

ADMINISTRATIVE PANEL DECISION

Benetton Group S.R.L. v. Client Care, Web Commerce Communications Limited

Case No. D2023-1769

1. The Parties

The Complainant is Benetton Group S.R.L., Italy, represented by Studio Barbero S.p.A., Italy.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <benettonargentina.com>, <benettonaustralia.com>, <benettoncanada.com>, <benettonchile.com>, <benettoncolombia.com>, <benettonespana.com>, <benettonitalia.com>, <benettonnz.com>, <benettonphilippines.com>, <benettonportugal.com>, <benettonsingapore.com>, <benettonsouthafrica.com>, <benettonuae.com>, <unitedcolorsofbenettonmexico.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 24, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint (Not Disclosed). The Center sent an email communication to the Complainant on May 1, 2023, 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 May 3, 2023.

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 May 4, 2023. In accordance with the Rules, paragraph 5,

the due date for Response was May 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 25, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on June 19, 2023. 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 an Italian fashion company founded in 1965 by the Benetton siblings Luciano, Gilberto, Giuliana, and Carlo, having expanded between the 1970s and 1980s, opening many shops all over the world, including Europe, United States of America, and Japan, and exporting 60% of its products, what lead it to become present, as of 2019 in 81 countries with approximately 4500 shops around the world.

The Complainant holds, amongst others, the domain name <benetton.com> (registered on September 5, 1996) incorporating the BENETTON trademark subject of the following, amongst others, trademark registrations:

- International trademark registration No. 912997 for the word mark BENETTON, registered on December 18, 2006, subsequently renewed, in classes 3, 9, 14, 18, 25, and 28;
- United States of America trademark registration No. 3,536,086 for the word mark BENETTON, filed on September 20, 2007, registered on November 25, 2008, subsequently renewed, in classes 18, and 25;
- International trademark registration No. 503845 for the word mark UNITED COLORS OF BENETTON, registered on July 18, 1986, subsequently renewed, in classes 3, 9, 14, 16, 18, 23, 24, and 25; and
- European Union trademark registration No. 011102555 for the word mark UNITED COLORS OF BENETTON, filed on August 7, 2012, registered on April 1, 2013, in classes 3, 9, 14, 16, 18, 24, 25, and 35.

The disputed domain names were registered on and were used in connection with:

Disputed Domain Name	Registration Date	Use at the time of filing the Complaint
<benettonargentina.com>	November 15, 2022	Online shop displaying the Complainant's products and logo.
<benettonaustralia.com>	November 12, 2022	Online shop displaying the Complainant's products and logo.
<benettoncanada.com>	November 12, 2022	Online shop displaying the Complainant's products and logo.
<benettonchile.com>	November 15, 2022	Online shop displaying the Complainant's products and logo.
<benettoncolombia.com>	November 15, 2022	Online shop displaying the Complainant's products and logo.
<benettonespana.com>	November 15, 2022	Online shop displaying the Complainant's products and logo.
<benettonitalia.com>	November 15, 2022	Online shop displaying the Complainant's products and logo.
<benettonnz.com>	November 12, 2022	Online shop displaying the Complainant's products and logo.
<benettonphilippines.com>	November 12, 2022	Online shop displaying the Complainant's products and logo.

<benettonportugal.com>	November 15, 2022	Online shop displaying the Complainant's products and logo.
<benettonsingapore.com>	November 12, 2022	Online shop displaying the Complainant's products and logo.
<benettonsouthafrica.com>	November 12, 2022	Online shop displaying the Complainant's products and logo.
<benettonuae.com>	November 12, 2022	Online shop displaying the Complainant's products and logo.
<unitedcolorsofbenettonmexico.com>	November 15, 2022	Online shop displaying the Complainant's products and logo.

Presently, no active webpages resolve from the disputed domain names.

5. Parties' Contentions

A. Complainant

The Complainant asserts that its BENETTON trademark, regularly used since the 1970s has become a well-known trademark worldwide as a result of significant investments in research and development, marketing and expressive sales.

The Complainant further asserts that the BENETTON brand rapidly achieved great success internationally during the 1980s when the photographer Oliviero Toscani became the creative director of the group and who led to a change in the advertising focus towards raising awareness for various issues worldwide, such as racism, HIV and religion, thus creating many controversial and famous advertising campaigns, such as the UNHATE campaign, showing world leaders Barack Obama, China's President Hu Jintao and the Venezuelan leader Hugo Chavez kissing each other on the lips.

Moreover, the Complainant stresses to be focused on the respect of the environment, using more than 54% of organic and recycled cotton, having started a collaboration with Greenpeace in the context of the Detox Commitment in order to remove 11 chemical substances from its production.

The Complainant submits that the disputed domain names, registered between November 12, 2022 and November 15, 2022, reproduce the Complainant's well-known BENETTON trademark in its entirety with the addition of geographical terms ("Argentina", "Australia", "Canada", "Chile", "Colombia", "Espana" for Spain, "Italia" for Italy, "Mexico", "NZ" - abbreviation for New Zealand, "Philippines", "Portugal", "Singapore", "South Africa", and "UAE" - abbreviation for United Arab Emirates) which are not capable of distinguishing the disputed domain names from the Complainant's trademark.

The disputed domain names have also been used, since their registration, in connection with websites reproducing without authorization the Complainant's trademarks, product visuals and official images, and offering for sale purported BENETTON products at discounted prices, without displaying any disclaimer of non-affiliation with the Complainant, there being a risk, given the prices indicated that such products are counterfeit.

Moreover, the Complainant submits that upon learning of the disputed domain names it sent on March 1, 2023, a first cease-and-desist letter, followed by reminders on March 7, 2023, and March 28, 2023.

As to the Respondent's lack of rights or legitimate interests in respect of the disputed domain names, the Complainant contends that:

- (a) the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the trademark BENETTON;

- (b) the Respondent is not commonly known by the disputed domain names as an individual, business or other organization and its family name does not correspond to BENETTON, UNITED COLORS OF BENETTON or names corresponding to the disputed domain names;
- (c) the Respondent has not provided any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services before any notice of the dispute, there being no evidence that the Respondent might have used the disputed domain names in connection with a legitimate non-commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark;
- (d) the disputed domain names have resolved to websites featuring the Complainant's trademarks and official advertising images, promoting the sale of purported BENETTON products at discounted prices, without providing any disclaimer as to the Respondent's lack of relationship with the Complainant, thus misleading Internet users into believing that the websites are operated by the Complainant or by an affiliated entity with the Complainant's consent, what is not true;
- (e) the lack of accurate and prominent disclaimers as to the lack of affiliation with the Complainant on the Respondent's websites and the contents of the websites available at the disputed domain names were clearly designed to generate the wrong impression that they might be operated by the Complainant or one of the Complainant's affiliated entities; and
- (f) the composition of the disputed domain names comprised of the Complainant's trademark plus an additional term cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner as decided by past UDRP panels.

As to the registration of the disputed domain names in bad faith, the Complainant asserts that, in light of the extensive use of the BENETTON trademark since the 1970s and the advertising and sales of the Complainant's products worldwide under the trademarks BENETTON and UNITED COLORS OF BENETTON, the Respondent could not have possibly ignored the existence of the Complainant's trademarks when it registered the disputed domain names which are confusingly similar to the trademarks BENETTON and UNITED COLORS OF BENETTON.

Further, the fact that purported BENETTON products were offered for sale and the Complainant's trademarks have been published on the websites to which the disputed domain names resolved, indicates that the Respondent was fully aware of the Complainant and its trademarks. In addition to that, also according to the Complainant, the use of the disputed domain names in connection with the commercial websites described above, displaying the Complainant's trademarks and official advertising images and offering for sale purported BENETTON products at discounted prices without displaying any disclaimer of non-affiliation with the Complainant, clearly indicates that the Respondent's purpose in registering and using the disputed domain names was to capitalize on the reputation of the Complainant's trademark, by intentionally attempting to attract Internet users seeking the Complainant's branded products to the disputed domain names for commercial gain, creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its websites and the goods offered and promoted through said websites, according to paragraph 4(b)(iv) of the Policy

Lastly, the Complainant contends that the lack of reply to the Complainant's cease-and-desist letters and subsequent reminders is a further indication of the Respondent's bad faith registration and use of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth three requirements, which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain names.

A. Identical or Confusingly Similar

The Complainant has established its rights in the BENETTON and UNITED COLORS OF BENETTON trademarks duly registered in several jurisdictions.

The Panel finds that all of the disputed domain names reproduce the Complainant's BENETTON trademark in its entirety and one of the disputed domain names reproduces the UNITED COLORS OF BENETTON trademark in its entirety. As recognized by past UDRP panels, this test involves a "comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name" and the disputed domain names are thus confusingly similar to the Complainant's trademark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, "[WIPO Overview 3.0](#)", section 1.7.)

The first element of the Policy has therefore been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondents' rights to or legitimate interests in the disputed domain names. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names 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 names, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel notes that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The burden of production has therefore shifted to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names. This entitles the Panel to draw any such inferences, as it considers appropriate pursuant to paragraph 14(b) of the Rules.

As seen above, the disputed domain names were used in connection with online shops purportedly offering the Complainant's products without the Complainant's authorization. Indeed such use cannot be considered here a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use under the Policy.

Furthermore, the composition of the disputed domain names, wholly incorporating the Complainant's well-known trademark with additional geographical terms, carries a risk of implied affiliation. See section 2.5.1, [WIPO Overview 3.0](#). Also, the lack of evidence on record showing that the Respondent has been commonly known by the disputed domain names, is a further indication that the Respondent lacks rights or legitimate interests in the disputed domain names.

The second element of the Policy has also been met.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of the disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain names:

- a) the Complainant's trademark is well-known;
- b) the use of the disputed domain names in connection with online shops purportedly offering the Complainant's products, reproducing the Complainant's logo and copyrighted promotional materials without authorization or disclaimer;
- c) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by them of the disputed domain names;
- d) the present inactive use of the disputed domain names; and
- e) the Respondent did not reply to the cease-and-desist letter and subsequent reminders sent prior to this procedure.

Considering the totality of the circumstances in case, the Panel finds that the disputed domain names were registered and, at the time of filing the Complaint, were being used in bad faith as described in paragraph 4(b)(iv) of the Policy. The present inactive use of the disputed domain names does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3.

Further, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

For the reasons above, the Respondents' conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain names.

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 names, <benettonargentina.com>, <benettonaustralia.com>, <benettoncanada.com>, <benettonchile.com>, <benettoncolombia.com>, <benettonespana.com>, <benettonitalia.com>, <benettonnz.com>, <benettonphilippines.com>, <benettonportugal.com>, <benettonsingapore.com>, <benettonsouthafrica.com>, <benettonuae.com> and <unitedcolorsofbenettonmexico.com>, be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: July 3, 2023