



Asian Domain Name Dispute Resolution Centre

beijing

## **ADMINISTRATIVE PANEL DECISION**

**Case No. CN-2301521**

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**Complainant: CONFEZIONI LERARIO S.R.L**

**Respondent: shu zhi**

**Domain Name: tagliatores.com**

**Registrar: Name.com, Inc.**

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### **1. Procedural History**

On 5 January 2023, the Complainant submitted a Complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC Beijing Office) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) and the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules) approved by the ADNDRC.

On 13 January 2023, the ADNDRC Beijing Office sent to the Complainant by email an acknowledgement of the receipt of the Complaint and transmitted by email to ICANN and the Registrar, Name.com, Inc., a request for registrar verification in connection with the disputed domain name.

On 17 January 2023, the Registrar transmitted by email to the ADNDRC Beijing Office its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 18 January 2023, the ADNDRC Beijing Office notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent and the case officially commenced. On the same day, the ADNDRC Beijing Office transmitted the Written Notice of the Complaint to the Respondent, which informed that the Complainant had filed a Complaint against the disputed domain name and the ADNDRC Beijing Office had sent the Complaint and its attachments through email according to the Rules and the Supplemental Rules. On the same day, the ADNDRC Beijing Office notified ICANN and the Registrar, Name.com, Inc., of the

commencement of the proceedings.

The Respondent failed to submit a Response within the specified time period. The ADNDRC Beijing Office notified the Respondent's default. Since the Respondent did not mention the Panel selection in accordance with the time specified in the Rules, the ADNDRC Supplemental Rules, and the Notification, the ADNDRC Beijing Office informed the Complainant and the Respondent that the ADNDRC Beijing Office would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Dr. Kun Fan, the ADNDRC Beijing Office notified the parties on 8 February 2023 that the Panel in this case had been selected, with Dr. Kun Fan acting as the sole panelist. The Panel determines that the appointment was made in accordance with Paragraph 6 of the Rules and Articles 8 and 9 of the Supplemental Rules.

On 8 February 2023, the Panel received the file from the ADNDRC Beijing Office and should render the Decision within 14 days, i.e., on or before 22 February 2023.

Pursuant to Paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

## **2. Factual Background**

### **A. The Complainant**

The Complainant in this case is CONFEZIONI LERARIO S.R.L. The registered address is VIA MOTTOLA KM 2, 200 ZONA IND. I-74015 MARTINA FRANCA (TA). The authorized representative in this case is CCPIT Patent & Trademark Law Office.

### **B. The Respondent**

The Respondent in this case is shu zhi. The registered address is Changning District, Shanghai, China.

The Respondent is the current registrant of the disputed domain name "tagliatores.com", which was registered on 26 September 2022 according to the WHOIS information. The Registrar of the disputed domain name is Name.com, Inc.

## **3. Parties' Contentions**

## **A. The Complainant**

### **(1) The disputed domain name is identical or confusingly similar to the trademark or service mark owned by the Complainant, which is very likely to cause confusion**

The Complainant is an Italian clothing company which makes its entire clothing production in Italy branded *Tagliatore*. The brand *Tagliatore* is enjoying considerable success in Italy and abroad.

The Complainant was founded in 1984 by Mr. Francesco Lerario, who as a young man was nicknamed the “Tagliatore” so much so that in 2007 a book was dedicated to him, by his son Pino Lerario, who is a stylist of the Complainant and other employees in the production and administration sited in Martina Franca (Italy).

As a result of Complainant’s investments in promoting, advertising and promotional activities, the Complainant has enjoyed great popularity and goodwill before 26 September 2022, the registration date of the disputed domain name, in Italy and across the globe, China included.

The trademarks “**tagliatore**” (Reg. No. G1277938), and “TAGLIATORE” (Reg. No. G1448089) are registered by the Complainant in China.

Apart from the aforesaid marks, the Complainant is the registrant since 2005 of the domain name <tagliatore.com> and <tagliatore.it>, where the clothing branded “Tagliatore” is promoted. This internet website, from 1 January 2022 to 17 November 2022, generated almost 120,000 visits (sessions) by people knowing the word “Tagliatore” (organic search, direct, social and referral). Among the disputed domain name <tagliatores.com>, “.com” is the generic suffix of the domain name, leaving the distinguishable part of the disputed domain name to be “tagliatores”, which consists of the Complainant’s mark “TAGLIATORE” in whole and the word “s”.

The word “s” *per se* is not distinctive in domain names given its implication that the website using such domain names is actually an electronic marketplace. Combining with the Complainant’s mark “TAGLIATORE”, the disputed domain name <tagliatores.com> suggests the website using it is a store selling items branded “TAGLIATORE”, which would very likely confuse the public as to the relationship between the website and the Complainant.

The Complainant considers the similarity between the disputed domain name and the Complainant’s own mark sufficient to cause confusion among the public, thereby infringing the Complainant’s civil rights and interests, as well as the consumer’s legitimate interests. As such, this complaint satisfies the requirement under Paragraph 4(a)(i) of the Policy.

### **(2) The Respondent has no rights or legitimate interests in respect of the disputed domain name**

The Complainant contends that the Respondent is not affiliated with the Complainant nor with any affiliates of the Complainant. The Complainant has never granted the Respondent any authorization or license to use the trademark or service mark of the Complainant. Nor has the Complainant ever consented to the Respondent's registration of the disputed domain name in which the Complainant's mark "TAGLIATORE" is used.

The Respondent does not have any trademark registration, business registration, or other civil rights in respect of "TAGLIATORE". In addition, the disputed domain name was registered after the registration of the Complainant's trademarks and relevant domain names.

Therefore, the Respondent has no rights or legitimate interests in the disputed domain name and this complaint satisfies the requirement under Paragraph 4(a)(ii) of the Policy.

**(3) The disputed domain name has been registered and is being used in bad faith**

i. Copying of the Complainant's website

The disputed domain name <tagliatores.com>, registered on 26 September 2022 that uses the same Italian word "Tagliatore" was already used by the Complainant before, on the Complainant's website [www.tagliatore.com](http://www.tagliatore.com) (as results, for example, from [www.archive.org](http://www.archive.org) of 16 September 2021) and on social pages facebook and Instagram. The disputed domain name has the same distinctive sign "Tagliatore", as well as the possibility of selling them at a very low price that the website declares equal to 1/5 (one fifth) of the original one.

ii. Public confusion caused by the Respondent's use of the disputed domain name

The Complainant has become aware that third parties have been misled by the disputed domain name and the corresponding website because they thought it was an outlet sale website attributable to the original trademark "TAGLIATORE". This is the demonstration that it is easy to mislead the consumer, since the fake website has the same distinctive sign "Tagliatore", as well as the possibility of selling them at a very low price that the website declares equal to 1/5 (one fifth) of the original one. In fact, it is easy to see that the related web pages of [www.tagliatores.com](http://www.tagliatores.com) have the same images of both the dresses and the models (as a person) compared to the original website <https://www.tagliatore.com/> and its social networks.

iii. Other acts of deception

On similar case the fake websites "www.tagliatorestore.com" and "www.tagliatoreonlinestore.com", although apparently owned by different subjects, were transferred to the Complainant respectively by the decisions of 25 October 2022 and of 16 November 2022, issued by the ADNDRC.

These websites use the same images and the mark “Tagliatore” of Italian company. On this matter, the decision on “www.tagliatorestore.com” affirmed that “(...) Respondent is actively pursuing commercial benefits by registering the Complainant’s mark “TAGLIATORE” as a domain name, passing his website off as the Complainant’s, and eliciting commercial transactions with those who are deceived. Such behaviors are clearly in bad faith and should be prohibited by the law pursuant to Paragraph 4(a)(iii) of the Policy in order to protect the Complainant’s prior intellectual properties and civil rights, the legitimate rights and interests of the consumers, as well as the fair competition of the marketplace”.

Referring to that, the decision on the site “www.tagliatoreonlinestore.com” also states that: (...) Consequently, the Panel considers that the Respondent registered the disputed domain name in bad faith. The use of the Disputed Domain Name for displaying a merchant website imitating the Complainant’s website by reproducing the look and feel of the latter, including the Complainant’s trademark and logo as well as photographs of the Complainant’s products offered for sale constitutes use in bad faith.

Furthermore, the decision on “www.tagliatorestore.com” affirmed the reputation of the mark “Tagliatore”: “(...) The evidence provided by the Complainant also shows that the “TAGLIATORE” mark has accumulated a considerable reputation by 2022 when the Respondent first registered the disputed domain name”.

In light of the above, the Complainant believes that the Respondent is actively pursuing commercial benefits by registering the Complainant’s mark “TAGLIATORE” as a domain name, passing his website off as the Complainant’s, and eliciting commercial transactions with those who are deceived. Such behaviors are clearly in bad faith and should be prohibited by the law pursuant to Paragraph 4(a)(iii) of the Policy in order to protect the Complainant’s prior intellectual properties and civil rights, the legitimate rights and interests of the consumers, as well as the fair competition of the marketplace.

Based on the aforesaid factual and legal grounds, the Complainant hereby requests the transfer of the disputed domain name to the Complainant.

## **B. The Respondent**

The Respondent failed to submit a Response within the specified time period.

## **4. Discussions and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, the Complainant shall prove the following three elements:

(i) The disputed domain name is identical or confusingly similar to a trademark or

service mark in which the Complainant has rights;

(ii) The registrant has no rights or legitimate interests in respect of the disputed domain name; and

(iii) The disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

(i) Circumstances indicating that the respondent has registered or acquired the 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 documented out-of-pocket costs directly related to the domain name; or

(ii) The respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) The respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) By using the domain name, the respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

#### **A. Identity or Confusing Similarity**

According to evidence provided by the Complainant, the Complainant owns "TAGLIATORE" series of trademarks in several countries, including China. Particulars of the registration of the trademark "TAGLIATORE" in China are as follows:

c	MARK	Registration No.	International Registration Date	Country	Class
1.	<b>tagliatore</b>	G1277938	31 July 2015	CN	25
2.	TAGLIATORE	G1448089	5 December 2017	CN	35

The Respondent has not provided contrary evidence. The Panel is satisfied that the Complainant's trademarks "TAGLIATORE" is protected in China prior to the registration of disputed domain name on 26 September 2022.

The distinctive part of the disputed domain name <tagliatores.com> is "tagliatores". It includes the Complainant's registered trademark "TAGLIATORE" in its entirety, with the additional word "s".

The Panel notes that WIPO Jurisprudential Overview 3.0 provides that "[w]here the

relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.” (WIPO Jurisprudential Overview 3.0, para 1.8). The Panel agrees with and will adopt the above standard to determine whether the disputed domain name is confusingly similar to the Complainant’s trademark.

The Panel considers that, when seeing the disputed domain name, if a potential consumer will reasonably believe the disputed domain name is registered by or closely linked to the trademark holder, then confusing similarity for the first element is established. When considering the aspect of confusing similarity, the Panel needs to take into account several factors. The more distinctive the prior rights are, the more likely it is for the disputed domain name to cause confusing similarity.

In the present case, the Complainant’s trademark “TAGLIATORE” is not a generic English word. It is an Italian word and the nickname of the Complainant’s founder Mr. Francesco Lerario. It has been used as the Complainant’s trademark since 2015, forming a stable and unique correspondence relationship with the Complainant. The Panel believes that the addition of the meaningless term “s” would not prevent the confusing connection between the disputed domain name and Complainant’s trademark “TAGLIATORE”.

The Panel therefore finds that the disputed domain name is confusingly similar with the Complainant’s trademark in which the Complainant has civil rights and interests.

Accordingly, the first condition of Article 4(a) of the Policy is satisfied.

## **B. Rights or Legitimate Interests of the Respondent**

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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

To demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defenses under paragraph 4(c) of the Policy include the following:

- (i) before any notice of the dispute, the respondent’s use of, or demonstrable 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
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making 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 or service mark at issue.

In this case, the Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name because (a) the Respondent is not affiliated with the Complainant nor with any affiliates of the Complainant; (b) the Complainant has never granted the Respondent any authorization or license to use the trademark or service mark of the Complainant; (c) the Complainant has never ever consented to the Respondent's registration of the disputed domain name in which the Complainant's mark "TAGLIATORE" is used; and (d) the Respondent does not have any trademark registration, business registration, or other civil rights in respect of "TAGLIATORE".

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the burden is shifted to the Respondent to demonstrate its rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy. The Respondent has not provided any evidence to prove its rights or legitimate interests in the disputed domain name. The Panel also could not find any rights or legitimate interests under paragraph 4(c) of the Policy.

Accordingly, the second condition of Article 4(a) of the Policy is satisfied.

### **C. Bad Faith**

Under the third condition of the Policy, the Complainant must establish that the disputed domain name has been both registered and is being used in bad faith by the Respondent.

The Complainant has produced evidence to demonstrate to the satisfaction of the Panel that the "TAGLIATORE" trademarks are distinctive, as the Italian nickname of its founder. The Complainant has produced evidence to prove that the Complainant's registered trademarks "TAGLIATORE" have gained a high reputation around the world including China through its advertising and promotional activities. In such circumstances, it is very likely that the disputed domain name has been selected with the Complainant's brand in mind. It would be an extraordinary coincidence if the Respondent had come up with the disputed domain name independently. The Panel is of the view that the Respondent knew of the Complainant's trademark when registering the disputed domain name. Therefore, the disputed domain name was registered in bad faith.

The Complainant has also produced evidence to demonstrate to the satisfaction of the Panel that on the website of the disputed domain name, the Respondent uses the same distinctive sign "Tagliatore", and uses the same images of both the dresses and



the models of clothing compared to the Complainant's official website <https://www.tagliatore.com/> and its social networks, but sells them a much lower price (1/5 of its original price).

The Panel finds that the Respondent's use of the disputed domain name indicates an intent to create user confusion, so as to attract for commercial gain. It constitutes bad faith use under Paragraph 4(b)(iv) of the Policy, namely, "by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location."

In light of the above, the Panel finds that the disputed domain name was registered and used in bad faith.

Accordingly, the third condition of Article 4(a) of the Policy is satisfied.

## **5. Decision**

For all the foregoing reasons, all three conditions under paragraph 4(a) of the Policy are satisfied. Therefore, the Panel orders that the disputed domain name <tagliatores.com> be transferred to the Complainant CONFEZIONI LERARIO S.R.L.

*Fan Kun*

(Signature)

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Kun Fan

Dated: 22 February 2023