

Decision for dispute CAC-UDRP-104939

Case number	CAC-UDRP-104939
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Time of filing	2022-10-26 10:05:51
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Domain names	BERETTASALE.COM
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Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	Fabbrica d'Armi Pietro Beretta S.p.A.
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Complainant representative

Organization	Claudio Tamburrino (Barzanò & Zanardo Milano S.p.A.)
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Respondent

Name	Mr Gvuder Teuei
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has adduced evidence that it owns the following trademarks in relation to the mark "BERETTA", which remain valid in the following Nice Classification classes:

- International trademark registration No. 147879 of 7 July 1950 in classes 8 and 13;
- International Registration No. 558880 of 27 July 1990 in classes 8 and 13 (whose scope of protection includes China);
- European Union trademark registration No. 3801537 of 19 August 2005 in class 28;
- International trademark registration No. 746766 of 8 November 2000 in class 9 (whose scope of protection includes China);
- European Union trademark registration No. 9743543 of 28 June 2011 in classes 8, 9, 13, 14, 18, 25 and 34.

In addition, the Complainant has adduced evidence that it is the registrant of the domain names <beretta.com>, <beretta.it>, <berettadefense.com>, <berettaholding.com>, all of which were registered before 2022.

The Respondent registered the disputed domain name <berettasale.com> on 6 June 2022.

FACTUAL BACKGROUND

The Complainant, Fabbrica d'Armi Pietro Beretta, is a privately held Italian firearms maker that operates in several countries.

Founded in 1526 by Bartolomeo Beretta, it is the oldest active manufacturer of firearm components in the world. It has supplied weapons for every major European war since 1650. The company today has diversified into the law enforcement and sporting goods markets and has created a global presence including in China, all generating a 2021 turnover approaching €1 billion. In terms of its digital profile, Beretta has established a significant social media presence alongside its website marketing and sales outlets employing its various domain names in order to extend its prestigious and well known brand image for its products.

The Respondent registered the disputed domain name containing the Complainant's BERETTA brand without any authorization before or since.

Screenshots adduced by the Complainant show that the Respondent then proceeded to use the disputed domain name to redirect internet users to a website displaying BERETTA trademarks, official images and clearly counterfeit products. In effect, the Respondent has sought to develop a mirror website to that of the Complainant in order fraudulently to entice internet users into buying what they believe are BERETTA products at heavily discounted prices.

The Complainant adduced in this regard the text of an exchange of e-mails between its online store staff and a dissatisfied customer who made an order via the website associated with the disputed domain name and who was apparently defrauded.

PARTIES CONTENTIONS

COMPLAINANT:

1. IDENTITY OR CONFUSING SIMILARITY

A side-by-side comparison of the disputed domain name and the textual components of the marks on which this Complaint is based makes it evident that the BERETTA brand protected by trademark is recognizable within the disputed domain name and, thus, the disputed domain name is confusingly similar to the marks in which the Complainant has rights.

The disputed domain name indeed incorporates the entirety of the trademark whereas previous panels have already found confusing similarity where at least a dominant feature of the relevant mark is recognizable.

The only difference with respect to the domain name registered by the Complainant, <beretta.com>, is the addition of the generic, non-distinctive and descriptive word "sale". Such an addition neither affects the attractive power of the use of the Complainant's trademark nor is it sufficient to prevent a finding of confusing similarity. Rather, it enhances the likelihood of confusion as it could easily mislead the public into considering the Respondent's website to be another official BERETTA e-commerce outlet.

The Top Level Domain suffix <.com> is merely instrumental to the use of the internet, as has been found by previous panels.

Hence, the first requirement of the Policy is satisfied.

2. RESPONDENT'S LACK OF RIGHTS AND LEGITIMATE INTERESTS

It is a consensus view of UDRP panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of proof to the Respondent. The Complainant contends that the Respondent lacks rights or legitimate interests in the disputed domain name, and that there is no question of bona fide, legitimate or fair use by the Respondent, because:

domain name, and that there is no question of bona fide, legitimate or fair use by the Respondent, because:

- The Complainant has no relationship with the Respondent whatsoever;
- The Respondent has never received any approval on behalf of the Complainant to use its trademarks or official images;
- There is no evidence that the Respondent has acquired any rights in a trademark or trade name corresponding to the disputed domain name;
- The Complainant has adduced proof indicating that the disputed domain name has been associated with fraudulent activities based on supposed discounted prices on BERETTA products;
- The absence of any clear information on the real seller in conjunction with offering goods disproportionately below market value, misappropriating copyrighted images from the Complainant's website, the prompting of consumer complaints, and the improper masking of identity to avoid being contactable, which are all factors that have been found relevant by previous panels.

The Respondent therefore does lack rights or legitimate interests in the disputed domain name.

3. REGISTRATION AND USE IN BAD FAITH

The Respondent registered the domain name so as to be confusingly similar to the Complainant's well known trademarks. Given the distinctiveness and reputation of the BERETTA business and trademarks worldwide, it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of the Complainant and its rights in such marks. Thus, the Respondent has intentionally attempted to attract, for commercial gain, internet users to his website by creating a likelihood of confusion with the Complainant and its marks, as foreseen explicitly in Paragraph 4(b)(iv) of the Policy.

Concerning use in bad faith, as described above the domain name is used to display without authorization BERETTA trademarks, official promotional images and products. Moreover, the products are offered for sale at such a heavily discounted price that they cannot be legitimate offers. This conclusion is also supported by the lack of any clear information on the real seller and by the fact that the disputed domain name has prompted consumer complaints due to fraud. Carrying out unlawful and illicit activities through use of the disputed domain name constitutes registration and use of the disputed domain name in bad faith.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trademark and service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the UDRP were met and that there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has adduced sufficient evidence both to substantiate its own rights and to show the lack of any right or legitimate interests on the Respondent's side.

As in many cases of this kind, the evidence in this case that indicates lack of rights and legitimate interests merges into that which shows bad faith. And there are several elements here, first of all based on the Complaint -- most notably the unauthorized use of content from the Complainant's online outlets to re-create their look and feel on the Respondent's website - but also based on the CAC Case Administrator's preliminary investigation.

That investigation revealed an address in Hong Kong which the Panel notices is suspect since the postal code employed is widely known as being only rarely used locally; it is instead most used in mainland China for despatch to Hong Kong. Further, the Case Administrator provided a photograph showing that the letter the CAC sent to the Respondent in this proceeding was returned to the sender marked address unknown. These elements corroborate the Complainant's contentions as to concealed identity and reinforce the Complainant's central contention that the Respondent aims to mimic the Complainant's web outlets in order to perpetrate a scam on internet users.

The above combination of elements clearly compels a finding of bad faith.

However, the Panel remarks that the technical quality of some of the screenshots submitted in evidence was relatively poor for probative

purposes. Further, the Complainant submitted only the text of the e-mail exchange between a customer dissatisfied with the Respondent's service and the Complainant's online store staff; in particular, no technical information from the e-mail source (headers) or screenshots of the e-mails presented on-screen were presented to the Panel to allow it to assure itself of the veracity of this item of evidence.

Neither aspect affected the Panel's general assessment in what is a straightforward scam case overall. But, in a more finely balanced case, a Complainant would be well advised either to ensure that such evidence is of adequate quality as proof or, if this is not feasible, to explain why for example words and images are not easily recognizable.

Finally, the Complainant in its contentions regarding the shifting of the burden of proof upon making a prima facie case seems to suggest that a Panel is obliged to follow this approach procedurally. The Panel observes that this approach, while accepted by several previous panels, is not laid down in the Policy whereas Paragraph 10(d) of the Rules allocates the responsibility for determining the admissibility, relevance, materiality and weight of the evidence to the Panel in each case. In the present proceeding the Complainant did not elaborate on the practical implications here of the approach it invokes and thus this Panel needs only to record that it did not consider this contention further, the evidence being, as noted above, compelling.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

- 1. **BERETTASALE.COM**: Transferred

PANELLISTS

Name	Kevin Madders
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DATE OF PANEL DECISION 2022-12-06

Publish the Decision