

ADMINISTRATIVE PANEL DECISION

Calzaturificio Casadei S.p.A. v. Xiaoru Wang
Case No. D2023-1552

1. The Parties

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

The Respondent is Xiaoru Wang, China.

2. The Domain Name and Registrar

The disputed domain name <casadeishoe.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 8, 2023. On April 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 13, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 26, 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 May 7, 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 May 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 2, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on June 21, 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, based in Italy, designs, produces and markets fashionable footwear and accessories for women. Originally founded in 1958, it has operated under the “Casadei” corporate name since 1979, and now operates more than 21 stores in Milan, Rome, Shanghai and Moscow, and sells its products in other jurisdictions such as the United States of America (“United States”). The Complainant owns various trade mark registrations internationally for its CASADEI mark including, in particular, United States trade mark registration number 1705086 registered on August 4, 1992, and various Chinese registrations including Chinese trade mark registration number 12757630 registered on August 21, 2015. It also owns the domain name <casadei.com> registered on July 2, 1996, from which it operates its main website.

The disputed domain name was registered on January 30, 2023, and resolves to a website which prominently features the CASADEI trade mark, and offers for sale fashion footwear for women.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the disputed domain name wholly incorporates the CASADEI mark and is, therefore, confusingly similar to the Complainant’s trade mark. It says that the addition of the descriptor “shoes” does not distinguish the disputed domain name or prevent a finding of confusing similarity.

The Complainant submits that the Respondent has no rights nor claim to the disputed domain name. It says that the Respondent is not and has never been, a representative or licensee of the Complainant, nor is the Respondent otherwise authorised to use the “CASADEI” mark. Further, it submits that there is no affiliation between the Complainant and the Respondent, that the Respondent is not commonly known by the disputed domain name and that the Respondent does not use the disputed domain name for a *bona fide* offering of goods or services and is not making a legitimate noncommercial or fair use of it. On the contrary, says the Complainant, the Respondent has sold counterfeited CASADEI products, in particular shoes, from the website at the disputed domain name. It further says that using the Complainant’s CASADEI name and trade mark to mislead consumers with regard to the origin of the displayed goods, demonstrates that the Respondent has the intent to divert consumers in a misleading way or to tarnish the Complainant’s trade marks and brand for its own commercial gain, all of which is inconsistent with it having any rights or legitimate interests in the disputed domain name.

As far as registration and use in good faith are concerned, the Complainant submits that the CASADEI trade mark is well-known and enjoys very considerable renown internationally, and that the Respondent must have been aware of its trade mark and business when it registered the disputed domain name in 2023.

As described above, the Complainant says that the Respondent has sought to represent the website at the disputed domain name as if it belonged to the Complainant by using the CASADEI name and trade mark prominently in the website header and also using the word “shoe” after CASADEI, which according to the Complainant presents the message that people can buy original but discounted CASADEI products from the Respondent’s website. The Complainant also notes that the font used on the website to which the disputed domain name resolves is similar to the font used by the Complainant on its own website. As a result, the Complainant asserts that the Respondent has intentionally attempted to attract for commercial gain Internet users to the website at the disputed domain name in terms of paragraph 4(b)(iv) of the Policy.

The Complainant further notes that it sent a cease and desist letter to the Respondent on March 12, 2023, to which it has received no response.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns registered trade mark rights in its CASADEI mark as set out above. The disputed domain name wholly incorporates the CASADEI mark and is therefore confusingly similar to it. The addition of the word “shoes” does not distinguish the disputed domain name or prevent a finding of confusing similarity. Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s registered trade mark rights and that the Complaint succeeds under this element of the Policy.

B. Rights or Legitimate Interests

The Complainant has submitted that the Respondent has no rights nor claim to the disputed domain name. It has asserted that the Respondent is not and has never been, a representative or licensee of the Complainant and has never been authorised to use the CASADEI mark. Further, it has also submitted that there is no affiliation between the Complainant and the Respondent, that the Respondent is not commonly known by the disputed domain name and that the Respondent does not use the disputed domain name for a *bona fide*, offering of goods or services and is not making a legitimate noncommercial or fair use of it.

The Complainant has submitted that the Respondent has apparently sold counterfeit CASADEI products, in particular shoes, from the website at the disputed domain name and has asserted that it has and is using the Complainant’s CASADEI name and trade mark to mislead consumers with regard to the origin of the displayed goods. According to the Complainant, this demonstrates that the Respondent has the intent to divert consumers in a misleading way or to tarnish the Complainant’s trade marks and brand for its own commercial gain all of which is inconsistent with it having any rights or legitimate interests in the disputed domain name.

Furthermore, the nature of the disputed domain name, comprising the Complainant’s CASADEI trademark and the additional term “shoe” related to Complainant’s business, indicates an awareness of the Complainant and its trade mark and an intent to take unfair advantage of such, which is not consistent with a finding of any rights or legitimate interests.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond to or to rebut the Complainant’s case or to explain its conduct following receipt of the Complainant’s cease and desist letter or of this Complaint, and for these reasons and for those set out under Part C below the Panel finds that the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

The disputed domain name was only registered in 2023, many decades after the Complainant first started its business and after the registration of the Complainant’s CASADEI trade mark in various countries, including the United States and in China. It is apparent that the CASADEI mark enjoys a developed goodwill and reputation in various countries, and the fact that the mark is used prominently as the main brand on the website to which the disputed domain name resolves indicates that it is more likely than not that the Respondent was well aware of the Complainant’s CASADEI mark and business at the date of registration of the disputed domain name.

Under paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of the disputed domain name in bad faith where a respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s trade marks as to the source, sponsorship, affiliation or endorsement of the website.

The website at the disputed domain name displays the Complainant's CASADEI mark and looks very much as if it belongs to, or is affiliated with, the Complainant and appears to have been designed to confuse Internet users into thinking that it is part of the Complainant's business, or has some affiliation or connection which it does not have, or that the Respondent is authorised to sell the Complainant's products from this website when this is not the case. The composition of the disputed domain name comprising the Complainant's CASADEI trade mark in its entirety with the term "shoe" related to the Complainant's business, the unauthorised use of the Complainant's very distinctive CASADEI mark in the disputed domain name and the Complainant's CASADEI mark on the website to which the disputed domain name resolves, is obviously intended to attract and confuse Internet users to the Respondent's website and to pass-off the Complainant's CASADEI mark for commercial purposes. As a result, the Panel finds that the requirements of paragraph 4(b)(iv) of the Policy are fulfilled and that there is evidence of registration and use of the disputed domain name in bad faith.

This is a case of the Respondent attempting to use the Complainant's distinctive mark in the disputed domain name and on the website to which it resolves, to pass itself off in bad faith as having some connection with the Complainant's business that it does not have. The Panel's view of the Respondent's bad faith is only reinforced by its failure to reply to the Complainant's cease and desist letter or to respond in these proceedings.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complaint also succeeds under this element 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 <casadeishoe.com> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: July 5, 2023