

## **ADMINISTRATIVE PANEL DECISION**

Fedrigoni S.P.A. v. Edgar Ayllon Guerrero  
Case No. D2024-4262

### **1. The Parties**

The Complainant is Fedrigoni S.P.A., Italy, represented by Dr. Modiano & Associati S.p.A., Italy.

The Respondent is Edgar Ayllon Guerrero, Bolivia (Plurinational State of).

### **2. The Domain Name and Registrar**

The disputed domain name <fabrianobolivia.com> is registered with Realtime Register B.V. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 16, 2024. On October 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 17, 2024, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 17, 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 October 21, 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 October 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 12, 2024.

The Center appointed Miguel B. O’Farrell as the sole panelist in this matter on November 18, 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, Fedrigoni S.p.A. is part of the Fedrigoni Group, a leading company in Europe in the production and sale of special papers for graphic use and self-adhesive products for labels. According to the Complaint, it is a global leader in the production of self-adhesive labels for the wine sector.

The Complainant owns several trademark registrations for FABRIANO in many jurisdictions worldwide, including the following:

United States of America Trademark Registration No. 1,557,899 FABRIANO, registered on September 26, 1989, in class 16.

The Complainant also includes a detailed listing of FABRIANO marks registered in jurisdictions around the world, including Bolivia (Plurinational State of) where the Respondent seems to be located.

Among other domain names which include the FABRIANO mark, the Complainant operates the website "www.fabriano.com" to promote its goods and services.

The Respondent registered the disputed domain name on February 18, 2024 and the Complainant has proven that it resolved to a website offering purported FABRIANO products and other unrelated goods and that in addition, on this website the FABRIANO trademark/logo was displayed, presenting a number of the Complainant's copyright-protected official product images and marketing materials.

#### **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.

The Complainant contends that its trademark FABRIANO is well known, has been extensively used by the Complainant for many years and that as a result of this use, the Complainant has continually developed the goodwill and repute of its trademark.

The argument that the disputed domain name has been registered and used in bad faith is supported by the following facts:

1) the Complainant's trademarks are internationally renowned marks; 2) the Complainant has registered numerous domain names corresponding to and/or comprising its trademarks; 3) the Complainant has published company information on the Internet since the year 2000 through a number of official websites including "www.fabriano.com" and "www.fedrigoni.com" and many others; 4); the Respondent is using the disputed domain name to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark; 5) The Complainant affirms that the Respondent has never received any authorisation to use and/or register any domain name under the FABRIANO trademark in any form, and that the disputed domain name has never been used in good faith.

Thus, due to the fact that the Complainant's trademark has become internationally well-known through massive advertising and through the high-quality level of the products it designates, the Respondent could not have been unaware of the Complainant's trademark.

By knowingly choosing a domain name almost identical to the Complainant's trademark, the Respondent intentionally created a situation which is at odds with the legal rights and obligations of the parties.

Finally, the Complainant requests the Panel to issue a decision ordering the transfer of the disputed domain name to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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.

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 terms here, the geographical term "bolivia" 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.

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 1.11.1 of [WIPO Overview 3.0](#).

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.

Given the use of the disputed domain name to direct to a website allegedly offering for sale not only the Complainant's trademarked goods, but also goods of third parties, reinforces the lack of fair use behind the confusingly similar disputed domain name.

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 Panel is satisfied that the Respondent must have been aware of the Complainant's trademark FABRIANO mentioned in Section 4 above ("Factual Background") when it registered the disputed domain name on February 18, 2024, many years after the Complainant had registered and intensely used the FABRIANO mark.

The Panel also finds that by registering the disputed domain name which includes the Complainant's trademark FABRIANO in its entirety the Respondent was targeting the Complainant and its business. The addition of the geographical term "bolivia" only contributes to confuse Internet users and leads them to think that the Respondent's website belongs to or is endorsed by the Complainant with the intention to capitalize on the fame of the Complainant's trademark for its own benefit.

Further, 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, the nature of the disputed domain name, and the use of the disputed domain name to resolve to a website to offer third party products along with the Complainant's products, are indicative of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)).

The Panel concludes the registration and use is in bad faith under paragraph 4(b) of the Policy as the use of the disputed domain name falls under paragraph 4(b)(iv) of the Policy as Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant's mark. The Panel finds that the Respondent registered and is using the disputed domain in bad faith.

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 <fabrianobolivia.com> be transferred to the Complainant.

*/Miguel B. O'Farrell/*

**Miguel B. O'Farrell**

Sole Panelist

Date: November 25, 2024