

DECISION OF THE THIRD-PARTY DECIDER

Diadora S.p.A / Yang Nianyong

Case No. 444182 / diadora.be

1. The Parties

1.1. Complainant:

Diadora S.p.A.
Via Montello, 80
31031 Caerano di San Marco (TV)
Italy

Represented by:

Ms. Michele Provera
Head of IP Department – Convey s.r.l.
Corso Vernardino Telesio, 29
10146 Torino
Italy

1.2. Domain name holder:

Yang Nianyong
134, East Minsheng 3
10480 Taipei
Taiwan

2. Domain name

Domain name: diadora.be
Registered on: August 21st, 2015

Hereinafter referred to as "the Domain name".

3. Procedure

On December 22, 2022, the Complainant filed a complaint regarding the Domain name (hereinafter the "Complaint") with the Belgian Centre for Arbitration and Mediation (CEPANI), requesting the transfer of the Domain name to the Complainant, in accordance with the CEPANI rules for domain name dispute resolution (hereinafter the "Rules") and the Dispute Resolution Policy of DNS.be, incorporated in its General terms and conditions for .be domain name registration (hereinafter referred to as the "DNS Terms and condition").

The Domain name was therefore put on hold.

On January 25, 2023, CEPANI appointed the undersigned, Ms. Florence Margenat, as the Third-Party Decider to settle the Domain name dispute.

The Domain name holder did not submit any response to the Complaint.

On February 1st, 2023, the deliberations were closed.

In accordance with article 6.4. of the Rules, this decision is based solely on the Complaint, including the exhibits attached to the Complaint.

4. Factual Background information

The Complainant is a company registered in Italy, founded in 1948 and active in athletic footwear and apparel manufacturing. Since then, it has developed its products range (from mountain climbing, ski and after-ski boots to work shoes, passing by tennis, running and football shoes). It has developed numerous collaborations for this purpose.

The Compliant is the owner of several trademarks "DIADORA", registered worldwide, including the following, on which its Complaint is based (hereafter the "Diadora Trademarks"):

- INT. TM n° 682095A of July 31, 1997, in classes 3, 9, 12, 14, 16, 18, 25, 28;
- INT. TM n° 682095 of July 31, 1997, in classes 3, 9, 12, 14, 16, 18, 25, 28;
- European Union TM. n° 000339093 of January 07, 1999, in classes 18, 22 and 25;
- U.S.A. TM n° 2282558 of October 5, 1999 in classes 18 and 25.

The Complainant has made considerable efforts to protect and promote its brand, thus acquiring the trademark's goodwill:

- Registration of several domain names consisting of or comprising the trademark DIADORA under several different TLDs, including diadora.com, which was registered on October 19, 2013, or diadora.cn, registered on May 21, 2014.
- Promotion on the Internet using websites created by the Complainant (<https://www.diadora.com> and <https://www.diadorautility.com>), that generate a significant number of visits by Internet users.

- Promotion on the main social media: Facebook, Instagram, Twitter, Youtube (Annex 3). As an example, the official Facebook page Diadora counts over 900.000 followers worldwide.

According to the Complainant, the sign "Diadora" appears to have been used as a trademark since 1997, and as a tradename since 1948. The brand "DIADORA" (including trademark and tradename) has since acquired a "worldwide reputation in the footwear manufacturing sector".

The Domain name (diadora.be) was registered by the Domain name holder on August 21, 2015, apparently without the Complainant's authorization, and was then redirected to Sedo.com, LLC, a parking page aimed at offering the domain name for sale for 8.500 USD, as well as on the Afternic platform, for 9.999 USD.

The Domain name holder is a certain Yang Nianyong, based in Taiwan.

On April 17, 2022, the Domain name holder addressed an e-mail to the Complainant, with these words: *"I think diadora.be is very useful for your business. Please go to Sedo to purchase it: [...] Please reply me if you're interesting of it, and we support both Escrow.com and Sedo.com, transfer is very quick and 100% safely"*.

On April 29, 2022, the Compliant instructed its representative to address to the Domain Name holder a summons letter, notifying him of the infringement of the Complainant's trademarks rights, requesting the immediate cease of any use, and the transfer, of the Domain Name to the Complainant.

The same letter of summon was sent on the same day to the Domain name holder via the DNS.be contact online form indicated in the WHOIS records.

The Respondent did not answer to neither of these summons letters.

The Domain name does not lead to any active website.

5. Position of the parties

5.1. Position of the Complainant

The Complainant requests the transfer of the Domain name under its ownership and control, and claims that the three cumulative conditions for such transfer are met:

- the Domain name is identical to the various trademarks in which the Complainant has rights worldwide, as it incorporates the Complainant's entire trademarks;
- the Domain name holder has no rights or legitimate interests in the Domain name, as it has no connection with the Complainant's trademarks nor company;

- the Domain name holder has registered and is using the Domain Name in bad faith, particularly in order to take advantage of the Complainant's reputation and trademarks.

5.2. Position of the Domain name holder

The Domain Name Holder did not submit any response.

6. Discussion and findings

According to Article 16.1 of the CEPANI rules for domain name dispute resolution, the Third-Party Decider shall rule on domain name disputes with due regard for the Policy and the CEPANI rules for domain name dispute resolution.

According to Article 10b (1) of the DNS Terms and conditions, the Complainant must provide evidence of the following:

- *"the Domain name holder is identical or confusingly similar to a trademark, a tradename, a social name or corporation name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the Complainant has rights; and*
- *the Domain name holder has no rights or legitimate interests in the domain name; and*
- *the Domain name holder's domain name has been registered or is being used in bad faith."*

6.1. The Domain Name is identical or confusingly similar to trademarks in which the Complainant has rights

The Complainant has established the existence of several trademarks "DIADORA", registered in a large number of countries, and amongst others in Europe and in the US, at least since 1997.

The Domain name registered by the Domain name holder, « diadora.be », is identical to those trademarks in which the Complainant has rights, since it incorporates the entire word constituting the DIADORA trademarks.

According to the CEPANI case-law, country code top-level domains (ccTLDs), such as the suffix ".be", are not relevant to establish the identity or similarity between a domain name and a trademark (CEPANI case no. 44409 SOCIETE NOUVELLE DEL ARTE SAS / Mr. Arafat OZTURK, September 21st, 2016).

For these reasons, the Third-Party Decider rules that the Domain name is identical to the DIADORA trademarks and trade name in which the Complainant has rights.

Considering the above, the Third-Party Decider rules that the first element of Article 10.b(1) of the DNS Terms and condition is fulfilled.

6.2. The Domain name holder has no rights or legitimate interests in the Domain Name

According to Article 10.b.1, ii) of the DNS Terms and conditions, the Complainant has to prove that the Domain Name Holder has no rights or legitimate interests in the Domain Name.

According to the CEPANI case-law, it is widely accepted that, given the difficulty of proving a negative fact, a Complainant must only establish a *prima facie* case that the Domain name holder has no rights or legitimate interests, for example by stating that the latest is unaware of any reason or circumstance which could be indicative of such a right or legitimate interest (see for example cases nr. 44409 Société nouvelle del arte sas / Mr. Arafat Ozturk, September 21st, 2016).

If the Complainant succeeds, the burden of proof then shifts to the Domain name holder which must then provide relevant evidence of rights or legitimate interests in the Domain Name (see for example the CEPANI cases nr. 444110, Clarins vs. Leihcim Revalk, December 30, 2020, and nr. 444122, Carrefour vs. Hagenimana, March 25th, 2021)

According to Article 10, b), 3) of the DNS Terms and conditions, the registrant can demonstrate his rights or legitimate interests to the domain name by the following circumstances:

- *prior to any notice of the dispute, the registrant used the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services or made demonstrable preparations for such use; or*
- *the registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if he has no trademark; or*
- *the registrant is making a legitimate and non-commercial or fair use of the domain name, without intent to misleadingly divert consumers for commercial gain or to tarnish the trademark, trade name, social name or corporation name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity at issue.*

The Complainant asserts the following facts:

- The Respondent is not a licensee or authorized agent of the Complainant, nor is authorized in any other way to use the Complainant's trademarks.
- The Domain name holder is not an authorized reseller of the Complainant and has not been authorized to the registration and use of the Domain name.

- The Domain name holder is not commonly known by the Domain name as an individual, a business or another organization and their family names do not match DIADORA.
- The Domain name holder's use cannot be considered neither a *bona fide* offering of goods or services nor a legitimate non-commercial or fair use of the disputed Domain Name. On the contrary, the offering for sale of a Domain name shows that the Domain name holder's intention was to take advantage of the Complainant's reputation and trademarks.
- The Respondent has registered the disputed Domain Name – which is identical to the Complainant's trademarks – to prevent the Complainant's from reflecting the mark in a corresponding Domain Name.

The Third-Party Decider notes that the domain name was placed by the Domain name holder on a Sedo.com, LLC parking page aimed at offering the Domain Name for sale for 8.500 USD, and that the Domain name is also offered for sale on Afternic platform for 9.999 USD. The purpose of such an approach is undoubtedly to sell this Domain name, and thus to (unduly) benefit from its registration. The Domain name holder has, moreover, offered it for sale to the Complainant, by an e-mail of April 17, 2022.

Now, it has already been decided that:

- the registration and use by the Domain name holder of a Domain name that incorporates the Complainants' trademarks in their entirety, in order to impersonate the Complainants, does not constitute a *bona fide* offering of goods or services or fair use (CEPANI case nr. 444170 Eastman Chemical Company & Eastman Chemical HTF GmbH / Rodun International BV, October 14th, 2022).
- the mere registration of a domain name does not create an intellectual property right (CEPANI case nr. 44260 Sputnik TV BVBA / Alexander White, March 16th, 2012).
- the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

The Complainant therefore reasonably asserts – in its Complaints and evidence – that the Domain name holder does not have any rights or legitimate interests in the Domain name.

By not submitting a response to the Complainant, the Domain name holder failed to provide any explanation or evidence to establish any rights or legitimate interests in the Domain name.

Considering the above, the Third-Party Decider rules that the second element of Article 10.b(1) of the DNS Terms and conditions is fulfilled.

6.3. The Domain name holder's Domain Name has been registered or is being used in bad faith

According to Article 10, b), 2) of the DNS Terms and conditions, evidence of such bad faith registration or use of domain names can *inter alia* be demonstrated by a non-exhaustive list of circumstances (see for example CEPANI case nr. 44199, June 25, 2010 (eurosocap.be); CEPANI case nr. 44233, July 5th, 2011 (piperheidsieck.be)):

- *circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark, trade name, registered name or company name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity, or to a competitor of the complainant, for a price that exceeds the costs that the registrant can show are directly related to the acquisition of the domain name;*
- *the domain name was registered in order to prevent the owner of a trademark, a trade name, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or a name of a geographical entity to use the domain name and that the registrant has engaged in a pattern of such conduct;*
- *the registrant has registered one or more personal names without the existence of a demonstrable link between the registrant and the registered domain names.*

In this case, it should be noted that:

- In view of the registration and intensive use of the trademarks "DIADORA" since 1948, the advertising and sales of the Complainant's products worldwide, the Domain name holder could not have been unaware of the existence of the Complainant's trademark, which is identical to the disputed Domain Name.
- The Domain name holder clearly registered the disputed Domain Name with the intention of referring to the Complainant and its trademarks.

The above is demonstrated, on the one hand, by the fact that the Domain name was offered for sale on a Sedo.com, LLC parking page and on the Afternic platform for a significant price, that exceeds the costs that the registrant incurred in acquiring the Domain name, and on the other hand, by the e-mail sent by the Domain name holder to the Complainant on April 17th, 2022 offering to purchase the Domain Name.

Finally, the Domain name holder never answered to the summons letters sent to him by the Complainant on April 29, 2022, nor to the Complaint filed by Complainant with CEPANI on December 26, 2022. By failing to respond to the Complaint, the Respondent has taken no initiative to challenge the foregoing.

Based on the above, the Third-Party decider rules that the Domain Name has been registered and is being used in bad faith, and that the condition stated in Article 10, b), 1, iii), of the Policy is therefore fulfilled.

7. Decision

Consequently, pursuant Article 10(e) of the *Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE*, the Third-Party Decider hereby rules that the registration of the domain name "**diadora.be**" is to be transferred to the Complainant.

Brussels, February 15th, 2023.

Florence MARGENAT
The Third-party Decider