



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

**URS DISPUTE NO. 3B7F4FC3**

Determination DEFAULT

**I. PARTIES**

Complainants: ALPARGATAS, S.A. (BR), ALPARGATAS EUROPE, S.L.U (ES)  
Complainants' authorized representative(s): PADIMA TEAM, SLP, Ana Bricio (ES)

Respondent(s): Privacy Guardian, See PrivacyGuardian.org (US)

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

Domain Name(s): HAVAIANASITALIA.TOP  
Registry Operator: .TOP Registry  
Registrar: NameSilo, LLC

**III. PROCEDURAL HISTORY**

Complaint submitted: 2021-07-19 11:27  
Lock of the domain name(s): 2021-07-20 08:37  
Notice of Complaint: 2021-07-20 09:39  
Default Date: 2021-08-04 00:00  
Notice of Default: 2021-08-04 10:32  
Panel Appointed: 2021-08-04 10:37  
Default Determination issued: 2021-08-06 14:40

**IV. EXAMINER**

Examiner's Name: Guido Maffei

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 Complainants request the domain name to 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. Complainants:**

The Complainants are (i) the Brazilian company ALPALGARTAS, SA, as owner of different EU trademark registrations consisting of or including the word HAVAIANAS and protecting said word in class 25, and (ii) the Spanish company ALPARGATAS EUROPE, S.L.U, as licensee and exclusive distributor of HAVAIANAS trademarks in Europe.

The Complainants are owner/licensee of the following trademarks HAVAIANAS:

- European Union Registration no. 7156128 “HAVAIANAS” (word) registered on March 23, 2009, in class 25;
- European Union Registration no. 8664096 “HAVAIANAS” (device) registered on April 23, 2010, in class 25;
- European Union Registration no. 3772431 “HAVAIANAS” (device) registered on September 20, 2005, in class 25.

The mark HAVAIANAS is a renowned trademark all over the world, due to the well-known HAVAIANAS flip-flops and also for the use of this trademark to distinguish clothes and accessories related to summer or beach environments.

The Complainants contend that the above trademarks were registered before the registration of the disputed domain name.

According to the Complainants, the domain name in dispute is highly similar to the prior rights owned by the Complainants on HAVAIANAS. This in consideration of the fact that the disputed domain name includes the well-known trademark HAVAIANAS.

Furthermore, the Complainants state that they have never authorized the Respondent to use the mark HAVAIANAS.

Finally, it is the Complainants view that the registration and use of the disputed domain name is in bad faith since it resolves to a website, including abusive and not authorized reproductions of Complainants trademarks and pictures, dedicated to the e-commerce of HAVAIANAS flip-flops and consequently gives the clear impression to be an official website of the Complainants.

## **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 Procedure Paragraph 9(d), in absence of a Response, the language of the Determination shall be English.

## **D. Findings of fact:**

The disputed domain name was registered on June 23, 2021.

The Complainants have demonstrated to be the owner/licensee of the following trademarks:

- European Union Registration no. 7156128 “HAVAIANAS” (word) registered on March 23, 2009, in class 25;



- European Union Registration no. 8664096 “HAVAIANAS” (device) registered on April 23, 2010, in class 25;
- European Union Registration no. 3772431 “HAVAIANAS” (device) registered on September 20, 2005, in class 25.

## **E. Reasoning:**

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

The Complainants have established that they have rights in the trademark HAVAIANAS at least since 2004. The Complainants’ trademark, therefore, was registered well before the registration of the disputed domain names (June 23, 2021). The disputed domain name is composed of (i) the Complainants’ HAVAIANAS trademark, (ii) the word ITALIA and (iii) the top-level domain name “. top”. The word ITALIA is a mere geographic identifier and, as such, it does not alter the finding of similarity between the domain name in dispute and the previous registered trademark (see *Six Continents Hotels, Inc. v. Sdf fdgg*, WIPO Case No. D2004-0384 and *Credit Agricole SA v. Frederik Hermansen*, CAC Case No. 101249). In consideration of the above, it is clear that the only distinctive part of the disputed domain name is the Complainants’ HAVAIANAS mark. Adding a mere geographic identifier to this mark does not prevent the disputed domain name being confusingly similar to the Complainants’ HAVAIANAS trademark. In addition, it must be considered that the relevant comparison to be made is with the first portion of the domain name only (i.e., “havaianasitalia”), as it is well-established case law that the top-level domain name (in this case .top) should be disregarded for this purpose (see *Playboy Enterprises International, Inc. v. John Taxiarchos*, WIPO Case No. D2006-0561; *Burberry Limited v. Carlos Lim*, WIPO Case No. D2011-0344; *Magnum Piercing, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525).

Therefore, the Examiner finds that the requirement set forth under Paragraph 1.2.6.1. of the URS Procedure has been satisfied.

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

The Complainants provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it was never authorized to use it by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name.

Based on the above, the Examiner finds that the Respondent lacks any rights or legitimate interests with respect to the disputed domain names as per the requirement set forth under Paragraph 1.2.6.2. of the URS Procedure.

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

The Respondent registered the disputed domain name years after the use and registration of the HAVAIANAS mark by the Complainants. In consideration of the reputation achieved by HAVAIANAS it is clear that the Respondent was surely aware of the Complainants’ trademark when he registered the domain name in dispute.

Moreover, the Respondent appears to have attempted to benefit commercially from the appropriation of the HAVAIANAS mark in the disputed domain name. The use made by

Respondent of the famous mark HAVAIANAS, which is well-known, especially for the flip-flops, clearly indicates that the disputed domain name was chosen by the Respondent to take advantage of the Complainant's mark reputation. This finding leads to the obvious conclusion that the disputed domain name has been registered in bad faith (Research In Motion Limited v. Privacy Locked LLC/Nat Collicot - WIPO Case No. D2009-0320; The Gap, Inc. v. Deng Youqian - WIPO Case No. D2009-0113; AXA S.A. v. P.A. van der Wees - WIPO Case No. D2009-0206; BHP Billiton Innovation v. Ravindra Bala - WIPO Case No. D2008-1059).

The Examiner also finds that, by creating abusive copies of Complainant's official website connected to the disputed domain name, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the trademark HAVAIANAS as to the source, sponsorship, affiliation or endorsement of its website and the products promoted therein. This is a clear bad faith use of the disputed domain.

Therefore, the Examiner finds that the requirement set forth under Paragraph 1.2.6.3. of the URS Procedure has been satisfied by the Complainant.

#### **4. Abusive Complaint**

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

### **VIII. DETERMINATION**

#### A. Demonstration of URS elements

Demonstrated

#### B. Complaint and remedy

Complaint: Accepts

Domain Name(s): HAVAIANASITALIA.TOP Suspend for the balance of the registration period

#### C. Abuse of proceedings

Finding of abuse of proceedings: Not found

#### D. Publication

Publication: Publish the Determination

### **SIGNATURE**

Name: Guido  
Surname: Maffei  
Date: 2021-08-06