

ADMINISTRATIVE PANEL DECISION

Calzaturificio Casadei S.p.A. v. Ludovico Apollonio, Rocket Brands SI
Case No. D2023-0255

1. The Parties

The Complainant is Calzaturificio Casadei S.p.A., Italy, represented by Studio Legale Tributario EY, Italy.

The Respondent is Ludovico Apollonio, Rocket Brands SI, Spain.

2. The Domain Name and Registrar

The disputed domain name <casadei-outlet.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 January 19, 2023. On January 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On Friday 23, 2023, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 24, 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 amended Complaint on January 28, 2023.

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 February 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2023.

The Center appointed Miguel B. O’Farrell as the sole panelist in this matter on March 2, 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, Calzaturificio Casadei S.p.A., is an Italian Company and a leader in the field of design, production and marketing of footwear products, which developed from the small boutique created by Quinto and Flora Casadei in 1958 into a specialized footwear business that exported its products to Germany and the United States of America (“United States”). In 1977, it opened its first single-brand store in Brussels, Belgium. Later expanded into many international markets, particularly the Middle East. It currently holds 21 flagship stores and 21 corners in Milan and Rome and boutiques in Shanghai, China and Moscow, the Russian Federation.

The Complainant owns various trademark registrations for CASADEI in several jurisdictions, including the following:

Italian Trademark Registration No. 362019000036569, CASADEI, filed on April 21, 1989 and registered (lastly renewed) on September 20, 2019, in classes 03, 09, 14, 16, 18, 24, 25 and 28;

United States Trademark Registration No.1705086 CASADEI, filed on June 6, 1989, and registered on August 4, 1992, in class 25; and

European Trademark Registration No. 005047361 CASADEI, filed on April 28, 2006, and registered on July 12, 2007, in classes 18 and 25.

The Complainant owns several domain names that include the trademark CASADEI, such as <casadei.com> registered on July 2, 1966, which resolves to the official website of the Complainant and is used to promote and sell the Complainant’s products.

The Respondent registered the disputed domain name <casadei.outlet.com> on September 12, 2022, which at one time resolved to a webpage selling alleged counterfeit CASADEI clothing, and at the time of drafting this decision does not resolve to any active webpage.

5. Parties’ Contentions

A. Complainant

The Complainant alleges to have developed the CASADEI trademark into a world famous brand for footwear.

The Complainant claims that the disputed domain name is confusingly similar with the trademark CASADEI in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

The Respondent has no relationship with the Complainant and has no permission from the Complainant to any use of any trademark comprehensive of the term “casadei”. Moreover, the Respondent does not own any trademark comprehensive of CASADEI and is not known with this name in Internet.

The Respondent is most likely Italian. Ludovico Apollonio is a typical Italian name and surname, his phone number includes the Italian national area code (“+39”). In an article in Forbes.it, a Mr. Ludovico Apollonio is identified as “The Italian expert on online sales” and it is specified that he studied in the “La Sapienza” university, which is in Rome, Italy. It is impossible for him not to know the well-known brand CASADEI.

The disputed domain name was registered by the Respondent on September 12, 2022, that is 26 years after the Complainant had registered the domain name <casadei.com> and used it to resolve to its official website for promoting and selling its products worldwide online.

The disputed domain name was used by the Respondent to direct Internet users to a website, which offered CASADEI counterfeit clothing.

The Respondent has registered and used the disputed domain name to confuse Internet users to make them think that the website to which the disputed domain name resolved belonged to the Complainant and thereby benefit monetarily from the fame of the Complainant's trademark CASADEI.

The Complainant, having no means to directly approaching the Respondent, tried to contact the Respondent by addressing him/her a formal cease-and-desist letter to the Registrar abuse contact email on November 15, 2022, which the Complainant did not receive any answer from the Respondent.

Meanwhile, the Complainant sent a trademark infringement notice to the Service Provider Shopify Having, who having acknowledged the rights of the Complainant, took prompt action and the website to which the disputed domain name resolved is now in fact currently unavailable.

Finally, the Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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.

A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant's CASADEI marks.

The disputed domain name <casadei-outlet.com> incorporates the Complainant's trademark CASADEI in its entirety with a hyphen and the word "outlet", which do not prevent a finding of confusing similarity, Pursuant to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive or otherwise) would not prevent a finding of confusing similarity under the first element.

The “.com” generic Top-Level Domain (“gTLD”) is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark CASADEI in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the 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 has been commonly known by the domain name, even if it has acquired no 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.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production 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.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under Section 6.C of this Decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name, but rather that it intends to use the disputed domain name for the purpose of deriving unfair monetary advantage by confusing Internet users and leading them to believe that the website, to which the disputed domain name resolves, is an official site of the Complainant.

As established in section 2.5 of [WIPO Overview 3.0](#): “Fundamentally, a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry”. Here, the nature of the disputed domain name carries a high risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded in the present proceeding and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant's trademark CASADEI mentioned in section 4 above (Factual Background) when it registered the disputed domain name on September 12, 2022.

The Respondent when registering the disputed domain name has targeted the Complainant's trademark CASADEI with the intention to confuse Internet users and capitalize on the fame of the Complainant's name and trademark for its own monetary benefit. The term "outlet" conveys the message that the CASADEI products are sold with a discount which only helps to increase the consumers confusion.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name, is also a significant factor to consider that the disputed domain name was registered in bad faith (as stated in section 3.2.1 of [WIPO Overview 3.0](#)).

UDRP panelists have found that non-use of a domain name does not prevent a finding of bad faith under the doctrine of "passive holding" when circumstances exist such as the distinctiveness or reputation of the complainant's mark, the failure of the respondent to submit a formal response or to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the disputed domain name may be put. The Panel finds that all these circumstances are relevant to this proceeding and therefore that a finding of bad faith lies under the doctrine of "passive holding" (section 3.3 of [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has registered and uses the disputed domain intentionally to attempt to attract for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement. This amounts to bad faith under paragraph 4(b)(iv) 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 <casadei-outlet.com> be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: March 8, 2023