

ADMINISTRATIVE PANEL DECISION

Gido Ltd. v. Vincenzo Cucco, Girotti Srl
Case No. D2022-0892

1. The Parties

The Complainant is Gido Ltd., Bulgaria, internally represented.

The Respondent is Vincenzo Cucco, Girotti Srl, Italy, represented by Saglietti Bianco, Italy.

2. The Domain Name and Registrar

The disputed domain name <girottishoes.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 11, 2022. On March 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 16, 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 received email communications from the Respondent on March 21, March 23, and March 28, 2022.

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 March 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2022. The Center received email communications from the Respondent on March 30 and April 6, 2022. The Response was filed with the Center on April 15, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on April 28, 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, Gido Ltd (ГИДО ООД), is a fashion producer with a place of business in Peshtera, Bulgaria. It is the owner of European Union Registered Trademark no. 12630398 for the word mark GIROTTI, registered on August 20, 2014 in Classes 10, 25, and 35 (footwear, retail sale, and electronic commerce services). It is also the owner of European Union Registered Trademark no. 14390942 for a figurative mark featuring the word GIROTTI in a stylized typeface, registered on November 30, 2015 in Classes 18, 25, and 35 (luggage, footwear, retail sale, and electronic commerce services).

The disputed domain name was registered on June 9, 2016. Girotti Srl (“the Respondent Company”) was incorporated on October 11, 2016 and registered under number 03714760364 (Business Register of Modena, Italy) on October 18, 2016. An entry from the said Business Register dated December 20, 2021, indicates that the sole shareholder of the Respondent Company as of June 19, 2017 was an entity named Girotti Trade Bulgaria EOOD of Plovdiv, Bulgaria. Although this entity does not appear to be the same entity as the Complainant, and neither of the Parties explains the connection, the fact that the Respondent Company has a Bulgarian entity shareholder suggests to the Panel that the Complainant and the Respondent Company are now or have been linked in some way in the past.

On December 15, 2021, the Court of Modena, Italy, declared the Respondent Company bankrupt and appointed Dr. Vincenzo Cuzzo (“the Respondent Receiver”) as insolvency receiver. On December 27, 2021, the Court of Modena at the instance of the Respondent Receiver issued an order to “the persons who deal with the management of [the disputed domain name]” to allow the Respondent Receiver to manage the assets of the Respondent Company, providing him with “all necessary tools and access credentials for the purpose.”

In order to understand the registrant history of the disputed domain name, the Panel has consulted the related historic Whois entries.¹ These also appear to indicate a link between the Parties. A historic Whois entry for the disputed domain name dated the same day as its registration date indicates that the original registrant of the disputed domain name was HeatDesign, Georgi Anev, of Peshtera, Pazardjik, Bulgaria. The Complainant notes that this entity is its partner and was acting on the Complainant’s behalf. By April 2, 2018, the historic Whois entry shows the registrant as the Respondent Company, suggesting that the disputed domain name had been transferred into its ownership and control.

At some point between October 22, 2021 and January 16, 2022, the registrant of the disputed domain name was changed back to Heat Design Ltd of Pazardjik, Bulgaria. By March 6, 2022, the registrant of the disputed domain name was concealed behind the Registrar’s privacy service. On March 25, 2022, the registrant of the disputed domain name was revealed to be the Respondent Company (listed in the registrant organization field) and the Respondent Receiver (listed in the registrant name field). As far as the Panel can tell from fragments of email correspondence passing between the Respondent Receiver and the Registrar, the disputed domain name was transferred to the Respondents by the Registrar on March 2, 2022, following upon the Respondent Receiver exhibiting a court order to the Registrar, presumably that of the Court of Modena dated December 27, 2021 noted above, requiring the transfer of the disputed domain name into the name of the Respondent Company.

¹ With regard to the Panel conducting limited factual research into matters of public record, such as consulting online public databases or visiting the website associated with the disputed domain name, see section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

5. Parties' Contentions

A. Complainant

The Complainant contends as follows:

Identical or confusingly similar

The Complainant is the owner of the GIROTTI trademark, which is used to sell shoes under that brand. The disputed domain name was registered two years after the registration of said mark and five years after the Complainant began selling shoes under such mark in Europe.

Rights or legitimate interests

The disputed domain name was initially registered by the Complainant's partner, Heat Design Ltd on the Complainant's behalf and with its permission but has subsequently been taken by the Respondent illegally.

Registered and used in bad faith

The Respondent is selling the disputed domain name at auction to competitors which will use it misleadingly to sell shoes under the "Girotti" brand.

Supplemental filing

In its supplemental filing, the Complainant notes that its legal team will be taking the case forward and contends as follows:

Documentary evidence will be forthcoming shortly demonstrating that all products sold by the Respondent Company are produced by the Complainant in terms of a contract between the Parties. The Respondent Company may only use the GIROTTI trademark for products provided by the Complainant. The sale of a single product bearing the said mark, by the Respondent Company, which is not supplied by the Complainant will lead to court action. Other traders have also been selling the Complainant's products under the "Girotti" brand since 2007. The Respondent Company was incorporated only a few months after the disputed domain name was registered and the Complainant asks how the Respondent Company could own the disputed domain name in these circumstances without providing proof of ownership.

B. Respondents

The Respondents contend as follows:

General

The Complaint should be dismissed because it was not filed against the holder of the disputed domain name but rather against the Respondent Receiver personally. The latter is not the holder of the disputed domain name nor the legal representative of the Respondent Company.

Rights or legitimate interests

The Complainant has been unable to establish a *prima facie* case that the Respondent Company lacks rights or legitimate interests in the disputed domain name because the Respondent Company does hold such rights and legitimate interests. The Respondent Company was incorporated in 2016 under the trade name "Girotti" under Italian law and has a legitimate trade name right thereon dating from 2016. The Respondent Company's business since incorporation has been the sale of shoes in Italy and internationally under the trade name and trademark GIROTTI, and it has acquired goodwill in this respect. There is extensive evidence of the Respondent Company's use of its trade name in connection with the purchase of shoes

worldwide (sample Italian and international invoices produced).

Registered and used in bad faith

The Complainant has been unable to prove that the disputed domain name has been both registered and used in bad faith. The Complainant asserts that the disputed domain name is being sold at auction without any evidence. The registration and use of the disputed domain name is an expression of the rights of the Respondent Company and of its ordinary business in selling shoes under the trade name and trademark GIROTTI. None of the circumstances described in paragraph 4(b) of the Policy apply to the Respondents' registration or use of the disputed domain name.

Supplemental filing

In its supplemental filing, the Respondent Receiver states that it hopes the Complainant will disclose the contracts referred to, together with a demonstration of a secure date of subscription of same.

6. Discussion and Findings

A. Preliminary Matter: Effect of Court Proceedings

Paragraph 18(a) of the Rules provides that the Panel has discretion to suspend, terminate or continue a proceeding under the Policy where a domain name dispute that is the subject of the Complaint is also the subject of other pending legal proceedings.

In the present case, the Panel has been informed by the Respondents of a court order by the Court of Modena, Italy dated December 27, 2021 ordering the transfer of the disputed domain name to the Respondent Company. As far as the Panel understands the position, this order was sought by the Respondent Receiver arising from or in connection with insolvency proceedings relating to the Respondent Company. The order (or a related court order) was notified to the Registrar and was implemented on March 2, 2022 by the transfer of the disputed domain name to the Respondents. Consequently, the Complainant filed the Complaint in the present administrative proceeding on March 11, 2022.

In these circumstances, the proceedings (which may be concurrent) of which the Panel is aware are insolvency proceedings related to the Respondent Company. Although an order was granted relating to the disputed domain name in those proceedings, the Panel does not understand the domain name dispute between the Parties to this administrative proceeding to be the subject of any legal proceedings, whether pending or not.

In any event, the existence of any such concurrent court proceedings would not necessarily prevent the Panel from proceeding to a decision under the Policy, although the Panel retains discretion in that respect. In the present case, however, the point is moot as the Panel has decided that the matter is unsuited to a determination under the Policy for the reasons provided below in the section relating to the merits.

B. Preliminary Matter: Identity of the Respondent

The UDRP Rules define the respondent as "the holder of a domain name registration against which a complaint is initiated". Nevertheless, the Panel retains discretion to substitute or join another entity as a respondent by way of its general powers as set out in paragraph 10(a) of the Rules. In the present case, the holder of the disputed domain name is listed in the corresponding Whois record as the Respondent Company (listed in the registrant organization field) and the Respondent Receiver (listed in the registrant name field).

It is clear to the Panel that the Respondent Company is the holder of the disputed domain name, while the Respondent Receiver is simply a named contact on the domain name record. In these circumstances, the Panel finds that the Respondent Company is the proper Respondent for the purposes of the present administrative proceeding. Nevertheless, the Panel will retain the Respondent Receiver's details in the instance of this Decision, in order that the Registrar would be able to implement a transfer of the disputed domain name should the Panel make an order for transfer.

C. Preliminary Matter: Parties' supplemental filings

Paragraph 12 of the Rules provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case. Supplemental filings are generally discouraged unless specifically requested by the panel. Panels have repeatedly affirmed that the party submitting or requesting to submit a supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response.

In the present case, both of the Parties have submitted brief supplemental filings. The Panel is content to admit the Complainant's supplemental filing on the basis that the Complainant could not reasonably have anticipated the nature of the Response when it filed the Complaint. The Panel reminds itself that it also has a duty in terms of paragraph 10(b) of the Rules to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and accordingly admits the Respondent's supplemental filing, which sought to answer the point regarding forthcoming documentary evidence which was raised in the Complainant's supplemental filing.

D. Merits

The Panel finds that this case is not suitable for a determination under the Policy. The record before the Panel does not describe a typical case of cybersquatting of the kind which the Policy was created to address. This is essentially a business dispute involving the insolvency of a corporate entity, whereby a court has ordered the transfer of the disputed domain name into the name of the Respondent Company and the Registrar has implemented that order. In so doing, as far as the Panel can tell, the Registrar has removed the disputed domain name from an account which was previously controlled by the Complainant's business partner, and thus in turn has removed the disputed domain name from the Complainant's control. The actions of the Respondent Company, carried out by the Respondent Receiver, are not the actions of a typical cybersquatter but those of an entity undergoing court-mandated insolvency proceedings.

The Panel is mindful of relevant observations of a panel in a relatively early case under the Policy, *The Thread.com, LLC v. Jeffrey S. Poploff*, WIPO Case No. [D2000-1470](#), namely that panels under the Policy are not a general domain name court, and the Policy is not designed to adjudicate all disputes of any kind that relate in any way to domain names. Rather, the Policy is narrowly crafted to apply to a particular type of abusive registration. That is not to say that the Panel considers that the Complainant does not necessarily have a remedy, only that on the basis of the present factual matrix it is not able to seek such remedy by way of the Policy. For example, the Panel acknowledges that the Complainant is the owner of relevant European Union registered trademarks and that it seems likely, on the basis of the present record, that the disputed domain name was transferred away from the Complainant's control by virtue of the court order of the Court of Modena. Thus, this complex business dispute with competing interests involves the interaction between the intellectual property rights of the Complainant and the insolvency of the Respondent Company, a procedure taking place under court supervision. Its resolution is more appropriately found in the courts, whether or not specifically in the Court of Modena which has already ordered the transfer of the disputed domain name or in an alternative forum. A detailed analysis of the Parties' possible rights and remedies are beyond the scope of this administrative proceeding.

For completeness, the Panel notes that had it considered the case on the merits it would in any event have denied the Complaint on the basis of the second element assessment. The Respondent Company has established that at present it has rights and legitimate interests in the disputed domain name arising out of the transfer order from the Court of Modena which itself was issued in connection with insolvency

proceedings relating to the Respondent Company.

In making the present determination, the Panel notes that it takes no position on the merits of the outstanding dispute that exists between the Parties. Finally, the Panel notes that the Decision is not addressed to any particular forum that may ultimately be seized of the matter.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: May 12, 2022