

ADMINISTRATIVE PANEL DECISION

CORE s.r.l. v. Hongxia456 Wei
Case No. D2024-1265

1. The Parties

The Complainant is CORE s.r.l., Italy, represented by Dr. Modiano & Associati S.p.A., Italy.

The Respondent is Hongxia456 Wei, China.

2. The Domain Name and Registrar

The disputed domain name <capita-shop.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 March 25, 2024. On March 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 26, 2024, 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 in the Complaint. The Center sent an email communication to the Complainant on March 27, 2024, 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 March 29, 2024.

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 April 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 22, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 23, 2024.

The Center appointed Kateryna Oliynyk as the sole panelist in this matter on May 2, 2024. 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 headquarters in Colico, Italy, and was founded in 2004. The Complainant's line of business includes the wholesale distribution of sporting and recreation goods. The Complainant is the global leader in snowboard binding manufacturing. The Complainant now holds four brands, four factories, and over 200 employees, all united by the same guiding principle. The dealer network of 1.7K dealers is distributed over 46 markets.

The Complainant's brand portfolio includes the CAPITA trademark which is an iconic brand in the world of snowboarding. The history of the brand dates back to 2000, when CAPITA Snowboarding was founded in the United States of America ("United States"). Now, the CAPITA trademark belongs to the Complainant, and the CAPITA branded snowboards are hand crafted in Austria with self-generated clean energy at The CAPITA MotherShip. The CAPITA Mothership is the world's first snowboard manufacturing facility powered by 100% clean energy.

The Complainant's turnover for the CAPITA trademark alone was EUR 11.846.755,00 in 2021 and 17.560.216,00 in 2022.

The Complainant is the owner of national, international and community registered trademarks, including the following trademark registrations:

- United States Trademark Registration No. 2782346 for CAPITA, registered on November 11, 2003, and designating goods in International Classes 25 and 28;
- European Union Trademark Registration No. 004224556 for CAPITA, registered on July 31, 2009, and designating goods in International Classes 25 and 28;
- Chinese Trademark Registration No. 56229111 for CAPITA, registered on March 14, 2023, and designating goods in International Class 28.

The Complainant has a strong online presence in social media and has registered directly or through authorized entities domain names incorporating the CAPITA trademarks and providing company information, including such domain names as <capitasnowboarding.com> (created on September 11, 2000), <capitasnowboarding.net> (created on December 28, 2017), <capitasnowboards.com> (created on September 11, 2000), and <capitasnowboards.net> (created on November 21, 2016).

The disputed domain name was created on September 5, 2022, and resolves to a commercial website, purporting to offer for sale snowboards under the CAPITA trademarks at heavily discounted prices and replicating the Complainant's logo, images of the original snowboards under the CAPITA trademarks. The evidence provided by the Complainant shows that customers sent email communications to the Complainant asking if the website at the disputed domain name was legitimate due to its heavily discounted prices of the CAPITA branded products. Further, a customer purchased a snowboard from the website at the disputed domain name but received a necklace instead.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Identical or Confusingly Similar

The Complainant contends that the disputed domain name and the CAPITA trademark are identical or confusingly similar.

According to the Complainant's contentions, the disputed domain name incorporates the Complainant's CAPITA trademark in full with the additional of the generic term "shop" followed by the generic Top-Level Domain ("gTLD") ".com". The Complainant contends that the addition of a descriptive and/or geographical term to a trademark in the disputed domain name is not sufficient to avoid confusion.

No Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name.

According to the Complainant's contentions, the Respondent is not commonly known by the disputed domain name, has not used or prepared to use the disputed domain name in connection with a bona fide offering of goods or services, and has not been authorized, licensed, or otherwise permitted by the Complainant to register and/or use the disputed domain name.

The Complainant further submits that there is no evidence that the Respondent has trademarks or company activities registered under the CAPITA trademark.

The Complainant also contends that the disputed domain name is used for a website where the Complainant's CAPITA trademark is displayed, and purported products under the CAPITA trademark are sold at discounted prices. It therefore appears that the Respondent is trying to impersonate the Complainant, and thus is not making any legitimate use of the disputed domain name.

Registered and Used in Bad Faith

The Complainant claims that the disputed domain name has been registered and used to cause confusion among internet users as to the source of the disputed domain name.

The Complainant submits that the Respondent registered and is using the disputed domain name in bad faith. The Respondent registered the disputed domain name after many years of the Complainant's use and promotion in Italy and abroad of the CAPITA trademark. The Respondent must have been aware of the Complainant's CAPITA trademark when it registered the disputed domain name.

The Complainant further asserts that the Respondent's overall behavior indicates that the Respondent has no good faith intentions in respect to the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy directs that the Complainant must prove each of 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;
- 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.

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its decision on the statements and documents submitted in accordance with the Policy and the Rules.

Under paragraph 5(f) and paragraph 14(b) of the Rules, if a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint, and where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7.

Ownership of a nationally or regionally registered trademark serves as a prima facie evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of the [WIPO Overview 3.0](#). The Complainant submitted evidence that the CAPITA trademark enjoys protection under national, regional, and international trademark registrations. Thus, the Panel finds that the Complainant's rights in the CAPITA trademark have been established pursuant to the first element of the Policy.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other term here, "shop", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Furthermore, section 1.11.1 of the [WIPO Overview 3.0](#) states that the applicable TLD in "a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test". The gTLD ".com" will therefore be discounted in the Panel's consideration of confusing similarity.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Based on the records of the case the Panel has established that the disputed domain name resolves to a commercial website, purporting to offer for sale snowboards under the CAPITA trademarks and replicating the Complainant’s logo, images of the original snowboards under the CAPITA trademarks.

According to section 2.8.1 of the [WIPO Overview 3.0](#), 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. Outlined in the “Oki Data test” (*Oki Data Americas, Inc. v. ASD Inc.*, WIPO case No. [D2001-0903](#)), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- i. the respondent must actually be offering the goods or services at issue;
- ii. the respondent must use the site to sell only the trademarked goods or services;
- iii. the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- iv. the respondent must not try to “corner the market” in domain names that reflect the trademark.

The current case at least does not satisfy the first and third requirements under the Oki Data test because the evidence provided by the Complainant shows that a customer purchased a snowboard from the website at the disputed domain name but received a necklace instead. Further, there is no accurate and prominent disclaimer regarding the Respondent’s relationship with the Complainant shown on the website at the disputed domain name. Instead, the Complainant received email communications from its customers asking if the website at the disputed domain name was legitimate due to heavily discounted prices.

After a complainant has made a prima facie case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain name. In the absence of any evidence rebutting the Complainant’s prima facie case indicating the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or service on [respondent's] website or location".

The Panel accepts that the Complainant's use and registration of the CAPITA trademark long predated the Respondent's registration and use of the disputed domain name. The Respondent clearly knew of the Complainant's business and trademark as the disputed domain name resolves to a website purportedly offering products carrying the Complainant's trademark.

Clearly, the Respondent has primarily registered the disputed domain name, and is using it, with the intention to attract as many users as possible to its website for commercial gain. The disputed domain name is likely to attract users which seek goods for outdoor active sports to the Respondent's website, thanks to the reputation of the CAPITA trademark. The disputed domain name has been chosen to unfairly take advantage of the Complainant's goodwill by creating a likelihood of confusion with the Complainant's trademark, misleading Internet users as to the website connected to the disputed domain name.

The Panel finds that the Complainant has established the third 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 <capita-shop.com> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: May 16, 2024