

ADMINISTRATIVE PANEL DECISION

The Attico S.r.l. v. Sanli Zhang
Case No. D2022-3640

1. The Parties

The Complainant is The Attico S.r.l., Italy, represented by Studio Scarpellini, Italy.

The Respondent is Sanli Zhang, China.

2. The Domain Name and Registrar

The disputed domain name <theatticoshop.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 30, 2022. On September 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 2, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. On October 4, 2022, the Complainant submitted a second Complaint which corrected the disputed domain name in the first submission.

The Center verified that the Complaints 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 October 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 28, 2022.

The Center appointed Marilena Comanescu as the sole panelist in this matter on November 2, 2022. 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.

4. Factual Background

The Complainant, an Italian company founded in 2016, operates in the field of luxury fashion. Currently, the Complainant has famous clients and is featured in the relevant publications.

The Complainant holds trademark rights for ATTICO and THE ATTICO, such as the following:

- the International word trademark ATTICO, registration No. 1337862 registered on June 22, 2016, for goods in International Classes 14, 18, 25; and
- the European Union word trademark THE ATTICO, registration No. 018053975 filed on April 19, 2019, and registered on August 3, 2019, for goods and services in International Classes 3, 9 and 35.

The Complainant owns the domain name <theattico.com> where it promotes and sells its goods.

The disputed domain name <theatticoshop.com> was registered on December 9, 2021. At the time of filing the Complaint, the disputed domain name resolved to a commercial website promoting highly discounted fashion articles, such as clothing, footwear, and bags, with each item description in the form of “The Attico (description of the product)”, reproducing the Complainant’s THE ATTICO mark at the top of the home page and inviting Internet users to subscribe to a newsletter.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its well-known trademark THE ATTICO, that the Respondent has no rights or legitimate interests in the disputed domain name and that the Respondent registered and is using the disputed domain name in bad faith, *i.e.*, to sell counterfeit products. The Complainant requests the transfer of the disputed domain name to it.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

In view of the Respondent’s default, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the THE ATTICO and ATTICO trademarks.

The disputed domain name <theatticoshop.com> incorporates the Complainant's trademarks THE ATTICO and ATTICO in their entirety with an additional term "shop". However, such addition does not prevent a finding of confusing similarity as the Complainant's trademarks are clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) to a trademark in a domain name would not prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

It is well established in decisions under the UDRP that the generic Top-Level Domain ("gTLD") (e.g., ".com", ".org") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name.

Given the above, the Panel finds that the disputed domain name <theatticoshop.com> is confusingly similar to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the marks THE ATTICO and ATTICO, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, "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". See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case.

There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain name or that the Respondent has made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use under the disputed domain name.

According to the evidence provided in Annex 7 to the Complaint, the Respondent has used the disputed domain name in connection with a commercial website selling apparent THE ATTICO branded goods (at a very low price comparing to the Complainant's own goods, with the Complainant claiming that the products sold via the disputed domain name are counterfeits).

The sale of counterfeit goods can never confer rights or legitimate interests on a respondent. See section 2.13 of the [WIPO Overview 3.0](#). The Panel notes some indicia that the goods sold on the website at the disputed domain name may be counterfeits, if so the Respondent does not have rights or legitimate interests, but the Panel will also make an analysis of this case under the possibility that those were genuine THE ATTICO branded goods.

In certain cases, UDRP panels have recognized that resellers, distributors using a domain name containing a complainant's trademark to undertake sales related to complainant's goods may constitute a *bona fide* offering of goods and thus have a right or legitimate interest in such domain name. Accordingly, in this case,

the key question under this element is whether the Respondent's use of the disputed domain name amounts to a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy.

The current state of UDRP panel consensus in relation to this issue is summarized in section 2.8 of the [WIPO Overview 3.0](#), based on panel decisions such as *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). According to the "Oki Data" test, several cumulative requirements will be applied in the specific conditions of a UDRP case, including the fact that the site must accurately and prominently disclose the registrant's relationship with the trademark holder (the complainant) and that the respondent must use the site to sell only the trademarked goods or services. In this case, according to the available record, on the website corresponding to the disputed domain name there is no indication regarding the relationship between the Parties, or lack thereof.

This is definitely not an activity falling under the circumstances listed by paragraph 4(c) of the UDRP as demonstrating the Respondent's rights or legitimate interests in the disputed domain name.

In addition, the nature of the disputed domain name, comprising the Complainant's trademarks in combination with an additional term related to the Complainant's business, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Consequently, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds registered trademark rights for ATTICO and THE ATTICO since at least 2016 and 2019 respectively, its trademarks have gained reputation in the fashion industry.

The disputed domain name was created in 2021 and incorporates the Complainant's marks together with a dictionary term closely related to the Complainant's business, "shop". The website at the disputed domain name also features the Complainant's THE ATTICO trademark, logo and purportedly offers THE ATTICO brand products.

For the above, the Panel finds that the disputed domain name was registered in bad faith, with the Respondent's knowledge of the Complainant, its business, and particularly targeting its trademarks.

At the time of filing the Complaint, the Respondent was using without permission the Complainant's THE ATTICO trademark in order to get traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant. This impression is created particularly by the incorporation of the Complainant's trademarks in the disputed domain name together with a descriptive term "shop", the content on the website provided thereunder, which includes the Complainant's trademarks and purports to sell THE ATTICO brand products, and the lack of any disclaimer on this website.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] web site or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] web site or location or of a product or service on [the respondent's] web site or location" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's trademark and the website operated under the disputed domain names displays the Complainant's trademarks and purportedly offers THE ATTICO brand goods, indeed in this Panel's view, the Respondent has intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademarks.

The Respondent has not participated in the present proceedings in order to put forward any arguments in its favor and apparently provided false contact details in the Whois because the Written Notice could not be delivered to the Respondent by courier service. Such facts, together with all the other elements in this case, supports, in the eyes of this Panel, a finding of bad faith behavior.

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 <theatticoshop.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: November 16, 2022