

## **ADMINISTRATIVE PANEL DECISION**

Renner Italia S.p.A. v. Louis Jasso, Jasso Sales Group  
Case No. D2022-1827

### **1. The Parties**

The Complainant is Renner Italia S.p.A., Italy, represented by Bugnion S.A., Italy.

The Respondent is Louis Jasso, Jasso Sales Group, United States of America (“United States”).

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

The disputed domain name <rennerproducts.com> (the “Disputed Domain Name”) is registered with Wix.com Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 20, 2022. On May 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 24, 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 May 25, 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 May 30, 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 the proceedings commenced on June 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 23, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on June 27, 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 is a company incorporated under the laws of Italy that operates a business manufacturing and selling chemical products across 63 countries for the preparation of varnishes, impregnating agents and solvents for wood and metals, varnishes, lacquers, impregnating agents, solvents, all for wood and metals with sales of EUR 122 million in 2020. The Complainant holds registrations for the trademark RENNER in numerous jurisdictions including, for example: International Trademark Registration No. 923733 for RENNER, registered on March 9, 2007.

The Complainant owns numerous domain names that incorporate its trademark including <renneritalia.eu> registered on July 9, 2006.

The Disputed Domain Name was registered on January 13, 2022.

The Disputed Domain Name resolved to a website which purported to offer for sale the same or similar products to the ones available at the Complainant's main website. At the time of the Decision, the Disputed Domain Name redirects to another website with the same content.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant cites its Italian trademark No. 1579330 registered on February 3, 2006 and other registrations in Italy and internationally for the mark RENNER as *prima facie* evidence of ownership.

It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the RENNER trademark and that the similarity is not removed by the addition of the word "products", or the addition of the generic Top-Level Domain ("gTLD") ".com".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it resolved to a webpage displaying the Complainant's trademark and has not authorised the Respondent to register a domain name containing its trademark.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules and submits that the Respondent was aware of the trademark RENNER and that "the Complainant's mark 'RENNER' is inherently distinctive at a high level and is widely known in the field of paints and varnishes, the Respondent cannot credibly claim to have been unaware of the mark as it is apparent that the Respondent knew, or should have known, that its registration would be identical to the Complainant's mark". The Complainant also contends that "products belonging to the Complainant are sold and, therefore, this circumstance may lead the consumer to believe that, in addition to a business relationship, there exists an association between the Complainant and the Respondent [...] and that [...] all technical data sheets concern products bearing the trademark RENNER [...] contributes to assume that the (Disputed Domain Name) is intended for the selling of Renner products."

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

### **A. Identical or Confusingly Similar**

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark RENNER in numerous jurisdictions, including Italy. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.1.2).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the RENNER trademark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant's trademark RENNER; (b) with the additional word "products"; (c) followed by the gTLD ".com".

It is well established that the gTLD used as technical part of a domain name may be disregarded. (see [WIPO Overview 3.0](#), section 1.11). The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "rennerproducts".

It is also well established that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing under the first element (see [WIPO Overview 3.0](#), section 1.7).

It is also well established that where the relevant trademark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see [WIPO Overview 3.0](#), section 1.8).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

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

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because "it has never authorized whoever to register the [Disputed Domain Name]

and that there is no use of the [Disputed] Domain Name in connection with a *bona fide* offering of goods or services”.

Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name (see [WIPO Overview 3.0](#), section 2.8).

The Respondent is not commonly known by the Disputed Domain Name. Nor is the Respondent an authorized reseller with legitimate interests in a domain name incorporating the Complainant’s mark. Nor does the site accurately and prominently disclose the registrant’s relationship with the trademark holder, a requirement of the test recognised by numerous panels set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (see [WIPO Overview 3.0](#), section 2.8.1).

The Panel is satisfied that the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. In the absence of a response, or any other kind of denial with evidence to the contrary, this Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Panel finds for the Complainant on the second element of the Policy.

### **C. Registered and Used in Bad Faith**

The third element of the Policy requires that the Complainant must also demonstrate that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the content of the website it resolves to, the Panel is satisfied that the Respondent knew of the Complainant’s trademark RENNER when it registered the Disputed Domain Name (see *Renner Italia S.p.A. v. wang qing shui (王清水)*, WIPO Case No. [D2020-2186](#) (“In light of the evidence of the Respondent’s previous use of the Website in the manner described above, the distinctiveness of the Trade Mark, and the fact that the disputed domain name was registered many years after the registration of the Trade Mark, the Panel finds that, in all the circumstances, the requisite element of bad faith has been satisfied”).

In addition, the gap of several years between registration of the Complainant’s trademark and the Respondent’s registration of the Disputed Domain Name, along with the composition of the Disputed Domain Name (containing the Complainant’s trademark in its entirety) in the circumstances of this case is a further indicator of bad faith. (See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Complainant’s rights in its trademark predate any rights that could possibly flow from the Respondent’s registration of the Disputed Domain Name by at least 16 years.

On the issue of use, the Complainant’s evidence is that the Disputed Domain Name previously resolved to a website that displayed the Complainant’s trademark, and currently redirects to another website with the same content. This Panel accepts the Complainant’s evidence that the Disputed Domain Name resolved to a website displaying the Complainant’s trademark as evidence that the Respondent was well aware of the Complainant’s trademark RENNER when registering the Disputed Domain Name and has used it in bad faith.

In the absence of any evidence to the contrary, this Panel accepts the Complainant’s evidence and finds that the Respondent has used the Complainant’s trademark RENNER for the Disputed Domain Name, without the Complainant’s consent or authorization, for the very purpose of unfairly capitalizing on the reputation of

the trademark by infringing upon the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements 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 <rennerproducts.com> be transferred to the Complainant.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: July 4, 2022