

ADMINISTRATIVE PANEL DECISION

Get Weird, LLC v. Francesca Di Buono
Case No. D2022-1210

1. The Parties

The Complainant is Get Weird, LLC, United States of America (“United States”), represented by Società Italiana Brevetti S.p.A., Italy.

The Respondent is Francesca Di Buono, Italy.

2. The Domain Name and Registrar

The disputed domain name <antisocialsocialclub.shop> is registered with eNom, Inc. dba Dynames.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2022. On April 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 6, 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.

The Center verified that the 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 the proceedings commenced on April 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 10, 2022.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on May 20, 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 operates since 2015 in the clothing and accessories industries, commercializing its products internationally over various online platforms as well as its own website “www.antisocialsocialclub.com” (registered on July 21, 2014), under the trademark ANTI SOCIAL SOCIAL CLUB.

The Complainant has secured trade mark registrations for ANTI SOCIAL SOCIAL CLUB in several jurisdictions including, by way of example, European Union Trade Mark Registration No. 018260581, ANTI SOCIAL SOCIAL CLUB (wordmark), registered on November 27, 2020, in Classes 9, 10, 14, 21, 24, 28, 34, and 35, and United States Trade Mark Registration No.5,046,740, registered on September 20, 2016, for goods in class 25, including short-sleeved or long-sleeved t-shirts and hooded sweatshirts (collectively the “Trademark”).

The disputed domain name was registered on September 14, 2021.

The disputed domain name resolves to a website that is a clone of the Complainant’s website “www.antisocialsocialclub.com”, where the Respondent is offering clothing, hats and accessories under the Trademark.

5. Parties’ Contentions

A. Complainant

The Complainant states, in summary and in so far as relevant, the following.

Due to extensive use and promotion of the Trademark since 2015, the Complainant and its trademark have become a leading provider of streetwear fashion and clothing, developing a reputation in this field.

The disputed domain name reproduced entirely the Trademark. The only difference between the disputed domain name and the Trademark is the addition of “.shop” top level extension which, however, does not affect and cannot mitigate the confusion between the Trademark and the disputed domain name. The addition of “.shop” strengthens the likelihood of confusion as it directly refers to the Complainant’s clothing and fashion items sales services.

The Complainant says also that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent does not own any trade mark registrations for ANTI SOCIAL SOCIAL CLUB, nor has the Respondent registered this term as a corporate name in any jurisdiction. The Respondent is not a licensee, authorized retailer, or distributor of ANTI SOCIAL SOCIAL CLUB products, nor has the Complainant authorized, nor somehow given its consent to the Respondent to register and / or use the disputed domain name or the Trademark for any purpose.

The choice of the Trademark and the use of the dispute domain name to resolve to a “clone” of the Complainant’s website aims at creating a direct affiliation with the Complainant and its business. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods and services, but instead she is trying to attract Internet users through the Complainant’s widely known mark for the Respondent’s own commercial purposes. The disputed domain name reverts to a website that offers counterfeit products using the Trademark, logos and promotional images, the copyright in which is owned or exclusively licensed to the Complainant. The Respondent does this without authorization and in breach of copyright. Therefore, it is clear that there can be no legitimate interest in the sale of such counterfeit goods.

The disputed domain name was registered and is being used in bad faith. The disputed domain name was registered over four years after the first use and registration of the Trademark when the Complainant’s business with the Trademark was well established and the Trademark was already registered in several

countries. The Respondent has deliberately attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant and the Trademark. The disputed domain name deliberately incorporates the well-known Trade mark, with the mere addition of the gTLD “.shop”.

The disputed domain name resolves to a website that is a clone of the Complainant’s website. The content of both websites is identical. The Respondent’s website offers counterfeit products, instead of the Complainant’s products.

Furthermore, the Complainant disclosed that the use of the disputed domain name is involved in litigation before the Court of Genova, Italy. The Complainant had filed an appeal against an Order issued on October 23, 2021 by the first instance Judge. The dispute is between the Complainant and Anti Social Social Club Srls, docket No. 10296/2021. The Court decision is a “cautionary provisional proceeding”, similar to a preliminary injunction. The Complainant submitted a translation of the decision of December 14, 2021 of the Court of Genova, that reads *inter alia*:

“- inhibits pursuant to art. 131 of the Italian Intellectual Property Code the company Anti Social Social Club srl and its assignees from using, for any reason, the sign “ANTI SOCIAL SOCIAL CLUB” or the trademarks registered by Anti Social Social Club S.r.l.s. (“ANTISOCIAL CLUB SOCIAL” (both words and figure); “ANTI SOCIAL CLUB” (both words and figure); “ANTI S.S. CLUB” (both words and figure)) or the domain name <antisocialsocialclub.it> <antisocialsocialclub.eu> and <antisocialsocialclub.store> or other sign similar to and confusable with the trademark “ANTI SOCIAL SOCIAL CLUB” owned by Get Weird, including [...], extending this injunction order to the whole territory of the European Union.”

B. Respondent

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

6. Discussion and Findings

Dealing, first, with the Respondent’s failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under these Rules, the Panel shall be entitled to draw such inferences from this omission, as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant prove each of the following three elements in order to succeed in its Complaint:

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

A. Preliminary issue: Impact of the prior Court of Genova decision

As indicated above, the Panel notes that the Complainant has provided evidence of a prior court decision between the Complainant and the company Anti Social Social Club Srls. Where there are prior court proceedings, it is within the panel’s discretion to determine the relevance to ascribe to such proceeding in the UDRP context, in light of the case circumstances. See section 4.14.2 of the [WIPO Overview 3.0](#).

In this case, the Panel notes that the Court of Genova decision does not refer to the disputed domain name, and while some elements may be relevant to understand the broader context of this case, it is important to note that the Court of Genova decision was rendered under Italian law and not under the UDRP. Here the

Panel shall make its decision on whether the Complainant has demonstrated the three elements of the UDRP.

In any event, this Panel operating under the UDRP does not have authority to intervene in the processes or decisions of an Italian court, and notably to interpret or implement court decisions.

In this context, the Panel will disregard the outcome of the Court of Genova decision of December 2021 and will render its decision on the three elements of the UDRP.

B. Identical or Confusingly Similar

The Complainant indisputably has rights in the ANTI SOCIAL SOCIAL CLUB mark, both by virtue of its trademark registrations and as a result of its use of this Trademark in the clothing and accessories industries.

The ANTI SOCIAL SOCIAL CLUB mark is directly recognizable in the disputed domain name.

The disputed domain name incorporates the ANTI SOCIAL SOCIAL CLUB mark in its entirety, adding the gTLD “.shop”, which is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity.

Accordingly, this Panel finds that the disputed domain name is identical to the Trademark, and the first element of the Policy under paragraph 4(a) has been satisfied.

C. Rights or Legitimate Interests

This, the second element of the Policy paragraph 4(a)(ii)), essentially calls for a complainant to prove a negative, which is far from easy where the relevant information as to the respondent's rights or legitimate interests is often primarily within the knowledge of the respondent. The matter is addressed in section 2.1 of [WIPO Overview 3.0](#) as follows:

“While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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.”

This is not such a case. The facts as set out in section 5 above leave no room for doubt. The facts speak for themselves:

- the website under the disputed domain name is so similar to the Complainant's website that consumers will think they are visiting the website of the Complainant or an affiliated company;

- alleged counterfeit goods are offered on the website under the disputed domain name;

As found by the panel in *Philipp Plein v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Norma Brandon, cheaphilipplein*, WIPO Case No. [D2015-1050](#); “The Respondent's use of a domain name that is confusingly similar to the Complainant's trade marks in order to attract Internet users looking for genuine products of the Complainant's company and to offer them unauthorized copies instead is a ‘bait and switch’ strategy that lacks *bona fides* and does not give rise to rights or a legitimate interests under the Policy”. See also section 2.13.1 of the [WIPO Overview 3.0](#) which explains that “Panels have categorically held that the use of a domain name for illegal activity (*e.g.*, the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other

types of fraud) can never confer rights or legitimate interests on a respondent”.

Having regard to the above considerations, the Panel finds that the disputed domain name is not being used in connection with a *bona fide* offering of goods and services, and the second element of the Policy under paragraph 4(a) has been satisfied.

D. Registered and Used in Bad Faith

Given that the Respondent’s website is essentially a clone of Complainant’s commercial website selling what appears to be counterfeit products and the discussion above, the Panel finds that the disputed domain name has been registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

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 <antisocialsocialclub.shop> be transferred to the Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: May 30, 2022