

ADMINISTRATIVE PANEL DECISION

AUTRY International S.r.l. v. Unknown (Whois Agent) / Kuehp Tgfdeu
Case No. D2022-0879

1. The Parties

The Complainant is AUTRY International S.r.l., Italy, represented by LEGANCE Avvocati Associati, Italy.

The Respondent is Whois Agent, Domain Protection Services, Inc., United States of America (“United States” or “U.S.”) / Kuehp Tgfdeu, China.

2. The Domain Name and Registrar

The Disputed Domain Name <scontoautry.com> is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2022. On March 14, 2022, the Center transmitted, by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 21, 2022, the Registrar transmitted, by email to the Center, its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 22, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 22, 2022.

The Center verified that the Complaint together with the amended Complaint 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 that the proceedings commenced on March 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was set to April 14, 2022. The Respondent did not submit any response. Accordingly, on April 19, 2022 the Center notified the parties of the Respondent’s default as of that date.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on April 25, 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

As reflected in the registration record for the Disputed Domain Name in the public Whois database (a copy of that record appears in Annex 2 to the Complaint), the Disputed Domain Name was registered on February 17, 2022 and the registration will expire on February 17, 2023.

A. The Complainant's AUTRY Marks

As indicated in the Complaint, the Complainant owns various U.S., European, and International trademark registrations collectively for the term "AUTRY" both in block letters alone and in stylized form, the latter with either with a design element or additional text (all referred to herein as the "AUTRY Marks"). The Complainant has provided, in Annexes 7-11 to the Complaint, copies of its registration certificates for these registrations. Pertinent details of illustratively two of these registrations are as follows:

- i. AUTRY (block letters)
United States Registration No. 5,645,745; registered: January 1, 2019

This trademark is registered for use in connection with: "Walking sticks; Umbrellas and parasols; Luggage; all-purpose carrying bags; wallets; suitcases; travelling bags; Leather straps; Straps made of imitation leather; Bags for sports; Bags for sports clothing; Leather pouches; Haversacks; Suitcases with wheels; Daypacks; School bags; Rucksacks; Backpacks; Sports packs", all in international class 18; and "Clothing, namely, tops, bottoms, suits, jackets, shirts, T-shirts, dresses; Sports clothing, namely, sport coats, sport stockings, sport shirts, sports jerseys, sports shirts, sports jackets, sports vests, breeches for sports, sports shirts with short sleeves, T-shirts, polo shirts, leggings; Footwear; Headgear, namely, headwear", all in international class 25.

- ii. AUTRY (block letters)
European Registration No. 17916957; registered: September 25, 2018

This trademark is registered for use in connection with: "Walking sticks; Umbrellas and parasols; Luggage, bags, wallets and other carriers; Straps (Leather); Straps made of imitation leather; Sport bags; Bags for sports clothing; Holdalls for sports clothing; Bumbags; Haversacks; Sport bags; Wheeled suitcases; Daypacks; Backpacks; Sports packs", all in International class 18; and "Clothing; Footwear; Headgear", all in international class 25.

B. The Parties and their activities

The Complainant was established on May 24, 2018 and operates in the fashion and luxury sector, manufacturing and marketing worldwide – including through its website – clothing, footwear, and accessories for men, women, and children. Since its establishment, the Complainant uses the term "AUTRY" as its company name, trademark and both as its domain name or as a component of various other domain names it owns, the latter typified by <autry-usa.com>. Hard-copy printouts of the home and several lower level pages from the Complainant's <autry-usa.com> website appear in Annex 14 to the Complaint. Annex 16 to the Complaint provides copies of Whois registration records for various other AUTRY-based domain Name which the Complainant owns, e.g., <autry-people.com>, <autryteam.com>, and <autrywear.it>.

As one way of promoting its business, the Complainant posts to social networks Instagram and Facebook (hard-copy printouts of webpages from these networks are provided in Annexes 17 and 18, respectively) and has done so since December 23, 2019 and June 7, 2019, respectively (hard-copy printouts of webpages

from those dates and on those networks are provided in Annexes 19 and 20, respectively). The Complainant's Instagram page has 72,600 followers, while its Facebook page has 3,545 likes. Through the sale of its products, the Complainant generated revenues of EUR3,208,461 in 2020 and EUR 19,768,549 in 2021. Its "AUTRY" brand has been subject of a number of articles in web publications (copies of illustrative articles in Italy and other countries appear in Annexes 21 and 22-24, respectively).

The Complainant, during the course of undertaking routine online surveillance, recently discovered the existence of the Respondent's website at the Disputed Domain Name (hard-copy printouts of pages from that site appear in Annex 26 to the Complaint). The Respondent is it not a distributor of the Complainant, nor a licensee nor has the Complainant authorized the Respondent to use the mark "AUTRY". Through its website, the Respondent advertises and sells counterfeited goods under the mark "AUTRY" at low prices – compared to the Complainant's pricing, using the very same pictures, logo and layout that the Complainant uses on its own website.

The Complainant attempted to contact the Respondent directly, sending a cease and desist message to the email address shown on Whois database for the Disputed Domain Name, but has not received any response. A copy of the message appears in Annex 27 to the Complaint.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the Disputed Domain Name is confusingly similar to its mark AUTRY.

Specifically, the Disputed Domain Name contains this mark prepended by the term "sconto", with the latter being a descriptive Italian word meaning "discount" (in English) and thus incapable of adding sufficient distinctiveness whatsoever to the mark to mitigate any resulting confusion of online users between the name and the mark. The Complainant notes that, under standard practice, the generic top-level domain (gTLD) present in the name, *i.e.*, ".com", is ignored, as a standard registration requirement, in assessing confusingly similarity under the Policy.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

Specifically, the Respondent is not licensed or otherwise authorized by the Complainant to use any of its AUTRY Marks. Moreover, the name resolves to the Respondent's website through which the Respondent advertises and sells counterfeit products of the Complainant for its own commercial benefit and, in so doing, uses webpages that contain logos, pictures, and layout of the Complainant's website. This high similarity, in turn, creates considerable consumer confusion with the Complainant's mark as to source, sponsorship, affiliation, or endorsement with an aim of misleadingly diverting consumers from the Complainant's website to that of the Respondent. This use of the name in conjunction with the Respondent's website is likely to infringe the Complainant's exclusive rights in its AUTRY Marks, and as such does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use.

Further, the Respondent has never been commonly known by any name, trade name or domain name that incorporates the term AUTRY, nor could it be given that the Complainant's exclusive trademark rights in its mark AUTRY began well prior to the February 17, 2022 date on which the Respondent registered the

Disputed Domain Name and the Complainant acquired global reputation and market recognition in that mark during the intervening time frame.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the Disputed Domain Name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent registered the Disputed Domain Name on February 17, 2022 several years after the Complainant began using its mark "AUTRY" as its company name and mark and also first registered that mark. The Respondent, obviously with full knowledge of the worldwide reputation which the Complainant acquired through its mark during those prior years, intentionally chose the name for its ability to cause considerable consumer confusion between the Complainant's AUTRY Marks and the Disputed Domain Name. This intent is clearly evident in Respondent's use of the name to resolve to its website which closely resembles the Complainant's website wherein the Respondent copied logos, pictures and layout of the Complainant's website into its own site and through which the Respondent, for its own commercial benefit or that of a third-party, advertises and sells to online consumers counterfeit goods at significantly discounted prices.

Clearly, the Respondent is using the Disputed Domain Name to intentionally attract online users by creating a likelihood of confusion with the Complainant's AUTRY Marks as to the source, sponsorship, affiliation or endorsement of the parties' websites. The resulting implication arising in the mind of such a consumer is that the Respondent is either of or in some way associated with the Complainant. Such a consumer is therefore invited to do business falsely and deceptively believing that it is doing so with either the Complainant itself or someone authorized on its behalf in relation to its goods – when in fact it is not and is dealing with the Respondent.

Thus, the Complainant contends that this conduct by the Respondent constitutes bad faith registration and use under paragraph 4(b)(iv) of the Policy.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a), and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's mark AUTRY.

From a simple comparison of the Disputed Domain Name to the Complainant's mark AUTRY, no doubt exists that the name is confusingly similar to the mark. The name consists of this mark to which the common Italian word "sconto" meaning "discount" in English has been prepended to form a composite term and then to which the gTLD ".com" has been appended. The addition of the gTLD is irrelevant in assessing confusing similarity under paragraph 4(a)(i) of the Policy and thus ignored. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 1.7 and 1.11.

It is now very well-established, that a minor variation to a mark, including a minor addition to it such as a commonly understood word does not prevent confusing similarity. Here, the Respondent's addition of the word "sconto", which carries a common English meaning of "discount", to the Complainant's mark to form the Disputed Domain Name unquestionably constitutes such a minor variation and does not prevent a finding of

confusing similarity. See [WIPO Overview 3.0](#), section 1.8, and, e.g., *Universal Services of America, LP d/b/a Allied Universal v. This Domain May be for Sale at https://www.networksolutions.com*, *New Ventures Services, Corp.*, WIPO Case No. D2019-083;

Moreover, as is relevant to the second and third elements, the addition of the word “sconto”, rather than ameliorating consumer confusion, significantly accentuates it as the meaning of the Disputed Domain Name intentionally conveyed to and perceived by online consumers is that of a website, likely affiliated in some fashion with the Complainant, through which the Complainant is offering discounted versions of its own AUTRY-branded products to those consumers – when, in fact, the site offers discounted counterfeit goods instead.

Hence, the Complainant satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the Disputed Domain Name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant’s mark AUTRY in either a domain name or any other use and has no relationship, affiliation, or connection whatsoever with the Respondent.

Further, it is clearly evident to the Panel that the Respondent has not used the Disputed Domain Name in connection with a *bona fide* offering of goods or services or made any prior demonstrable preparations to do so. Rather, the Respondent uses the name, which totally incorporates the Complainant’s mark AUTRY, to resolve to its website through which the Respondent offers for sale counterfeit versions of the Complainant’s AUTRY-branded goods. Using a domain name in a manner that intentionally infringes the exclusive trademark rights of another fails to qualify as a *bona fide* use generally but also specifically under UDRP paragraph 4(c)(i). Nor does such a use constitute either a legitimate noncommercial or fair use of the Disputed Domain Name under UDRP paragraph 4(c)(iii).

Given the Complainant’s exclusive rights in its mark AUTRY, which predate the date (February 17, 2022) on which the Respondent registered the Disputed Domain Name, and the recognition, reputation and good-will which the Complainant likely developed in its AUTRY Marks over the prior 3 1/2 years since the Complainant first starting using its mark AUTRY, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to those of the Complainant - at least for the goods provided by the Complainant under any of those marks - by selling counterfeit goods. See, e.g., *Universal Services of America, LP d/b/a Allied Universal v. This Domain May be for Sale at https://www.networksolutions.com*, *New Ventures Services, Corp.*, WIPO Case No. [D2019-0834](#); *Praxis Capital, Inc. v. John C. Martinez, The Praxeology Group LLC*, WIPO Case No. [D2019-0254](#); *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. [D2015-1527](#); and *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. [D2015-0787](#). Consequently, the Respondent is not commonly known by the Disputed Domain Name or any of the Complainant’s marks and hence does not qualify under UDRP paragraph 4(c)(ii).

Hence, the Respondent does not fall within any of paragraphs 4(c)(i) to 4(c)(iii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent’s actions with respect to the Disputed Domain Name constitute bad faith registration and use.

It is categorically clear to the Panel, even apart from any inference that could be drawn from the lack of any Response, that the Respondent was well aware of the Complainant and its mark AUTRY and the

considerable potential for the Disputed Domain Name to cause confusion with the Complainant's mark. Yet, in spite of that knowledge, the Respondent intentionally and purposely registered the name for its potential to cause confusion and to commercially benefit therefrom.

The Respondent's bad faith registration and use becomes patently obvious from collectively viewing several factors present here. First, the Complainant offered its AUTRY-branded goods for approximately 3 1/2 years prior to the Respondent entering the Complainant's market. Furthermore, the Respondent did not enter the market with legitimate goods competitive with those of the Complainant, but rather with counterfeit goods bearing the Complainant's mark AUTRY. Second, not only did the Respondent offer such goods, it did so under a domain name that identically incorporated the Complainant's mark AUTRY preceded by a word meaning "discount". This, in turn, was intentionally designed to opportunistically and deceptively divert online customers from the Complainant's website to the Respondent's own site at which they reasonably believed they would be purchasing legitimate, though reduced-price, versions of the Complainant's goods, but unbeknownst to them, were actually offered counterfeit versions of those very same goods. Third, to heighten the ensuing confusion and deceptive diversion, the Respondent copied into its website pictures, logos and layout from the Complainant's website, thus further creating the deceptive impression that its site was somehow connected with, sponsored or endorsed by or affiliated with the Complainant's website – when, in fact, it was not.

By doing so, the Respondent relied on online consumers, upon entering the Disputed Domain Name into their respective browsers and subsequently being diverted to the Respondent's website, becoming confused, by the confusing similarity between the Disputed Domain Name and the Complainant's mark as well as the two websites, as to the origin and legitimacy of the Respondent's goods and particularly whether those goods emanated from the Complainant - when they did not, or were somehow connected with, sponsored by or associated with the Complainant - when, in fact, they were not, all to the Complainant's detriment.

The Respondent likely derived revenue or other monetary benefit from the counterfeit goods it offered through its website, thus profiting from the confusion it intentionally caused and, through doing so, opportunistically exploited the Complainant's goodwill and reputation for its own benefit.

Consequently, the Respondent's conduct constitutes bad faith registration and use under paragraphs 4(b) and specifically 4(b)(iv) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient evidence of its allegations, with respect to the Disputed Domain Name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The Panel now orders that the Disputed Domain Name <scontoautry.com> be transferred to the Complainant.

/Peter L. Michaelson/

Peter L. Michaelson

Sole Panelist

Date: May 9, 2022