

## **ADMINISTRATIVE PANEL DECISION**

G.& G. srl v. Donnino Buono, it it  
Case No. D2025-1055

### **1. The Parties**

The Complainant is G.& G. srl, Italy, represented by Leexè Studio Legale, Italy.

The Respondent is Donnino Buono, it it, Italy.

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

The disputed domain name <italybaracuta.com> is registered with Hongkong Kouming International Limited (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on March 14, 2025. On March 14, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 2025, 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.

On March 20, 2025, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On March 24, 2025, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Chinese of the Complaint, and the proceedings commenced on March 25, 2025. In accordance with the Rules, paragraph 5, the due date for Response was April 14, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 15, 2025.

The Center appointed Luca Barbero as the sole panelist in this matter on April 22, 2025. 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 is the owner of the BARACUTA clothing brand, which originated in Manchester in 1937, where the first factory was created by the Miller Brothers, whose mission was to create a ubiquitous outerwear brand that would offer stylish protection from the unpredictable British weather.

One of the first and most iconic BARACUTA items was the G9 jacket, which was worn by many celebrities such as Steve McQueen, Elvis Presley, Frank Sinatra, James Dean in the 50's, when the brand gained widespread acclaim thanks to its distribution in the United States of America ("United States"), becoming considerably popular in Hollywood and over the years even amongst youth subcultures and iconic bands.

In 2007, BARACUTA turned 70 years old and returned to the big screen with the English-style ambassador James Bond, played by Daniel Craig that in the film Quantum of Solace, wearing the G9 jacket.

In 2021, the brand launched a collaboration with the Jaguar car vehicle brand.

The Complainant has provided evidence of ownership of several trademark registrations for BARACUTA, including the following, as per trademark registration certificates submitted as Annex E to the Complaint:

- European Union trademark registration No. 000263251 for BARACUTA (word mark) filed on May 1, 1996, and registered on September 9, 1998, in class 25;
- European Union trademark registration No. 017963302 for BARACUTA (word mark), filed on October 1, 2018, and registered on February 14, 2019, in classes 18, 25, and 35;
- European Union trademark registration No. 018666656 for BARACUTA (word mark), filed on March 3, 2022, and registered on August 20, 2022, in classes 9, 25, 35, and 41;
- European Union trademark registration No. 015115942 for BARACUTA (word mark), filed on February 16, 2016, and registered on July 8, 2016, in classes 3, 9, and 16;
- United Kingdom trademark registration No. UK00000659010 for BARACUTA (word mark), registered on May 10, 1947, in class 25;
- United Kingdom trademark registration No. UK00900263251 for BARACUTA (word mark) filed on May 1, 1996, and registered on September 9, 1998, in class 25;
- United States trademark registration No. 1148995 for BARACUTA (word mark), filed on August 30, 1978, and registered on March 24, 1981, in international class 25;
- United States trademark registration No. 5798123 for BARACUTA (word mark) filed on October 12, 2018, and registered on July 9, 2019, in international class 25; and
- United States trademark registration No. 5830824 for BARACUTA (word mark) filed on February 18, 2016, and registered on August 13, 2019, in international classes 3, 9, 16, and 18.

The Complainant is also the owner of the domain name <baracuta.com>, which was registered on May 19, 2003, and is used by the Complainant to promote and offer for sale its products under the BARACUTA mark.

The disputed domain name was registered on November 28, 2024, and is currently not pointed to an active website. However, based on the screenshots submitted by the Complainant - which have not been contested by the Respondent - prior to the present proceeding the disputed domain name resolved to a website in Italian publishing the Complainant's BARACUTA mark and product images identical or similar to those published on the Complainant's official website at "www.baracuta.com", whilst promoting the online sale of purported BARACUTA products at significantly lower prices than those applied by the Complainant, without providing a disclaimer as to the lack of affiliation between the Respondent's website and the Complainant. The copyright line read: "Diritto d'autore © 2025 Negozio monomarca Baracuta - Offerto da italybaracuta.com" ("Copyright © 2025 Baracuta flagship store - Offered by italybaracuta.com").

## **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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the trademark BARACUTA in which the Complainant has rights, as it reproduces the trademark in its entirety with the mere addition of the geographical indicator "Italy" and the generic Top-Level Domain ("gTLD") ".com".

The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name, because: i) the Respondent is in no way connected to or affiliated with the Complainant and has not been licensed or permitted by the Complainant to use its BARACUTA mark in a domain name or any other manner; ii) the Respondent has no rights on the BARACUTA mark whatsoever (including trademark rights) in the disputed domain name or any name corresponding to the disputed domain name; iii) the Respondent did not use the disputed domain name in connection with a bona fide offering of goods or services since it has pointed the disputed domain name to a website dedicated exclusively to BARACUTA products, displaying the Complainant's trademark BARACUTA and advertising images identical or very similar to the ones of the Complainant and promoting prima facie counterfeit BARACUTA products, which were advertised and offered for sale at significantly lower prices, without providing any disclaimer as to the lack of affiliation between the Respondent's website and the Complainant.

With reference to the circumstances evidencing bad faith, the Complainant indicates that since the Complainant's trademark and activity are well-known throughout the world, the Respondent must have been aware of the Complainant's existence and its rights when it registered the disputed domain name. The Complainant further states that the Respondent's awareness may be inferred by the fact that the Respondent used the BARACUTA mark in the disputed domain name and redirected it to a website that created a strong association with the Complainant, being written in Italian language, like the Complainant's official website at "www.baracuta.com", and promoting and offering for sale products branded with the Complainant's BARACUTA mark, using advertising images identical or similar to those of the Complainant.

The Complainant also submits that the Respondent has used the disputed domain name to intentionally 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 of its website.

### **B. Respondent**

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

## 6. Discussion and Findings

According to paragraph 15(a) of the Rules: “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 registered by the Respondent 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.

### 6.1. Preliminary procedural issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that:

- The Respondent intended to complicate and delay the resolution of the proceedings by selecting to register the disputed domain name with a registrar that operates exclusively in Chinese, whilst having no obvious connection to the location of the Registrar, or the Chinese language, as the Respondent is based in Italy, the disputed domain name is registered in Latin characters and includes the English term “Italy”, the website to which the disputed domain name resolved was in Italian language and the currency accepted on said website was only Euro.
- English is the most practical and neutral language as it is an international language and suitable for resolving disputes with transnational elements.
- The disputed domain name includes the English word “Italy”.
- The activities of the Respondent are typical of cybersquatters and it would be unduly burdensome for the Complainant to have to bear the additional costs and associated delays if it were to translate the Complaint.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.5.1).

The Panel notes that, as highlighted by the Complainant, the disputed domain name is composed of Latin characters and contains the Complainant’s BARACUTA mark combined with the English word “Italy”.

The Panel further notes that the Center duly notified the Respondent in English and in Chinese on the request of the Complainant to use English as the language of the proceeding (being Chinese the language of the Registration Agreement accepted by the Respondent when registering the disputed domain name). The Respondent was provided with an opportunity to object and request the proceeding to not be carried in English. Furthermore, the Panel notes that the Center sent the notification of the Complaint and commencement of the proceeding to the Parties in both languages (English and Chinese), accepting the Complaint filed in English, and giving equal opportunities to the Parties to participate in the proceeding.

The Respondent, however, did not make any specific submissions with respect to the language of the proceeding and did not submit a Response, failing to use the opportunity to argue its case.

Therefore, the Panel concludes that each Party of the proceeding was treated fairly and was provided a fair opportunity to present its case.

The Panel also finds that, under the circumstances, requiring the Complainant to translate the Complaint would unfairly disadvantage and burden the Complainant and delay the proceeding.

In view on the foregoing, the Panel concludes that it is not unfair for the Parties to proceed in English and finds that it is appropriate to allow the proceeding to be conducted in English.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

## **6.2 Substantive issues**

### **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 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. Indeed, the Complainant has provided evidence of valid trademark registrations for BARACUTA.

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 such as the geographical term "Italy" 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.

In addition, the gTLD ".com" can be disregarded under the first element confusing similarity test, being a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1.

Therefore, 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.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not an affiliate or licensee of the Complainant, nor has the Respondent obtained authorization to use the Complainant's trademark or to register the disputed domain name.

Moreover, there is no element from which the Panel could infer the Respondent's rights over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

The Panel also finds that the Respondent's use of the disputed domain name does not amount to a bona fide offering of goods or services or a legitimate non-commercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

As mentioned above, the disputed domain name is currently not resolving to an active website, but, according to the Complainant's submissions – which have not been contested by the Respondent – it was previously directed to a website publishing the Complainant's BARACUTA mark and product images identical or similar to those published on the Complainant's official website, where purported BARACUTA products were offered for sale at significantly lower prices than those applied by the Complainant. The Respondent did accurately and prominently disclose its lack of relationship with the Complainant and indicated in the copyright line that its website was the BARACUTA flagship store, with the clear intention to suggest an affiliation with the Complainant. In view of the foregoing, the Panel finds that the Respondent has failed to meet the requirements set forth in the *Ok! Data* test for legitimate resellers, distributors or service providers of a complainant's goods or services to claim nominative fair use of a disputed domain name incorporating a complainant's trademark. [WIPO Overview 3.0](#), section 2.8.

The Panel further finds that the disputed domain name, incorporating the Complainant's registered trademark BARACUTA in combination with the geographical term "Italy", is inherently misleading as it suggests an affiliation with the Complainant. Even where a domain name consists of a trademark plus additional terms, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, the Panel finds the second element of the Policy has been established as well.

### **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.

In view of the prior registration and use of the trademark BARACUTA in connection with the Complainant's clothes and accessories, including online via the Complainant's website at "www.baracuta.com", and the widely known character of the mark in its sector, the Panel finds that the Respondent knew of should have known of the Complainant's BARACUTA mark at the time of the registration of the disputed domain name. [WIPO Overview 3.0](#), section 3.2.2.

According to the screenshots submitted by the Complainant, the disputed domain name resolved prior to this proceeding to a website displaying the Complainant's BARACUTA mark and promoting the online sale of purported BARACUTA products at discounted prices, without providing any disclaimer of non-affiliation with the Complainant and claiming to be the BARACUTA flagship store. In view of such use of the disputed

domain name, the Panel finds that the Respondent intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its website according to paragraph 4(b)(iv) of the Policy.

Furthermore, the disputed domain name does not currently resolve to an active website. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark and, considering the composition of the disputed domain name, the Respondent's failure to submit a Response and the implausibility of any good faith use to which the disputed domain name may be put, finds that, under the circumstances, the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Therefore, the Panel finds that the Complainant has also 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 <italybaracuta.com> be transferred to the Complainant.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: May 5, 2025