the Complainant's mark.

The Respondent states that there is no logic to the allegation that the Respondent targeted the Complainant when it purchased the disputed domain name as the disputed domain name was deleted after four years and offered for re-registration. The Respondent states that the lack of advertisements targeting the Complainant's goods or services suggest that the Respondent did not intend to confuse Internet users into thinking that Complainant was somehow associated with the Respondent's website. The Respondent argues that it is improper and misleading of the Complainant to indicate the presence of allegedly infringing links on the website associated with the disputed domain name by running a specific search for the term "Araldi", adding that the search function does not target the Complainant, and that the links related to "common general business" provide support for the Respondent's good faith use. The Respondent notes that it has won disputes under the Policy more often than it has lost them.

The Respondent seeks a finding of Reverse Domain Name Hijacking, arguing that there is no basis for the Complaint, and that the Complainant's counsel knew that it could not prove at least two of the three elements under the Policy, before it filed the Complaint. The Respondent asserts that the Complaint amounts to a "Plan B" case where the Policy has been used after the Complainant failed in the marketplace to acquire the disputed domain name.

### **C. Complainant's supplemental filing**

The Complainant submits that it has not attempted to purchase the disputed domain name from the Respondent in the marketplace, adding that it could not have known the identity of the Respondent before filing the Complaint due to the Respondent's use of a privacy service.

The Complainant notes that the evidence provided by the Respondent concerning the value of surname domain names shows that the price increases based upon the number of people bearing such surname, and that when more than 75,000 people bear a surname the price would be approximately USD 61,133. The Complainant submits that "Araldi" is not a common surname, adding that there are only 4,892 people in the world with such name, with the highest density in Italy and Brazil. The Complainant asserts that, based upon the Respondent's methodology, the value of the disputed domain name should be USD 2,326 (or as estimated by GoDaddy, USD 4,316), well short of the minimum offer price set by the Respondent.

The Complainant puts forward four comparable Italian surname domain names of a frequency similar to "Araldi" together with the GoDaddy appraisal price for a corresponding ".com" domain name, namely "Pansini" (3,058 people bearing surname) – USD 3,281, "Azzini" (2,558 people) – USD 2,465, "Pelusi" (3,069 people) – USD 3,490, and "Pinton" (6,215 people) – USD 5,342. The Complainant concludes that there is no reason why the disputed domain name should be valued by the Respondent at USD 58,500. The Complainant suggests that this shows that the disputed domain name was acquired by the Respondent primarily for the purpose of selling it to the Complainant, pointing out that many companies are named after

their founders, and that the practice of buying surname domain names in order to gain an advantageous position over the bearers of the surname should be considered an illegal practice.

With regard to the Respondent's use of PPC links, the Complainant submits that "Araldi" is not a word that is descriptive of any goods and services that may be used for attracting consumers, that the Respondent's PPC links sometimes relates to commercial activities in competition with those for which the Complainant's mark is used, asserting that the disputed domain name has never been used in connection with any descriptive character of the word "Araldi".

With regard to the Respondent being based in the Republic of Korea, the Complainant notes that the ARALDI trademark was registered and used in the Republic of Korea before the Respondent acquired the disputed domain name, adding that it is unlikely that the Respondent was not aware of such earlier mark on the register and in the market. With regard to the Respondent's Google search for "Araldi", the Complainant points out that the second and third result relate to the Complainant's Instagram page and a website selling the Complainant's goods respectively.

With regard to the Respondent's argument that the Complainant's trademarks have been cancelled, the Complainant points out that the Complaint is based upon registered marks that are in force. With regard to the third party ARALDI trademarks identified by the Respondent, the Complainant argues that these are not relevant to the Respondent's rights or legitimate interests in the disputed domain name.

With regard to the fact that the disputed domain name had been allowed to expire, the Complainant submits that the reasons behind expiration can include mistakes or temporary inability to renew despite an interest in the domain name concerned. The Complainant notes that the bankruptcy described in the factual background section was an obstacle to the management of ordinary company activities which caused the disputed domain name to expire.

Finally, the Complainant notes that the fact that there may be other "araldi" domain names registered does not give rise to rights or legitimate interests or good faith on the Respondent's part.

#### **D. Respondent's supplemental filing**

With regard to the Complainant's denial of having attempted to purchase the disputed domain name, the Respondent submits that the Complainant contacted the Respondent through the offer form on the parking page on September 25, 2023.

With regard to the extent of use of the "Araldi" surname, the Respondent argues that its use of the ancestry website is more accurate. The Respondent also argues that even if the surname is not widely used, the value of a corresponding domain name may still be high.

With regard to the argument that "Araldi" is not a descriptive name for goods and services, the Respondent points out that it nevertheless generates PPC advertising for display that is unconnected to the Complainant's mark.

With regard to the fact that the Respondent is based in the Republic of Korea, the Respondent states that the Complainant's trademark is not world-famous or prominent, adding that its method is to check that the disputed domain name is worth its participation in an auction, and noting that it does not check whether the domain name is registered as a trademark in the Republic of Korea if it is a surname.

With regard to the Google "Araldi" search disclosing the Complainant's Instagram account, the Respondent submits that this does not confirm to the Internet user that the term is a trademark, adding that the first line of said search states that the term is a surname.

With regard to the cancellation of the Complainant's trademark, the Respondent stands by its submission, together with the submission that third parties are applying for the ARALDI mark.

With regard to the expiration of the disputed domain name, the Respondent argues that a respondent does not know why a domain name has expired, and is only aware that the owner did not extend the term.

With regard to the fact that there are other “araldi” names in use, the Respondent submits that the other uses affirm that the name is free to use by anyone.

## **6. Discussion and Findings**

### **A. Preliminary Matter: Parties’ Supplemental Filings**

Both of the Parties submitted supplemental filings in this matter.

Paragraph 10 of the Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition. Paragraph 12 of the Rules expressly provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel.

In all such cases, panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some “exceptional” circumstance). WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 4.6.

In the present case, the Panel considers it appropriate to admit the Parties’ supplemental filings. In each case, these address matters that could not reasonably have been anticipated by the party concerned in its filing in chief.

### **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 Panel finds the mark 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 notes in particular that the ARALDI element of the Complainant’s mark is the first and most distinctive element thereof, given that the other elements consist of a year and the description HAND MADE IN ITALY.

The Panel notes that the Respondent accepts the validity of the Complainant’s trademarks.

While the Complainant has established the existence of a trademark registered in the Republic of Korea in respect of ARALDI, it has not established that it is the owner of such mark. Although the existence of such mark may be evidentially relevant to the second or third elements of the Policy, it is not relevant for the purposes of the establishment of the Complainant’s standing in terms of the first element of the Policy.

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 that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name on the basis that the Respondent is not affiliated with the Complainant, the Respondent has not been authorized to use the Complainant’s mark in a domain name, the Respondent does not have any trademark rights nor is commonly known by the disputed domain name, the disputed domain name is being used in association with commercial PPC links (some of which target the Complainant), and the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name.

Consequently, the Panel turns to the Respondent’s submissions and evidence to determine whether it has rebutted such prima facie case. The essence of the Respondent’s case is that it acquired the disputed domain name due to it containing a valuable first or last name based upon Google search results, which it proceeded to monetize on PPC links related to “general business”. While the Google search results produced by the Respondent list the Complainant’s Instagram page in the second item with the legend “[...] Araldi CEO and Creative Director Mr. Luca Pierpaoli shares the secret behind the brand’s success”, the Respondent asserts that that this does not confirm to the Internet user that the term is a trademark. The Respondent did not address the fact that the third item on said Google search is a website selling belts manufactured by the Complainant under the legend “Araldi 1930 Milano Archives”. Insofar as any of the PPC links may have targeted the Complainant, the Respondent’s case appears to be that the Complainant induced this via typing into the parking screen search box on the website concerned.

Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.

Panels have additionally noted that respondent efforts to suppress PPC advertising related to the complainant’s trademark (e.g., through so-called “negative keywords”) can mitigate against an inference of targeting the complainant.

Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant’s (or its competitor’s) trademark. [WIPO Overview 3.0](#), section 2.9.

Here, although surnames are not dictionary words as such, the Panel considers that it would be reasonable to extend the general principle described in the immediately preceding paragraph to include the situation where a domain name consisting of a surname is used to host a page of PPC links genuinely and exclusively related to the surname connotation, such as ancestry services, DNA origin testing, family history websites or the like, and which does not trade off the complainant’s (or its competitor’s) trademark.



As the majority of the Panel sees it, the problem for the Respondent's case is that this is not what it has done. On its own submission, it registered the disputed domain name for its surname value, yet pointed this to links related to "general business". Whether or not the keying of PPC links to this term is directly or indirectly responsible for the links produced, crucially for present purposes, the PPC links on the website associated with the disputed domain name displayed links targeted to the trademark value of the term, being links relating to the Complainant's line of business. The fact that unrelated links were displayed at times does not absolve the Respondent of its responsibility not to target trademarks.

The Respondent asserts that the Complainant has induced the trademark-related PPC results by typing into a search box on the parking page, yet despite the fact that it selected and configured the PPC service itself, it produces no evidence to support this submission. For example, the provider of the PPC links might have been asked to demonstrate, from its log files or otherwise, how such alleged inducement took place. In any event, and more importantly for present purposes, the Panel notes that none of the screenshots of the website associated with the disputed domain name, whether produced by the Complainant or the Respondent, appear to display the presence of any "parking screen search box" that could have been used in this way.

Contrary to the position in those previous cases involving the Respondent in which PPC links were used under restriction to non-trademark connotations (e.g. in the case of a surname, "Baby or Infant naming", "First Names" or "Genealogy"), in the present case the majority of the Panel considers that assigning the parking service to "general business" could not in any way be regarded as the use of "negative keywords" which amount to an attempt to suppress the trademark value of the term. Consequently, there is no evidence that the Respondent took steps actively to prevent trademark targeting, and in the majority of the Panel's view, the keying of PPC links to "general business" is in fact more likely to have produced trademark-related advertisements than not. The Respondent, as a sophisticated domain name investor and user of PPC parking services, may be expected to have known this, not least as the issue has been discussed in previous cases under the Policy in which it has been involved as respondent (see, for example, *Administracion Nacional de Telecomunicaciones (Antel) v. Privacydotlink Customer 3691928/Kwangpyo Kim, MEDIABLUE INC*, WIPO Case No. [D2020-1212](#), in which the panel stated: "To be clear, there is nothing inherently wrong with purchasing and reselling 'brandable' domain names in principle; here however, the Respondent claims this is what he has done but then also has monetized the Domain Name with PPC links targeting the Complainant. He cannot have it both ways.").

In light of the above analysis, the Respondent's use of the disputed domain name in connection with commercial PPC links in this particular case cannot be regarded as a bona fide offering of goods and services.

To the extent that the disputed domain name represents a surname, the Panel observes that it is not the Respondent's own name. Consequently, the Respondent is not commonly known by such name. Nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name.

In these circumstances, the majority of the Panel finds that 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 majority of 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.

In the present case, the Panel notes that the Respondent acquired the disputed domain name at auction and pointed it to a website containing PPC links which at times targeted the trademark meaning of the term. The Respondent also listed the disputed domain name for sale at an amount exceeding its out-of-pocket costs. As discussed in the preceding section, the Respondent's position is that the disputed domain name represents a surname such that no party has exclusive rights in the term, and entitling it to take the actions which it did.

Particularly with respect to "automatically" generated Pay-Per-Click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests).

While a respondent cannot disclaim responsibility for links appearing on the website associated with its domain name, panels have found positive efforts by the respondent to avoid links which target the complainant's mark (e.g., through "negative keywords") to be a mitigating factor in assessing bad faith. [WIPO Overview 3.0](#), section 3.5.

Here, there have been no efforts made to avoid links which target the Complainant's mark. On the contrary, providing PPC links keyed to "general business" in respect of a surname is in the majority of the Panel's view highly likely to give rise to advertisements relating to the trademark value of such surname, and the Respondent as a sophisticated domain investor must have been aware of that fact. Notably, the issue of "negative keywords" was pointed out to the Respondent in certain previous cases under the Policy, both those in which it was found to have used PPC links that targeted a trademark owner, and those where it was found that it did not.

As a sophisticated domain name investor of many years' experience, the Respondent had an affirmative obligation to avoid the registration of trademark-abusive domain names. Panelists will look to the facts of the case to determine whether such respondent has undertaken good faith efforts to screen such registrations against readily-available online databases to avoid the registration of trademark-abusive domain names. [WIPO Overview 3.0](#), section 3.2.3. In this case, the Respondent did not undertake any such reasonable efforts. For example, the Respondent did not consult its local trademark register in the Republic of Korea. Had it done so, it would have seen the ARALDI trademark that is part of the trademark family that includes those now owned by the Complainant. Likewise, although the Respondent produces a Google search to illustrate how it identified the surname value of the term "Araldi", it appears to have overlooked the second and third items on such search that make it clear that the term has trademark value. The Respondent attempts to dismiss the first of these results (the second item on the search) by stating that it is merely an Instagram page, without addressing the fact that such result expressly refers to ARALDI as "the brand". The Respondent does not address the presence of the third item in the search at all, which unequivocally references the Complainant's mark in the description "ARALDI MILANO 1930 Brown Embossed Leather Belt Men Handmade in Italy [...]".

In short, the Respondent's willful blindness to the trademark value of the term, its denial of targeting by way of the PPC links, and its denial of any prior knowledge of the Complainant's mark in the circumstances of the present case gives rise in the majority of the Panel's view to the kind of "credibility gap" on the Respondent's part that was described in *Administracion Nacional de Telecomunicaciones (Antel) v. Privacydotlink Customer 3691928/Kwangpyo Kim, MEDIABLUE INC, supra*. This gap is widened somewhat further when the fact that the disputed domain name was acquired in an expired domain name auction is added into the equation.

The Respondent demonstrates that it is entirely capable of researching the past history of a domain name, by virtue of its evidence entitled "Who owned <araldi.com> in the past". This evidence makes it clear that both Araldi S.r.l. and W.A. Group S.r.l. were previous owners of the disputed domain name listing also the name of the family previously behind the ARALDI mark and brand. Had the Respondent chosen to conduct this research prior to acquiring the disputed domain name, it would also have become aware of the rights of the Complainant's predecessor in interest by that route. As the Panel in *Supermac's (Holdings) Limited v. Domain Administrator, DomainMarket.com*, WIPO Case No. [D2018-0540](#) noted, "Where registration occurs

through drop-catching, the registrant is objectively aware that another person held the registration immediately prior. This, in effect, puts the registrant on notice that another person (the immediately prior registrant) may have rights in a trademark to which the domain name is identical or confusingly similar. Where, as in this case, the drop-catching registrant fails to take any steps to determine if such rights exist, then the registrant is taking the risk that such rights do exist”.

The majority of the Panel concludes on the basis of the above analysis that the disputed domain name was registered and used in bad faith within the meaning of the Policy. The Panel notes that the outcome might have been different had there been no targeting of the Complainant's rights evident in the PPC links and had the Respondent produced evidence demonstrating that it had restricted the advertising categories to the surname connotation of the word, as it did in *Rolyn Companies Inc. v. Mediablue Inc.*, *supra*. However, on this occasion, the Respondent fell short of conducting the most basic screening for third party rights despite being on notice of the importance of doing so, and/or was willfully blind to the same, and assigned the disputed domain name to PPC links which targeted the Complainant's business. The majority of the Panel cannot see such actions as those of a party acting in good faith.

In light of this analysis, it is unnecessary to consider the issue of the disputed domain name having also been offered for sale at an amount exceeding the Respondent's out-of-pocket costs.

The Panel finds that the Complainant has established the third element of the Policy.

#### **E. Reverse Domain Name Hijacking**

In light of its findings above in the Complainant's favor, the Panel need not consider the Respondent's observations relating to Reverse Domain Name Hijacking.

#### **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 <araldi.com> be transferred to the Complainant.

*/Andrew D. S. Lothian/*

**Andrew D. S. Lothian**

Presiding Panelist

*/Nicholas Weston/*

**Nicholas Weston**

Panelist

*/Diane Cabell /*

**Diane Cabell**

Panelist

Date: August 27, 2024