

## **ADMINISTRATIVE PANEL DECISION**

Brioni S.p.A. v. Vira segal karo Co  
Case No. DIR2022-0010

### **1. The Parties**

The Complainant is Brioni S.p.A., Italy, represented Studio Barbero, Italy.

The Respondent is Vira segal karo Co, Iran (Islamic Republic of).

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

The disputed domain names <brionishop.ir> and <brionistore.ir> are registered with IRNIC.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 1, 2022. On June 2, 2022, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain names. On June 2, 2022, June 6, 2022, and June 7, 2022, IRNIC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 13, 2022.

On June 13, 2022, the Respondent sent two communications without content.

In accordance with the Rules, paragraph 5(a), the due date for Response was July 3, 2022. On July 4, 2022, the Center notified the Parties that it will proceed to appoint the Administrative Panel.

The Center appointed Alistair Payne as the sole panelist in this matter on July 6, 2022. 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's men's tailoring business under the BRIONI brand was founded in Italy in 1945. Since that time the business has expanded globally to become a very well reputed fashion brand internationally which subsequently has become part of Kering Group. The Complainant's Brioni products are sold through 50 boutiques in Europe, the United States, Asia, and the Middle East as well as online through its website at the domain name <brioni.com>. The Complainant owns various trade mark registrations for its BRIONI mark including International trade mark registration number 1331187 for BRIONI, registered on June 28, 2016, and which is designated in various countries, including in Iran (Islamic Republic of).

The disputed domain names were both registered on December 15, 2020, and are registered by the Respondent who is based in Iran (Islamic Republic of). When the Complainant first became aware of the disputed domain names they were re-directing to webpages at which the disputed domain names were offered for sale, without specifying the requested consideration, and a phone number was indicated in order to contact the owner and to request information. Prior to filing the Complaint, the disputed domain names were re-directing to parking pages with sponsored links to both the Complainant's and to competitors' products. The parking page also features links to an internal <sedo.com> website at which <brionistore.ir> was offered for sale at USD 1,999 and <brionishop.ir> at USD 2,000. Subsequently <brionishop.ir> was re-directed to the Complainant's official website which re-direction was eventually de-activated following correspondence between the parties.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant submits that it owns registered trade mark rights for its BRIONI mark as set out above and that each of the disputed domain names wholly incorporate that mark and are therefore confusingly similar to it. It says that the addition of the elements "shop" or "store" does not prevent a finding of confusing similarity.

The Complainant further submits that the Respondent is not a licensee or authorised agent of the Complainant and is not in any other way authorised to use the BRIONI trade mark. Neither says the Complainant is it in possession of, or aware of, the existence of any evidence demonstrating that the Respondent, who is listed as "Vira segal karo Co" in the public Whols records, is commonly known by a name corresponding to either of the disputed domain names whether as an individual, business, or other organization. Further, says the Complainant, based on the searches performed by its representative, the Respondent does not own any trade mark registrations for BRIONI.

The Complainant notes that the disputed domain names were originally redirected to webpages where the disputed domain names were advertised as being for sale. This, says the Complainant, confirms that the Respondent has no rights or legitimate interests in respect of the disputed domain names and is also evidence of the Respondent's lack of intention to use the disputed domain names in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use. The Complainant also notes that the Respondent's re-direction of the disputed domain name <brionishop.ir> to the Complainant's official website at the domain name <brioni.com> after having received the Complainant's cease and desist letter and subsequent correspondence, should be considered neither as a *bona fide* offering of goods or services nor as a legitimate noncommercial or fair use of the disputed domain names.

The Complainant says that the fact that the disputed domain names are currently re-directed to webpages displaying several pay-per-click sponsored links to the Complainant's products and to those of its competitors indicates that the Respondent is most likely earning commercial revenue from it, which is not a *bona fide* offering of goods or services. Neither, says the Complainant, is it a legitimate noncommercial or fair use of the disputed domain names without intent for commercial gain.

The Respondent's offer to sell the disputed domain names for amounts well in excess of the Respondent's out-of-pocket costs (USD 1,900 and USD 2,000, on the platform Sedo.com, and for USD 937 during the exchange of correspondence with the Complainant's representative) clearly demonstrates, according to the Complainant, that the Respondent never had an intention to use the disputed domain names in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use.

As far as bad faith is concerned, the Complainant submits that considering the degree of international renown attaching to the BRIONI mark and the manner in which the Respondent corresponded prior to the filing of these proceedings, that it must have been aware of the Complainant's mark and business when it registered each of the disputed domain names.

The Complainant submits that the initial re-direction of the disputed domain names to webpages where they were offered for sale demonstrates the Respondent's intention to derive profits from the sale of them based on their inclusion of the Complainant's registered and well-known trade mark. In addition, it says that the re-direction of the disputed domain names to webpages featuring sponsored links to the Complainant's products and to those of competitors which no doubt resulted in the Respondent earning income, is evidence of bad faith in terms of paragraph 4(b)(iv) of the Policy.

The Complainant further notes that in correspondence the Respondent requested USD 937 to transfer the disputed domain names to the Complainant and currently that the disputed domain names are offered for sale for USD 1,999 and USD 2,000 on the Sedo.com platform. This, says the Complainant, is evidence of bad faith in terms of paragraph 4(b)(i) of the Policy.

In addition, submits the Complainant, the Respondent has besides the disputed domain names, registered over 100 domain names that incorporate third-party well-known trade marks, especially in the fashion field, such as <valentinoshop.ir>, <valentinostore.ir>, <armanimarket.ir>, <alexander-mcqueen.ir>, and <bvlgarishop.ir> which is indicative of bad faith in terms of paragraph 4(b)(ii) of the Policy.

## **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 for its BRIONI mark including International trade mark registration number 1331187 for BRIONI, registered on June 28, 2016, which is designated in various countries, including in Iran (Islamic Republic of). Each of the disputed domain names wholly contains the Complainant's BRIONI mark and each disputed domain name is therefore confusingly similar to that mark. The Panel agrees with the Complainant that the addition of the elements "shop" or "store" does not prevent a finding of confusing similarity. Accordingly, the Panel finds that each of the disputed domain names is confusingly similar to the Complainant's BRIONI trade mark registration and that the Complaint succeeds under this element of the Policy.

### **B. Rights or Legitimate Interests**

The Complainant has submitted that the Respondent is not a licensee or authorised agent of the Complainant and is not in any way authorised to use the BRIONI trade mark. It has also asserted that it is not aware of any evidence demonstrating that the Respondent, who is listed as "Vira segal karo Co" in the public Whois records, is commonly known by a name corresponding to either of the disputed domain names whether as an individual, business, or other organization. Further, says the Complainant, based on the searches performed by its representative, the Respondent does not own any trade mark registrations for BRIONI.

Based on the evidence submitted by the Complainant it is apparent that the disputed domain names were originally re-directed to webpages from which they were advertised as being for sale. Subsequently both disputed domain names were re-directed to webpages displaying pay-per-click sponsored links to the Complainant's products and to those of its competitors and were also advertised as being available for sale.

The Respondent's offer to sell the disputed domain names for amounts well in excess of the Respondent's out-of-pocket costs (absent any evidence from the Respondent to the contrary) being USD 1,900 and USD 2,000 respectively on the parking page platform and for USD 937 during an exchange of correspondence with the Complainant's representative is further demonstrative of the Respondent's intentions to profit from the disputed domain names.

None of this conduct is consistent with the Respondent using either of the disputed domain names to make a *bona fide* offering of goods or services and there is nothing else on the record to suggest that the Respondent has done so. Neither is there any evidence that either of the disputed domain names have been used for legitimate noncommercial or fair use purposes. The Respondent's re-direction of the disputed domain name <brionishop.ir> to the Complainant's official website at <brioni.com> after having received the Complainant's cease and desist letter and subsequent correspondence was likely to confuse Internet users into thinking that this disputed domain name was controlled by or associated with the Complainant when this was not the case and is neither legitimate or consistent with a *bona fide* offering of goods or services.

The Complainant has therefore made out a *prima facie* case that the Respondent has no rights or legitimate interests in either of the disputed domain names. In circumstances that the Respondent has failed to respond to or to rebut the Complainant's case, the Panel finds that the Respondent has no rights or legitimate interests in either of the disputed domain names and that the Complaint succeeds under this element of the Policy.

### **C. Registered or Used in Bad Faith**

The disputed domain names were registered in December 2020 some years after the registration of the Complainant's BRIONI trade mark and many decades after the mark was first used by the Complainant or its predecessors. The BRIONI trade mark is a highly distinctive mark that is very unlikely to have been reproduced in the disputed domain names by coincidence and it developed a substantial reputation in relation to tailored clothing for men in a number of countries well before 2020. In addition, the Complainant's International trade mark registered in 2016 for BRIONI is designated in Iran (Islamic Republic of) being the Respondent's apparent location. It therefore appears to the Panel more likely than not that the Respondent was well aware of the Complainant's mark and business when it registered each of the disputed domain names.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of a 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.

In this case there is clear evidence that the Respondent has used each of the disputed domain names which contain the BRIONI trade mark together with the word "store" or "shop" for the purpose of confusing people seeking the Complainant's goods into thinking that they are going to be diverted to the Complainant's website when they are in fact diverted to parking pages that contain pay-per-click links which lead to offers for sale of both the Complainant's BRIONI goods and to the goods of its competitors. It is most likely that the registrar concerned and/or the Respondent gains commercial revenue or opportunity from these links, noting also that on the same parking page each of the disputed domain names is also advertised as being available for sale. The Panel finds that this activity fulfills the requirements of paragraph 4(b)(iv) of the Policy and amounts to evidence of registration and use in bad faith.

Under paragraph 4(b)(i) of the Policy there is evidence of registration and use in bad faith where circumstances indicate that a respondent has registered or acquired a domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name.

The parking pages to which each of the disputed domain names were diverted featured links to a an internal <sedo.com> website at which <brionistore.ir> was offered for sale at USD1,999 and <brionishop.ir> at USD 2,000. Subsequently and during an exchange of correspondence with the Complainant's agents the Respondent offered to sell a disputed domain names to the Complainant for USD 937. All of these figures are well above the Respondent's out of pocket costs in acquisition of the disputed domain names (absent any evidence from the Respondent to the contrary) and in the circumstances there is a strong inference that the Respondent registered or acquired the disputed domain names containing the well reputed BRIONI mark for the purpose of re-selling them at a considerable profit to the Complainant in terms of paragraph 4(b)(i) of the Policy.

This conclusion is only reinforced by the fact that based on the Complainant's evidence, the Respondent has, besides the disputed domain names, registered a whole range of domain names that incorporate third-party well-known trade marks, particularly in the field of high fashion including domain names such as <valentinoshop.ir>, <valentinostore.ir>, <armanimarket.ir>, <alexander-mcqueen.ir>, and <bvlgarishop.ir>. The Respondent therefore appears to be a serial registrant of domain names containing very well reputed marks particularly in the fashion field and has obviously done so with a view to preventing the relevant trade mark owners from registering such marks most likely on the basis that he could either sell them at a profit to the trade mark owner or to a competing third party. This conduct fulfills the requirements of paragraph 4(b)(ii) of the Policy and is further evidence of registration and use in bad faith.

Accordingly, the Panel finds that both the disputed domain names have been registered and 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 names <brionishop.ir> and <brionistore.ir> be transferred to the Complainant.

*/Alistair Payne/*

**Alistair Payne**

Sole Panelist

Date: July 20, 2022