



**WIPO Arbitration and Mediation Center**

**ADMINISTRATIVE PANEL DECISION**

Fall Nummer: D2003-0699

Entscheidung vom 29. Oktober 2003

**1. The Parties**

The Complainants are three companies constituting the Ermenegildo Zegna Group ...: ... (hereinafter Complainant), ...

The Respondent is Mr. Mario G..., of Napoli, Italy.

**2. The Domain Name and Registrar**

The disputed domain name <zegnaermenegildo.org> is registered with Register.com.

**3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 5, 2003. On September 9, 2003, the Center transmitted by email to Register.com a request for registrar verification in connection with the domain name at issue. On September 9, 2003, Register.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 10, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was September 30, 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 3, 2003.

The Center appointed Mr. Fabrizio Bedarida as the Sole Panelist in this matter on October 16, 2003. 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.

The language of the proceeding is English.

#### 4. F a c t u a l B a c k g r o u n d

The Complainant is an internationally well known group in the field of fashion and the owner of several hundred trademarks, filed and/or registered throughout the world, comprising the words ERMENEGILDO ZEGNA. Complainant's first application for the trademark ERMENEGILDO ZEGNA in Italy dates back to 1952. The Respondent applied for the domain name <zegnaermenegildo.org> on August 12, 2003. The Complaint is aimed at getting the domain name at issue transferred to Consitex S.A.

#### 5. P a r t i e s ' C o n t e n t i o n s

##### A. Complainant

The Complainant submits that:

The domain name <zegnaermenegildo.org> is used to redirect Internet users to a pornographic website.

That the Ermenegildo Zegna Group is an internationally well-known group in the field of fashion and the owner of several hundreds trademarks including the words Ermenegildo Zegna.

The Ermenegildo Zegna is a world renowned trademark.

The domain name <zegnaermenegildo.org> is confusingly similar to the trademark ERMENEGILDO ZEGNA owned by Complainant.

The Respondent, who is located in Italy, where the Ermenegildo Zegna Group was founded and has its international headquarters, cannot have ignored Complainant's trademark ERMENEGILDO ZEGNA, thus the registration of the disputed domain name may only have occurred in bad faith.

That upon information and belief, Respondent has no rights or legitimate interests in respect of the disputed domain name.

There is no evidence of the Respondent's use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

Upon information and belief, there is no evidence that Respondent has been commonly known by the domain name nor has done business under the domain name.

There is no evidence that Respondent is making a legitimate non-commercial or fair use of the domain name.

As regards the fact that the domain name was registered and is being used in bad faith, Complainant alleges that:

The default page of <zegnermenegildo.org> resolves to a pornographic portal intended for homosexuals, selling various services connected with pornography.

Complainant thus submits to be in the presence of a " pornosquatting " case, where a cybersquatter tries to take advantage of a well known trademark and or trade name to attract Internet users to a pornographic website. In addition, the pornographic website uses " mouse trapping " techniques to prevent visitors from leaving it.

## B. Respondent

The Respondent did not reply to the Complainant's contentions. Thus Respondent has failed to submit any statement. He has not contested the allegations in the Complaint and the Panel shall decide on the basis of Complainant's submissions, and shall draw such inferences from the Respondent's default that it considers appropriate (paragraph 14(b) of the Rules).

## 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 in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable. "

Paragraph 4(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the domain names registered by the Respondent be transferred to the Complainant:

1) the domain names are identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights;

2) the Respondent has no rights or legitimate interests in respect of the domain names;

3) the domain names have been registered and are being used in bad faith.

#### A. Identical or Confusingly Similar

Complainant has demonstrated rights in the ERMENEGILDO ZEGNA trademark, including registrations in Italy, where Respondent is located. It is unquestionable that Complainant's trademark registrations pre-date Respondent's domain name registration.

The domain name <zegnaermenegildo.org> is constituted of two words: ZEGNA and ERMENEGILDO both identical to the words constituting Complainant's trademark.

It is immediately clear that this mere order reversal of the words is not sufficient to avoid confusion, especially when they correspond to a well known trademark that is moreover a patronymic name.

In addition, the Panel agrees with Complainant's allegation that in Italian as well as in other languages, it is quite common to use the last name (Zegna) before the first (Ermenegildo). Therefore the domain name <zegnaermenegildo.org> ERMENEGILDOZEGNA and ZEGNAERMENEGILDO might be regarded as functionally identical (Consitex S.A., Lanificio Ermenegildo Zegna & Figli S.p.A., Ermenegildo Zegna Corporation v. Alexander Albert W. Gore, WIPO Case No. D2003-0483).

In view of all the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark ERMENEGILDO ZEGNA.

#### B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The respondent in a UDRP proceeding does not assume the burden of proof, but may

establish a right or legitimate interest in a disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy:

a) that before any notice to the respondent of the dispute, he or she used or made preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

b) that the respondent is commonly known by the domain name, even if he or she has not acquired any trademark rights; or

c) that the respondent intends to make a legitimate, non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Respondent does not appear to have any connection or affiliation with the Complainant, which has not licensed or otherwise authorised Respondent to use or apply for any domain name incorporating the ERMENEGILDO ZEGNA trademark. Respondent does not appear to make any legitimate use of the domain name for his own commercial or non-commercial activities. Respondent has not been known under this domain name. Respondent has not filed any Response to the Complaint and has not alleged any facts or elements to justify prior rights and/or legitimate interests in the disputed domain name. Therefore, the Panel concludes that the absence of any legitimate use, the fact that the domain name resolved to a pornographic portal, and the Respondent's failure to justify the use of the disputed domain name, constitutes prima facie evidence of a lack of rights to or legitimate interests in the domain name.

Accordingly, the Panel finds that the Complainant has satisfied the burden of proof with respect to paragraph 4(a)(ii) of the Policy.

### C. Registered and Used in Bad Faith

The Respondent has registered a domain name which mirrors an internationally well known trademark to which he cannot possibly have acquired any rights. According to the Policy criteria Complainant has shown that Respondent, when registering the domain name at issue in these proceedings, was well aware of the Complainant's trade mark ERMENEGILDO ZEGNA and intentionally chose to register it as a domain name. Thus it appears that Respondent, being aware that the use of a well known trademark would create confusion among visitors, chose the <zegnaermenegildo.org> domain name, in order to attract on his pornographic website searchers who were looking for totally unrelated contents. Moreover, the fact that the pornographic website uses a technique, known as "mouse-trapping," to prevent visitors from leaving the website reinforces a finding of bad faith use of the disputed domain name.

The Panel is therefore convinced that the registration under such circumstances and the ensuing use of the domain name in its pornographic context is evidence of Respondent's registration and use in bad faith.

## 7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name, <zegnaermenegildo.org>, be transferred to Consitex S.A.