

## **ADMINISTRATIVE PANEL DECISION**

Delticom AG v. Marlia Andrea, Check Mate On Line S.L.U.  
Case No. D2022-1311

### **1. The Parties**

The Complainant is Delticom AG, Germany, represented by Fechner Rechtsanwälte PartmbB, Germany.

The Respondent is Marlia Andrea, Check Mate On Line S.L.U., Spain.

### **2. The Domain Name and Registrar**

The disputed domain name <gommadiretto.net> is registered with OVH (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 13, 2022, the Registrar transmitted by email to the Center its verification response disclosing the 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 April 19, 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 amendment to the Complaint on April 20, 2022.

The Center also sent an email communication in English and Spanish to the parties on April 19, 2022 regarding the language of the proceedings, as the Complaint has been submitted in English and the language of the registration agreement for the disputed domain name was Spanish. The Complainant submitted a request for English to be the language of the proceedings on April 22, 2022. The Respondent did not comment on the language of the proceedings.

The Center verified that the Complaint together with the amendment to 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 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 16, 2022.

The Center appointed Kiyoshi Tsuru 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.

### 3.1 Language of the Proceedings

The Complaint was filed in English. The Complainant affirmed that the language of the Registration Agreement was French. However, the Registrar stated that the language of the Registration Agreement of the disputed domain name was Spanish.

In accordance with paragraph 11 of the Rules, the language of the proceedings must be the language of the Registration Agreement, unless otherwise agreed by the Parties, and subject to the Panel's decision, considering the circumstances of the case.

In the Complaint, and in its communication to the Center of April 22, 2022, the Complainant requested English to be the language of the proceedings. The Respondent did not reply to the Language of Proceedings communication and did not file a Response. Therefore, there is no agreement between the parties on the language of the proceeding.

In the present case, the Complainant proved that in *Delticom AG v. Krasimir Kalushkov, Megarella Ltd.*, WIPO Case No. [D2021-4113](#), Check Mate On Line S.L.U. sent, on March 9, 2022, an email in English to the Center and the Registrar concerning the disputed domain name "gommadiretto.com".

Based on this evidence, it can be inferred that the Respondent understands and can communicate in the English language.

Taking this fact into account, and in order to preserve the spirit of the Policy, which is to provide an agile, expedite, and low-cost proceeding, the Expert determines that the language of the proceeding shall be English.

## 4. Factual Background

The Complainant is an online distributor of tires and wheels, founded in 1999.

The Complainant holds the following trademark registrations:

| Trademark    | No. Registration | Jurisdiction   | Date of Registration | International Classes |
|--------------|------------------|----------------|----------------------|-----------------------|
| GOMMADIRETTO | 006827927        | European Union | January 12, 2009     | 12, 35, 39            |
| GOMMADIRETTO | UK00906827927    | United Kingdom | January 12, 2009     | 12, 35, 39            |

The Complainant owns the domain name "gommadiretto.it", which was registered on July 22, 2003.

The disputed domain name was registered on February 17, 2022, and resolves to a website that offers for sale tires online.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant argued the following:

That it is an online distributor of tires and wheels, founded in 1999, with headquarters in Hanover, Germany,

That its portfolio ranges from about 600 different brands, and 40,000 tire models, for cars and motorcycles.

That it operates 351 online stores, and has online platforms in 73 countries, serving more than 16 million customers.

That it has over 38,000 workshop partners, where the tires can be fitted to customers' cars.

That in late 2021 several customers brought to the Complainant's attention the existence of the domain name <gommadiretto.com> since they had had bad experiences when buying tires from the website to which the mentioned domain name resolved.

That the Complainant tried to stop this infringement by sending a warning letter to the Respondent.

That, since the Respondent did not reply to the letter, the Complainant had to file a UDRP complaint, which was resolved on March 1, 2022, *Delticom AG v. Krasimir Kalushkov, Megarella Ltd.*, WIPO Case No. [D2021-4113](#), transferring the domain name <gommadiretto.com> to the Complainant.

That the Respondent moved its website from "gommadiretto.com" and is now operating through the disputed domain name.

### **I. Identical or Confusingly Similar**

That the Complainant is the owner of trademark registrations for GOMMADIRETTO.

That the Complainant is entitled to prevent the Respondent from using its trademark.

That the disputed domain name is identical to the GOMMADIRETTO trademark.

That the goods and services offered by the Respondent through the website to which the disputed domain name resolves, are identical to the goods and services protected by the Complainant's trademark.

### **II. Rights or Legitimate Interests**

That the Respondent has no rights to or legitimate interests in the disputed domain name, since it unlawfully infringes the Complainant's trademark.

That the Complainant's domain name <gommadiretto.it> was registered in 2003, long before the date of registration of the disputed domain name.

That under the <gommadiretto.it> domain name, the Complainant runs a well-known tire-selling business.

That the Respondent uses the Complainant's good name and hard-earned reputation to sell its inferior products and services.

### III. Registered or Used in Bad Faith

That the Respondent used the formerly disputed domain name <gommadiretto.com> to make a parasitic use of the Complainant's reputation, for the Respondent's commercial gain.

That, by the time the disputed domain name was registered, the Respondent already knew of the commencement of *Delticom AG v. Krasimir Kalushkov, Megarella Ltd.*, WIPO Case No. [D2021-4113](#) case, which resulted in the transfer of the domain name <gommadiretto.com> to the Complainant. That this shows that the Respondent is willingly infringing the Complainant's rights.

That the website to which the disputed domain name resolves has notable similarities to the Complainant's website.

That the Respondent has intended to mislead and divert Internet customers to the Respondent's website, for commercial gain.

### B. Respondent

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

## 6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant is required to prove that each of the three following elements is satisfied:

- (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 was registered and is being used in bad faith.

Given the Respondent's failure to submit a formal Response, the Panel may decide this proceeding based on the Complainant's undisputed factual allegations, in accordance with paragraphs 5(f), 14(a), and 15(a) of the Rules, (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#)).

### A. Identical or Confusingly Similar

The Complainant owns trademark registrations for the GOMMADIRETTO trademark, including a registration in the European Union, to which Spain belongs, where the Respondent has declared to have its domicile.

The disputed domain name is identical to the Complainant's trademark GOMMADIRETTO, as it includes said trademark entirely (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"); see also *Alfred Dunhill, Inc. v. Registration Private, Domains By Proxy, LLC / Abdullah Altubayieb*, WIPO Case No. [D2017-0209](#); *Hoffmann-La Roche Inc. v. #1 Viagra Propecia Xenical & More Online Pharmacy*, WIPO Case No. [D2003-0793](#); *F. Hoffmann-La Roche AG v. Softech Ltd., DNS Administrator (gold)*, WIPO Case No. [D2007-1699](#); and *F. Hoffmann-La Roche AG v. P Martin*, WIPO Case No. [D2009-0323](#)).

The addition of the generic Top-Level Domain ("gTLD") ".net" to the disputed domain name constitutes a technical requirement of the Domain Name System. Thus, it has no legal significance in assessing identity or confusing similarity in the present case (see *CARACOLITO S SAS v. Nelson Brown, OXM.CO*, WIPO Case No. [D2020-0268](#); *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO

Case No. [D2015-0565](#); and *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#)).

In light of the above, the first element of the Policy has been met.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy sets forth the following examples as circumstances where a respondent may have rights or legitimate interests in the disputed domain name:

(i) before any notice to the respondent of the dispute, the use by the respondent of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it did not acquire trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The case file contains no evidence that demonstrates that the Respondent has used or has made demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services (see *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#); and *Rolex Watch U.S.A., Inc. v. NCSO*, WIPO Case No. [D2010-0948](#)).

The website to which the disputed domain name resolves predominantly displays the Complainant's GOMMADIRETTO trademark. This shows that the Respondent has attempted to impersonate the Complainant. In addition, the Panel notes that the composition of the disputed domain name carries a risk of implied affiliation since Internet users may think that the website to which this disputed domain name resolves is affiliated to or sponsored by the Complainant, which cannot be deemed as a *bona fide* offering of goods.

Thus, given the circumstances, and considering that the Respondent has intended to confuse Internet users into believing that the website to which the disputed domain name resolves is related to the Complainant, this Panel considers that the Respondent has attempted to impersonate the said Complainant. The consensus view among panels appointed under the Policy is that the use of a domain name for illegal activity, such as impersonation or passing off, cannot confer rights to, or legitimate interests in a domain name (see section 2.13.1 of the [WIPO Overview 3.0](#); see also *Self-Portrait IP Limited v. Franklin Kelly*, WIPO Case No. [D2019-0283](#); *Seminole Tribe of Florida, d / b / a Seminole Gaming v. Privacy Protect, LLC / Ibro King, Akara Inc*, WIPO Case No. D2018 1692; *Allianz SE v. Paul Umeadi, Softcode Microsystems*, WIPO Case No. [D2019-1407](#); *SVB Financial Group v. WhoisGuard Protected, WhoisGuard, Inc. / Citizen Global Cargo*, WIPO Case No. [D2018-0398](#); and *Haas Food Equipment GmbH c. Usman ABD, Usmandel*, WIPO Case No. [D2015-0285](#)).

The Complainant has established a *prima facie* case asserting that the Respondent lacks rights to or legitimate interests in the disputed domain name. The Respondent did not submit any evidence or arguments to challenge the Complainant's assertions.

Therefore, the second element of the Policy has been fulfilled.

### C. Registered and Used in Bad Faith

According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, shall be evidence of registration and use in bad faith:

(i) circumstances indicating that the respondent has registered or the respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 its web site or location.

The fact that the Respondent registered the disputed domain name which entirely reproduces the Complainant's GOMMADIRETTO trademark, shows that the Respondent has targeted the Complainant and its business, which constitutes opportunistic bad faith (see section 3.2.1 of the [WIPO Overview 3.0](#); see also *L'Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter*, WIPO Case No. [D2018-1937](#); *Gilead Sciences Ireland UC / Gilead Sciences, Inc. v. Domain Maybe For Sale c/o Dynadot*, WIPO Case No. [D2019-0980](#); *Dream Marriage Group, Inc. v. Romantic Lines LP, Vadim Parhomchuk*, WIPO Case No. [D2020-1344](#); and *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#)).

In addition, the Panel notes that the disputed domain name was registered on February 17, 2022, and that the complaint in *Delticom AG v. Krasimir Kalushkov, Megarella Ltd.*, WIPO Case No. [D2021-4113](#) was notified on January 12, 2022 (and that the Respondent answered in that proceeding on January 15, 2022), which affirms the Respondent's targeting of the Complainant's trademark.

The facts comprised in the case file also show that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to the website to which the disputed domain name resolves, by creating the impression among Internet users that said website is related to, associated with, or endorsed by the Complainant, which constitutes bad faith under paragraph 4(b)(iv) of the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#); see also *trivago GmbH v. Whois Agent, Whois Privacy Protection Service, Inc. / Alberto Lopez Fernandez, Alberto Lopez*, WIPO Case No. [D2014-0365](#); and *Jupiter Investment Management Group Limited v. N/A, Robert Johnson*, WIPO Case No. [D2010-0260](#)).

The Respondent's attempt to impersonate the Complainant for commercial gain also constitutes bad faith under the Policy (see *Philip Morris Products S.A. v. Domain Administrator, Registrant of iqosatismaganiz.com (apiname com) / Anl Girgin, Teknoloji Sarayi*, WIPO Case No. [D2019-0466](#); *Self-Portrait IP Limited v. Franklin Kelly, supra*; and *Friedman and Soliman Enterprises, LLC v. Gary Selesko, M&B Relocation and Referral, LLC*, WIPO Case No. [D2016-0800](#)).

Therefore, the third element of the Policy has been met.

## **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, <gommadiretto.net> be transferred to the Complainant.

*/Kiyoshi Tsuru/*

**Kiyoshi Tsuru**

Sole Panelist

Date: June 3, 2022