

ADMINISTRATIVE PANEL DECISION

Premiata S.R.L. v. Andrea Denise Dinoia, Puglia.com srls
Case No. D2024-2947

1. The Parties

The Complainant is Premiata S.R.L., Italy, represented by Dr. Modiano & Associati S.p.A., Italy.

The Respondent is Andrea Denise Dinoia, Puglia.com srls, Italy.

2. The Domain Name and Registrar

The disputed domain name <premiata.com> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2024. On July 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. After several communications, on August 6, 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 (“Not available”) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same August 6, 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 August 8, 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 August 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 1, 2024. The Respondent sent two email communications on August 30, 2024 and on September 2, 2024. Accordingly, the Center notified the Commencement of Panel Appointment Process on September 3, 2024.

The Center appointed Edoardo Fano as the sole panelist in this matter on September 9, 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to [the] Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules, and the Supplemental Rules and without the benefit of a formal response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Premiata S.R.L., an Italian company founded in 1885, operating in the field of footwear, and owning several trademark registrations for PREMIATA, among which:

- Italian Trademark Registration No. 0000710288 for PREMIATA, registered on May 16, 1997;
- European Union Trademark Registration No. 0004182236 for PREMIATA, registered on May 2, 2001;
- International Trademark Registration No. 1002682 for PREMIATA, registered on December 19, 2008;
- Italian Trademark Registration No. 0001449889 for PREMIATA, registered on May 17, 2011.

The Complainant also operates on the Internet, its main website being "www.premiata.it".

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain name was registered on June 7, 2002. It resolves to a parking page with pay-per-click ("PPC") links mostly related to the Complainant's sector, that is footwear, some of them redirecting to websites of the Complainant's competitors.

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 states that the disputed domain name is identical to its trademark PREMIATA.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name, it is not commonly known by the disputed domain name, and it is not making either a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name resolves to a parking page with PPC links mostly related to the Complainant's sector, some of them also redirecting to websites of the Complainant's competitors.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademark PREMIATA is distinctive and well known in the field of footwear. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain name and the Complainant contends that, by resolving to a parking page with PPC links mostly related to the Complainant's sector, the use of the disputed domain name to attract, for commercial gain, Internet users to the Respondent's website, creating a likelihood of confusion with the Complainant's trademark, qualifies as bad faith registration and use.

Moreover, the Complainant suspects that the Respondent might also use the disputed domain name in connection with phishing or fraudulent email communications, since the mail exchanger (MX) records attached to the disputed domain name have been activated.

Finally, the Complainant asserts that the Respondent is engaged in a pattern of registering other abusive domain name registrations.

B. Respondent

The Respondent has made no formal reply to the Complainant's contentions.

However, the Respondent sent the following two email communications to the Center:

"... I want to express my opposition to this complaint as the domain was not registered in bad faith (this is the first time I hear of "premiata" as a shoe brand, besides the fact that there are many 54 brands named "premiata" in various sectors). We registered the domain many years ago (about 20) and throughout these years, there has never been any contact or request from Premiata Srl; we registered the domain along with other domains. The word "premiata" in Italian has a very generic meaning which is "rewarded" in feminine form. We have an editorial project connected to Italian women who have won various kinds of titles worldwide. Along with the domain "premiata.com", for similar editorial projects, we have also registered "premiata.com, premiate.it, premiati.it, and premiato.it" (all meaning "rewarded"). The .com domains were registered in the same year, while the .it domains were registered a few years later as we began to also work with .it domains. Currently, the domains are parked because we were supposed to go online, but unfortunately, the project manager who was managing the projects passed away, and having many pending projects, we kept it on standby while reorganizing. I hope this provides a comprehensive explanation. Available for further information. Best Regards" (On August 30, 2024);

"In addition to the points already specified in the previous email, I would like to add that: We registered the domain in 2002. The changes in registrant seen in the WHOIS are merely changes of registrar (for price convenience) or changes of companies always belonging to the same person. The documents need to have (...) and associated individuals removed as they have nothing to do with the domain, and it was an error by SAV.COM that gave you that name. According to our database, there is no record of any negotiations for the domain at \$125,000. This is our final response. Looking forward to hear from you and I wish you a good day. Best Regards" (On September 2, 2024)

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed 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 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. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

It is also well accepted that a generic Top-Level Domain, in this case ".com", is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

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.

While 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 often impossible 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. 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 present 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 disputed domain name resolves to a parking page with PPC links mostly related to the Complainant's sector, some of them redirecting to websites of the Complainant's competitors. The use of a disputed 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 trademark. [WIPO Overview 3.0](#), section 2.9.

While the Respondent claims that it has registered the disputed domain name because of the dictionary meaning of the word "premiata" which means in Italian "rewarded in feminine form" and that it has an "editorial project connected to Italian women who have won various kinds of titles worldwide", he has not provided any evidence to support its claims. [WIPO Overview 3.0](#), section 2.10.

Moreover, the Panel finds that the composition of the disputed domain name – which is identical to the Complainant's trademark – carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, 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.

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.

In the present case, regarding the registration in bad faith of the disputed domain name, the reputation of the Complainant's trademark PREMIATA in the field of footwear is clearly established, and the Panel finds that the Respondent must have known of the Complainant, and deliberately registered the disputed domain name in bad faith, especially because of the content of the parking page to which the disputed domain name resolves, which consists of PPC links mostly related to the Complainant's sector, some of them redirecting to websites of the Complainant's competitors.

In fact, the Panel finds that the disputed domain name is also used in bad faith since in the relevant parking page there are PPC links, even in the case where they were automatically generated, referring to the footwear's field, that is to the same field of activity as the Complainant, some of them redirecting to websites of the Complainant's competitors, and the Respondent cannot disclaim responsibility for the parking page content. See [WIPO Overview 3.0](#), section 3.5.

The Panel therefore notes that the disputed domain name is being used in bad faith since the Respondent is trying to attract Internet users to its website by creating likelihood of confusion with the Complainant's trademark as to the disputed domain name's source, sponsorship, affiliation or endorsement, an activity clearly detrimental to the Complainant's business.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain name in order both to disrupt the Complainant's business, and to attract Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain name in bad faith, also taking into consideration the pattern of conduct of the Respondent in several other cases of abusive domain name registration against third parties.

Furthermore, the Panel considers that the nature of the inherently misleading disputed domain name, which is identical to the Complainant's trademark, further supports a finding of bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Finally, since the MX records attached to the disputed domain name have been activated, noting the nature of the disputed domain name (being identical to the Complainant's trademark), the Panel deems that there is a risk that the disputed domain name could be used for phishing activities.

Based on the available record, the Panel finds the third element of the Policy has been established.

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

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: September 23, 2024