



URS | DETERMINATION
(URS Procedure 9, URS Rules 13)

URS DISPUTE NO. 38D38101

Determination DEFAULT

I. PARTIES

Complainant: Basic Trademark (IT)

Complainant' authorized representative(s): Studio Sindico e Associate, Domenico Sindico (IT)

Respondent(s): Privacy Guardian, See [PrivacyGuardian.org](https://www.privacyguardian.org) (US)

II. THE DOMAIN NAME(S), REGISTRY OPERATOR AND REGISTRAR

Domain Name(s): SUPERGANEGOZIO.ONLINE

Registry Operator: DotOnline Inc.

Registrar: NameSilo, LLC

III. PROCEDURAL HISTORY

Complaint submitted: 2020-09-09 11:39

Lock of the domain name(s): 2020-09-09 18:34

Notice of Complaint: 2020-09-10 12:42

Default Date: 2020-09-25 00:00

Notice of Default: 2020-09-25 20:03

Panel Appointed: 2020-09-25 20:08

Default Determination issued: 2020-09-29 17:56

IV. EXAMINER

Examiner's Name: Igor Motsnyi

The Examiner certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Examiner in this administrative proceeding.

V. RELIEF SOUGHT

The Complainant requests that the domain name be suspended for the balance of the registration period.

The Respondent has not submitted a Response.

VI. STANDARD OF REVIEW

Clear and convincing evidence.

VII. DISCUSSIONS AND FINDINGS

A. Complainant:

The Complainant provided the following arguments in support of its complaint.

The Complainant is a prominent Italian company and is a part of the Basic Group, a market leader in the design and marketing of clothing, footwear and accessories, mostly sportswear or leisurewear, which are sold under various trademark including SUPERGA. It is a holder of many trademarks protecting the word Superga in classes 3, 9, 14, 16,18, 25.

The Superga trademarks have been used extensively in Europe and all over the world and, at least in Europe, it is one of the most famous brands in the sector of casual footwear. The Complainant conducts business through its e-commerce channels and its official web site www.superga.com. The potential customers can view all models and then proceed with the purchase.

The Complainant has never authorized any third party to register domain names referring to Superga trademarks.

The Complainant recently discovered the disputed domain name which is believed to be in violation of its exclusive trademark rights.

The disputed domain name is confusingly similar to the Superga trademark and the content of the website is an abusive copy of Superga's official website.

To obtain the temporary suspension of the disputed domain name, on July 20, 2020 the Complainant forwarded a report to the company Radix Domain Solutions Pte Ltd (responsible for the registration of domain name with the extension "online") reporting the violation of Superga Trademarks and the copyright of its official website and requested the immediate suspension of the disputed domain name.

The temporary suspension was granted on July 21, 2020. This suspension is temporary and for this reason the Complainant filed this complaint before the MFSD. The Complainant considered that despite its prompt actions, it received many consumer reports in relation to the disputed domain name.

B. Respondent:

The Respondent did not submit a Response.

C. Procedural findings:

Having reviewed the communications records, the Examiner finds that MFSD has discharged its responsibility under the URS Procedure paragraphs 3 and 4 and URS Rules paragraph 4.

In accordance with URS Rules Paragraph 9(d), in absence of a Response, the language of the Determination shall be English.

D. Findings of fact:

The Complainant has demonstrated that it owns the following registered trademarks:

- EU trademark "SUPERGA" (word) No. 003181492, registered on December 10, 2004 in classes 3, 9, 14, 16,18, 25;
- International trademark registration No. 1018404, "SUPERGA" (word), registered on July 8, 2009 in classes 3, 9, 18 and 25.



The Complainant provided screenshots from its website and some brochures about its products as a confirmation of use of its “SUPERGA” trademarks.

The disputed domain name was registered on May 04, 2020. The disputed domain name is not active on the date of this determination.

The Complainant asserts that the disputed domain name was suspended as a result of its complaint to Radix Domain Solutions Pte Ltd responsible for the registration of .online domains.

The Complaint did not provide any screenshots of the website by the disputed domain name or a copy of the report sent to Radix Domain Solutions Pte Ltd.

E. Reasoning:

According to Paragraph 13 of the URS Rules, the Examiner shall make a Determination of a Complaint in accordance with the URS Procedure, the URS Rules and any rules and principles of law that it deems applicable.

Even though the Respondent has defaulted, URS Procedure 1.2.6, requires Complainant to make a *prima facie* case, proven by clear and convincing evidence, for each of the following three elements to obtain an order that a domain name should be suspended.

For the Complainant to succeed, it must establish that each of the three following conditions under 1.2.6 URS Procedure are satisfied:

- That the disputed domain name is identical or confusingly similar to a word mark;
- That the Registrant has no legitimate right or interest to the disputed domain name;
- That the disputed domain name was registered and is being used in bad faith.

1. The domain name(s) is(are) identical or confusingly similar to a word mark

The Complainant demonstrated that it is the owner of the “SUPERGA” word trademarks and that these word trademarks are in use.

The disputed domain name fully includes the “SUPERGA” trademark coupled with the Italian word “negozio” (translated into English as “shop” or “store”) that could be seen as descriptive.

As stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) “*Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element*” (see 1.8 of WIPO Overview 3.0).

In this case the trademark of the Complainant is clearly recognizable and neither the descriptive term nor the .online zone adds to the distinctiveness of the disputed domain name.

Therefore, the Examiner finds that the requirements set forth under paragraph 1.2.6.1. of the URS Procedure have been satisfied.

2. Respondent has no rights or legitimate interests to the domain name(s)

The Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests; and once such *prima facie* case is made, the burden shifts to the Respondent who has to demonstrate his rights or legitimate interests.

The Complainant barely addressed this element in its Complaint only stating that: “the Complainant has never authorized any third party to register domain names referring to

Superga trademarks”. The website by the disputed domain name is not active on the date of this determination.

However, the Examiner finds he should not address this element given the findings in respect of the third element under 1.2.6.3. of URS.

3. The domain name(s) was(were) registered and is(are) being used in bad faith

First, the Examiner notes that the URS Procedure provides that the burden of proof shall be clear and convincing evidence (see paragraph 8.2 of URS Procedure) and that the Complainant must present evidence that the disputed domain name was registered and is being used in bad faith.

Under paragraph 8.6 of URS Procedure if the Examiner finds that all three standards are satisfied by clear and convincing evidence and that there is no genuine contestable issue, then the Examiner shall issue a Determination in favor of the Complainant.

If the Examiner finds that any of the standards have not been satisfied, then the Examiner shall deny the relief requested, thereby terminating the URS proceeding without prejudice to the Complainant to proceed with an action in court of competent jurisdiction or under the UDRP.

Second, while any URS complaint has a rather strict word limit (explanatory statement can only be up to 500 words), the complaint and the evidence submitted have to comply with the “clear and convincing” standard.

For instance, as stated in 1.2.4. of URS Procedure “for each domain name, the Complainant shall include a copy of the currently available Whois information and a description and copy, if available, of the offending portion of the website content associated with each domain name that is the subject of the Complaint”.

The disputed domain name is not active on the date of this determination.

The complaint contains very little information.

It mainly describes Complainant’s business but barely deals with the Respondent’s activities and the nature of the website by the disputed domain name and it is unclear was it indeed selling counterfeit goods and if yes, what is the proof, or was it a reseller of genuine goods, albeit unauthorized one (that could potentially give rise to rights and legitimate interests in certain cases)?

This is even more surprising given that the Complainant claims that it had already sent a report about the disputed domain name alleging trademark and copyright infringement. However, the Complainant did not attach the report to the complaint.

Third, the Complainant merely asserted that the disputed domain name was registered in order to prevent the trademark holder or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct and the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor.

The only proof provided by the Complainant to possibly support the bad faith element were copies of email messages sent by some of its customers that question the nature of the website by the disputed domain name. However, there is no any further proof of any activity on the website by the disputed domain name and such emails alone in the absence of any additional evidence are inconclusive.



This leaves some issues of material facts unresolved and it is not for the Examiner to conduct any additional investigation and research. The Examiner only deals with the arguments and evidence provided by the parties.

Under paragraph 9.1 of URS Procedure “there will be no discovery or hearing; the evidence will be the materials submitted with the Complaint and the Response, and those materials will serve as the entire record used by the Examiner to make a Determination” and under paragraph 9.3. if the Complainant does not satisfy the burden of proof, the URS proceeding is terminated.

While URS is a simplified procedure, it requires some serious preparatory work and high standard of proof for the complainants.

There is simply not enough information and evidence for the Examiner to decide on the bad faith element in this dispute and the Complainant fails to demonstrate that element by clear and convincing standard.

Relevant URS case law shows that mere assertions of bad faith are not sufficient and all the URS elements have to be demonstrated by clear and convincing evidence (see e.g. Forum case FA2009001911369 – “the Complaint does not specifically provide any support to address URS 1.2.6.3.” and Forum case FA1804001780755).

In the Forum case FA1804001780755 the Examiner noted: “The Examiner deplores the fact that the Complainant has not submitted any evidence supporting its claim of bad faith use and registration. The Examiner would have expected the Complainant to provide evidence of, for instance, the website associated with the disputed domain name. The Examiner notes that the Complainant submitted a screenshot of its own website, but not of the Respondent’s website.”

This is the case in the present dispute as well where the Complainant did not provide any information about the website by the disputed domain name (i.e. screenshots or the report it had allegedly sent).

The Examiner finds that providing just copies of some email messages by Complainant’s customers questioning the disputed domain name is not sufficient for the clear and convincing standard as required by URS.

Therefore, the Examiner finds that the Complaint did not satisfy the standards of URS Procedure 1.2.6.3, namely that the Complaint did not provide any evidence of bad faith registration and use of the disputed domain name.

4. Abusive Complaint

The Examiner finds that the Complaint was neither abusive nor contained material falsehoods.

The Examiner finds that the complaint was not substantiated, in particular in respect of the bad faith element, however this alone does not indicate abuse of proceedings. Had the Complainant provided more details and evidence, the outcome could have been different.

VIII. DETERMINATION

A. Demonstration of URS elements

Not demonstrated

B. Complaint and remedy

Complaint: Rejects

Domain Name(s): SUPERGANEGOZIO.ONLINE Unlocks and returns to the full control of the Registrant

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Igor

Surname: Motsnyi

Date: 2020-09-29