



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

**URS DISPUTE NO. 4984EDC0**

Determination DEFAULT

**I. PARTIES**

Complainant(s): Confezioni Lerario s.r.l. (IT)

Complainant's authorized representative: Barzanò & Zanardo Milano s.p.a. (IT)

Respondent(s): PrivacyGuardian.org, LLC (US)

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

Domain Name(s): ONLINETAGLIATORE.SHOP

Registry Operator: GMO Registry, Inc.

Registrar: NameSilo, LLC

**III. PROCEDURAL HISTORY**

Complaint submitted: 2022-12-01 16:52

Lock of the domain name(s): 2022-12-06 03:39

Notice of Complaint: 2022-12-11 19:19

Default Date: 2022-12-26 00:00

Notice of Default: 2022-12-26 10:29

Panel Appointed: 2022-12-26 10:36

Default Determination issued: 2022-12-29 12:25

**IV. EXAMINER**

Examiner's Name: Mariia Koval

The Examiner certifies that she has acted independently and impartially and to the best of her 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, incorporated in 1985, is an Italian based company active in the production and distribution of high-quality clothing goods.

The Complainant is the owner of the International trademark no. 1429457, registered on May 17, 2018, in respect of goods and services in classes 3, 9, 14, 18, 21, 24, 25 and 35; and the European Union trademark no. 013959391, registered on September 16, 2015, in respect of goods and services in classes 3, 18, 25 and 35 (hereinafter collectively referred to as “the Complainant’s Trademark”).

The Complainant contends that the disputed domain name is confusingly similar to the Complainant’s Trademark TAGLIATORE in view of the disputed domain name entirely contains the Complainant’s Trademark. The addition of the word “online” increases the likelihood of confusion with the Complainant’s Trademark since it is a “generic” and “descriptive” term which could be easily associated to the Complainant’s business. The “.shop” New gTLD extension has no impact in the confusing similarity assessment in view of its technical function.

The Complainant further asserts that the Respondent has no legitimate right or interest to the disputed domain name. The Complainant has never authorized the Respondent to use the Complainant’s Trademark in the disputed domain name. 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.

The Complainant also asserts that that the disputed domain name was registered and is being used in bad faith. The Complainant notes that the Respondent could not ignore the existence of the Complainant’s Trademark at the time of the registration of the disputed domain name in consideration of the nature of the domain name (consisting of the Complainant’s Trademark plus the addition of the generic and descriptive term “online”) and of the website’s content, which reproduces the Complainant’s Trademark as well as the photos of the Complainant’s website, advertising campaigns and products.

Furthermore, the disputed domain name has been registered long after the filing/registration of the Complainant’ Trademark. The disputed domain name links to a website offering for sale alleged “TAGLIATORE” 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 disputed domain name has been registered and is used to intentionally attract for commercial gain Internet users to the Respondent’s website, 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 did not submit a Response to the Complaint.

### **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 registration date of the disputed domain name is 9 October, 2022.

The Complainant owns a number of the trademark registrations, consisting in the distinctive term “TAGLIATORE”, around the world, in particular, but not limited to:

- International trademark no. 1429457, registered on May 17, 2018, in respect of goods and services in classes 3, 9, 14, 18, 21, 24, 25 and 35;
- the European Union trademark no. 013959391, registered on September 16, 2015, in respect of goods and services in classes 3, 18, 25 and 35.

The Complainant operates a domain name <tagliatore.com> and the related website for the promotion of its goods, and has accounts in the social networks Facebook and Instagram.

At the date of this Determination, the website under the disputed domain name is active and directs to the website in the English language where the clothing under the TAGLIATORE trademark is on sale.

### **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 despite the Respondent has defaulted, URS Procedure 1.2.6 requires the Complainant to make a prima facie case, proven by clear and convincing evidence.

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**

Under the Paragraph 1.2.6.1 of the URS Procedure, the Complainants shall prove “that the registered domain name is 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”.

The Complainant contends that the dispute domain name is 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. The Complainant has provided sufficient evidence to prove its existing ownership to the registered trademark “TAGLIATORE”.

The disputed domain name incorporates the Complainant’s Trademark in its entirety.

In the present case the disputed domain name incorporates the Complainant’s Trademark in its entirety with addition of the word “online” and TLD suffix “.shop”. Addition of the word “online” to the Complainant’s Trademark and TLD “.shop” does not affect the finding of confusing similarity of the disputed domain name to the Complainant’s Trademark.

Therefore, the Examiner finds that the disputed domain name is confusingly similar to the Complainant’s trademark and consequently the Examiner finds that 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)**

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 proof then shifts to the Respondent to show it does have rights or legitimate interests.

The Complainant asserts that the Respondent has no legitimate right or interest to the disputed domain name, providing evidence in confirmation of this assertion.

The Respondent, in the absence of any response, has not shown any facts or elements to justify rights or legitimate interests in the disputed domain name.

According to the Complaint, the Respondent and the website under the disputed domain name are not in any way affiliated to the Complainant nor has the Complainant authorized the Respondent’s registration and use of the disputed domain name.

The Respondent, which has no connection with the Complainant, does not seem to have legitimate interests or rights in the registration and in the use of the disputed domain name. The website under the disputed domain name contains the Complainant’s Trademark, number of the Complainant’s goods images and marketing materials without the Complainant’s authorization. At the same time, the website under the disputed domain name does not disclose any information about the relationship between the Complainant and the Respondent (or lack thereof).

Based on the above, the Examiner finds that the Respondent lacks rights or legitimate interests with respect to the disputed domain names as per the requirements set forth under Paragraph 1.2.5.2 of the URS Procedure.

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

According to URS Procedure 1.2.6.3, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. URS Procedure 1.2.6.3 identifies non-exclusive list of circumstances that Examiner could consider as constituting bad faith.

The Respondent registered the disputed domain name years after the registration and use of the Complainant’s Trademark. In consideration of the reputation achieved by such mark, it is clear that the Respondent was very well aware of the Complainant’s Trademark when he registered the disputed domain name. Moreover, the Respondent’s prior knowledge of the Complainant’s



Trademark is also supported by the use of the disputed domain name which resolves to a commercial website apparently offering the alleged products under the Complainant's Trademark and containing the Complainant's logo, marketing materials and copyrighted pictures taken from the Complainant's official website and social network accounts. The Internet users might have well been under the impression that it is a website created and operated by a certified service provider of the Complainant that is not true. Therefore, the Respondent intentionally attempted to attract for commercial gain, Internet users to its web site at the disputed domain name by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, and endorsement of the Respondent's web site.

Such use in this Examiner's point of view has already created actual confusion with the Complainant's trademark as to source, sponsorship, affiliation, or endorsement of the Respondent's website and therefore does not qualify as a bona fide use, but on the contrary, this is a clear bad faith use of the disputed domain name.

Finally, the Respondent, not participating in these proceedings, has failed to indicate any facts and/or evidence, which would show the good faith registration and use of the disputed domain name.

In the absence of any explanation from the Respondent, the Examiner agrees that the Respondent did have actual knowledge of the Complainant's Trademark demonstrating the bad faith registration and use of the disputed domain name, and disrupts the Complainant's business.

For the foregoing reasons, the Panel finds the Complainant has satisfied URS 1.2.6.3 as the Respondent registered the disputed domain name and is using it in bad faith.

#### **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): ONLINETAGLIATORE.SHOP 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: Mariia  
Surname: Koval  
Date: 2022-12-29