



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

URS DISPUTE NO. 41A50F47

Determination DEFAULT

I. PARTIES

Complainant(s): Fabbrica d'Armi Pietro Beretta S.p.A. (IT)
Complainant's authorized representative: Barzanò & Zanardo Milano S.p.A. (IT)

Respondent(s): Domain Protection Services, Inc. (US)

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

Domain Name(s): THEBERETTA.STORE
Registry Operator: Radix FZC
Registrar: Name.com, Inc.

III. PROCEDURAL HISTORY

Complaint submitted: 2022-12-21 11:56
Lock of the domain name(s): 2022-12-21 22:37
Notice of Complaint: 2022-12-22 11:39
Default Date: 2023-01-06 00:00
Notice of Default: 2023-01-06 10:01
Panel Appointed: 2023-01-06 10:03
Default Determination issued: 2023-01-12 10:12

IV. EXAMINER

Examiner's Name: Lars Karnoe

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:

This Complaint is based on the following **grounds**:

The trademark(s) mark(s) on which the Complaint is based is:

(URS 1.2.5; URS Rules 3(b)(v))

Fabbrica d'Armi Pietro Beretta is a privately held Italian firearms manufacturing company operating in several countries and the oldest active manufacturer of firearm components in the world.

Nonetheless Beretta has been owned by the same family for almost five hundred years and is a founding member of "Les Henokiens", an association of bicentenary companies that are family owned and operated. It is still hold by Beretta family (please find at the following link the current corporate governance <https://www.berettaholding.com/it/corporate-governance>)

The parent company, Beretta Holding, also owns Beretta USA, and acquired several domestic competitors (such as Benelli and Franchi) and some foreign companies, e.g. SAKO, Stoeger, Tikka, Uberti, and the Burris Optics company.

Beretta Holding closed the 2021 with 958 millions of Euro of revenue (of which 250 million of Euro has been generated by Fabbrica d'Armi Pietro Beretta, <https://www.beretta.com/it-it/azienda/fabbrica-d-armi-pietro-beretta/azienda>) and more than 3380 employees (<https://www.berettaholding.com/en/financial-highlights>), based not only in Europe but also in Australia, New Zealand, Russia, Turkey, USA and China (<https://www.berettaholding.com/en/global-presence>).

The Complainant is the owner of the following trademarks:

- International registration No 147879 of 7 July 1950, duly renewed, in classes 8 and 13;
- International registration No 746766 of November 08, 2010, in class 9;
- European Union registration No 9743543 of February 17, 2011 in classes 08, 09, 13, 14, 18, 25 and 34;
- European Union registration No 3801537 of August 19, 2005 in class 28, duly renewed.

Moreover, the Complainant is owner of several top-level and country code top-level domain names, constituted by the verbal element <BERETTA>, among which <beretta.com>, <beretta.it>, <berettadefense.com>, <berettaholding.com> and is present on the main social media.

The Complainant's trademarks are used in relation to the sale of different goods (arms and apparel). Among the products offered for sale with BERETTA trademarks there are also gilet vest and waistcoats: the same products are offered for sale on the website associated with the disputed domain name.

Requirements under URS Procedure para. 1.2.6

1. The domain name(s) is(are) identical or confusingly similar to a word mark for which the Complainant holds a valid national or regional registration and that is in current use:

(URS Procedure 1.2.6.1; URS Rules 3(b)(vi))

The disputed domain name entirely contains the sign "BERETTA" and, as such, it should be considered as confusingly similar to the Complainant's trademarks. The addition of the article "the" increases the likelihood of confusion with the Complainant's trademarks since it is a



“generic” and “descriptive” term, which could be easily associated to the Complainant’s business, as indicating exactly the renowned brand BERETTA. The “.store” New gTLD extension has no impact in the confusing similarity assessment in view of its technical function.

2. The Respondent has no legitimate right or interest to the domain name:
(URS Procedure 1.2.6.2)

The Complainant has never authorized the Respondent to use the BERETTA trademark in the domain name <theberetta.store>. The Complainant excludes that the Respondent is an authorized dealer, agent or licensee of the Complainant.

The disputed domain name redirects to a website which reproduces the same look and feel of the Complainant’s official website using images taken from the Complainant’s website without any authorization by the Complainant.

3. The domain name(s) was/were registered and is/are being used in bad faith:
(URS Procedure 1.2.6.3)

As far as registration in bad faith is concerned, the Complainant notes that the Respondent could not ignore the existence of the BERETTA trademark at the time of the registration of the disputed domain name in consideration of the nature of the same (consisting of the Complainant’s trademark plus the addition of the article “the”) and of the website’s contents, which reproduce Complainant’s trademarks as well as photos of Complainant’s website, advertising campaigns and products.

Furthermore, the disputed domain name has been registered long after the filing/registration of the Complainant’ trademarks.

As far as use in bad faith is concerned, the disputed domain name – despite prima facie inactive at the moment of filing of the complaint – was redirected to a website offering for sale alleged “BERETTA” goods and unduly depicting copyrighted pictures taken from the Complainant’s official website and social network accounts.

This kind of use is certainly not a use in good faith. It may cause substantial damages not only to the Complainant, but also to consumers. On the one side, the Complainant’s image and reputation are strongly affected by the website, very similar to the official one, offering for sale conflicting goods. On the other side, consumers share confidential information when they pay the purchased goods, with the concrete risk that this information is stolen and used fraudulently by the Respondent. Moreover, as a consequence of this fake website, the Complainant is experiencing serious problems with the shops that offer its products in exclusivity.

It appears from the above that the Domain Name has been registered and is used to intentionally attract for commercial gain Internet users to the Respondent’s web site, by creating a likelihood of confusion with the Complainant’s official website, also creating the impression that the Respondent’s website is sponsored/affiliated or endorsed by the Complainant.

B. Respondent:

The Respondent has not filed an official response within the deadline.

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.

C. Findings of fact:

The Registration Date of the Disputed Domain Name is as below:

<theberetta.store>: 2022-06-06

Despite 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.

[URS 1.2.6.1] The registered domain name(s) is/are identical or confusingly similar to a word mark:

- (i) for which the Complainant holds a valid national or regional registration and that is in current use; or
- (ii) that has been validated through court proceedings; or
- (iii) that is specifically protected by a statute or treaty in effect at the time the URS complaint is filed.

[URS 1.2.6.2] Registrant has no legitimate right or interest to the domain name.

[URS 1.2.6.3.] The domain was registered and is being used in bad faith.

E. Reasoning:

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

To satisfy URS 1.2.6.1, a Complainant needs to prove its rights in a word mark and the domain name(s) is/are identical or confusingly similar to the word mark.

In the present case, the Examiner finds that the Complainant is a well-known fire-arms and apparel manufacturer who also owns trademark registrations for BERETTA in different jurisdictions.

The Complainant claims that the Disputed Domain Name is confusingly similar to the BERETTA trademark. The Examiner accepts that the additional term “the” does not alter the underlying trademark or negate the confusing similarity and it does not sufficiently differentiate the Disputed Domain Names from that trademark.

In addition, the Examiner also finds that the “.store” generic top-level domain (“gTLD”) does not prevent the finding of confusing similarity under the first element.

For the foregoing reasons, the Panel finds the Complainant has satisfied URS 1.2.6.1 as the disputed domain name is confusingly similar to the Complainant’s registered trademarks.

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



To satisfy URS 1.2.6.2, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the domain name(s), and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests.

The Complainant asserts that the Respondent has not been authorized by the Complainant to use the trademark BERETTA in the Disputed Domain Name or the content of the website. The Respondent's use is not a legitimate noncommercial or fair use, and is not in connection with a bona fide offering of goods or services.

The Examiner finds that the Complainant has met its burden and established a prima facie case that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the Respondent has not rebutted the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied URS 1.2.6.2 as the Respondent has no legitimate rights or interest to the domain names.

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

The Complainant has, to the satisfaction of the Examiner, shown that the disputed domain name has been registered and is being used in bad faith. Given the character and documented use of the trademark BERETTA by the Complainant and the Respondent, it is clear and not disputed by the Respondent, that the Respondent has registered the disputed domain name with knowledge of the Complainant and its trademarks. In addition, the disputed domain name is not used for any bona fide offerings. The disputed domain name seems merely to be registered to generate traffic for the Respondent's web shop offering similar goods as those of the Complainant in an obvious attempt to trade off of the fame of the trademarks of the Complainant. All these elements lead to the conclusion that the Respondent has intentionally attempted to attract Internet users to the Respondent's website for commercial gain by creating a likelihood of confusion or association with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of that website by the Complainant.

In reaching the conclusion described above the totality of the circumstances of this particular case has been taken into account and the following facts of the present dispute demonstrate bad faith on the Respondent's side:

(i) The degree of distinctiveness or reputation of the Complainant's mark – the Complainant's BERETTA trademark is highly distinctive and widely used.

(ii) The failure of the Respondent to submit a response.

(iii) The implausibility of any good faith use to which the disputed domain name may be put taking into account the distinctiveness and wide spread use of the Complainant's trademark.

The disputed domain name is identical to a high degree to the Complainant's trademark as the mere addition of the generic term "the" should be disregarded in assessing the identity. As confirmed by WIPO Overview 3.0 the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (par. 3.1.4).

From the evidence available in the present dispute, it clearly appears that the Respondent has intentionally attempted to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's mark by fully incorporating Complainant's distinctive trademark into the disputed domain name.

This conduct is considered by the URS as a demonstration of bad faith registration and use, under Paragraph 1.2.6.3 (d) of the URS Procedure.

Therefore, the Examiner finds that the requirements set forth under Paragraph 1.2.6.3. of the URS Procedure have 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): THEBERETTA.STORE Suspends for the balance of the registration period

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Lars

Surname: Karnoe

Date: 2023-01-12