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ARBITRATION AWARD

.IN REGISTRY

(C/O NATIONAL INTERNET EXCHANGE OF India)

Before the Sole Arbitrator, Binny Kalra

Disputed domain name <**BRIONI.IN**>

INDRP Case No: 1368

In the matter of:

Brioni S.p.A.

vs

Doublefist Limited

Complainant

Respondent

Binny Kalra

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Before the Sole Arbitrator, Binny Kalra

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In the matter of:

Brioni S.p.A.,
Piazza San Bernardo, 101,00187 Roma,
Italy

Complainant

v.

Doublefist Limited
Wisconsin
USA

Respondent

INDRP Case No: 1368

1. The Parties:

The Complainant is Brioni S.p.A., a company incorporated under the laws of Italy, who is represented in these proceedings by an attorney, namely, Mr. Luca Barbero, c/o Studio Barbero S.p.A., Corso Massimo d'Azeglio 57, 10126 Torino, Italy. The authorization in favour of the said attorney is at Annex 10. The Respondent is Doublefist Limited, USA. The Respondent is not represented in these proceedings.

2. The domain name, Registrar, and Policy:

The disputed domain name is www.brioni.in (hereinafter referred to as the "**Disputed Domain Name**"). The Registrar for the Disputed Domain Name is Dynadot LLC, having its address at 210 S Ellsworth Ave #345 San Mateo, CA 94401, USA. The present arbitration is being conducted in accordance with the Arbitration



and Conciliation Act, 1996, the .IN Domain Name Dispute Resolution Policy (“**Policy**”) and the INDRP Rules of Procedure (“**Rules**”).

3. Procedural history:

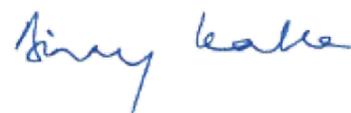
- 1 April 2021: Statement of acceptance along with a declaration of impartiality and independence was sent by the arbitrator to the .IN Registry
- 5 April 2021: The .IN Registry transmitted information of appointment of the arbitrator and circulated the complaint and its annexures to the parties
Type text here
- 5 April 2021: Notice of commencement of arbitration proceedings was sent by the Panel to the parties and a period of 21 days, until 26 April 2021, was given to the Respondent to submit a statement of defense
- 6 April 2021: The Complainant requested some clarifications under Rule 3 of the INDRP Rules of Procedure
- 8 April 2021: The Panel provided the requested clarifications in response to the Complainant’s inquiry which the Complainant acted upon on the same date
- 4 May 2021: The Panel wrote to the Parties and NIXI to record that no statement of defense or other communication was forthcoming from the Respondent by the due date therefore its right to file the statement of defense stood forfeited. The award was accordingly reserved.

4. Complainant’s case:

The Complainant’s submissions in the complaint are recapitulated here in brief:



- i. The Complainant, Brioni S.p.A., is the owner of the trademark BRIONI in several countries and has been using it in connection with its on-going business. The Complainant has given details of its registrations in India and other countries (Annex 2 and Annex 3 collectively);
- ii. The Complainant traces its history to 1945 when its first shop was opened in Rome, Italy. This was followed by events like fashion shows and expansion of its business over the following years in several developed countries;
- iii. The Complainant's brand acquired fame over time, has been widely advertised and is endorsed by celebrities;
- iv. In 2012, the Complainant became part of the PPR Group ("Pinault-Printemps-Redoute", now trading as Kering) which is a leading global group in the apparel and accessories market, and owns brands like GUCCI, BOTTEGA VENETA, SAINT LAURENT, ALEXANDER MCQUEEN and BALENCIAGA.
- v. The BRIONI products are sold through 70 official stores in Europe, United States, Asia and the Middle-east (the full list is provided at <https://www.brioni.com/experience/us/store-locator/#continent/>), as well as via the online store at www.brioni.com.
- vi. The Complainant is present on popular social media like Twitter, Facebook and Instagram (Annex 8.6).
- vii. The Complainant has registered over 70 domain names worldwide consisting of or comprising "brioni" in order to protect its trademark BRIONI on the Internet (Annex 4.3). The Complainant operates its official website at www.brioni.com to which most of its domain names are redirected;
- viii. The word BRIONI has been recognized as a well-known trademark worldwide inter alia in prior UDRP cases, namely:
 - *Brioni S.p.A. v. Steve Timani, Tutti Creative Design*, [WIPO Case No. D2018-0154](#) involving disputed domain names <brionisuit.net> and <brionituxedo.com>



and

- *Brioni S.p.A. v. Jack Black, Jack Black*, [WIPO Case No. D2015-0983](#) involving disputed domain names <brionioutletstore.com> and <brionisalesoutlet.com>
- ix. The Respondent registered the Disputed Domain Name on 28 December 2012, well after Complainant's registration of the trademarks, and initially identified itself in the Whois records as "Zhaxia, Pfister Hotel" and later changed its name into "Doublefist Limited" (Annex 1).
- x. At the time of the making this complaint, the Disputed Domain Name was pointing to a web page displaying several sponsored links, including a link named "Brioni", which redirect users to third parties' commercial websites and also to the Complainant's official website. In addition, the link shows that the Disputed Domain Name is being offered for sale and on clicking the tab at the top of the home page of the website to which the Disputed Domain Name resolves, users are redirected to the web page <http://brioni.in/listing> where they are invited to submit an offer to purchase the Disputed Domain Name (Annex 5).
- xi. Attempts to reclaim the Disputed Domain Name were commenced by Complainant's representative in 2015, at which time the named Registrant was an *alias* of the current Registrant. This claim is based on the fact that though the Registrant's name and address differed at that time, the email address was identical to the one indicated in the current Whois records. The contact details listed in the WhoIs database, based on the search conducted on 14 July 2015, as filed at Annex 1, were:

Name: Zhaxia, Pfister Hotel
Address: Milwaukee, WI 53214, Milwaukee 53202, USA
Telephone: +414.2710840
Fax: +414.2710840
Email: ymgroup@msn.com

- xii. The Complainant instructed a software agency to contact the Respondent to acquire information of any possible legitimate interest of the registrant in the



Disputed Domain Name. On 15 July 2015, the software agency sent an email to ymgroup@msn.com to inquire if the Respondent, then going by the name Zhaxia, Pfister Hotel in the Whois records, would assign the domain name. The Respondent initially replied that it was not interested but subsequent to receiving an offer equivalent to the registration and maintenance fees from the Complainant's representative, it indicated in short "*Only 2690 USD*" (Annex 6.1).

xiii. The Complainant found the sum demanded for the Disputed Domain Name to be excessive and instructed its representatives to send a cease and desist letter to the Respondent. A letter was first addressed to the Respondent on 22 September 2015 via email to the address indicated in the WhoIs database (i.e. ymgroup@msn.com), asking that the Respondent cease any use of the disputed Domain Name and transfer it to Complainant free of charge (Annex 6.2 and Annex 6.3). The Respondent replied (see Annex 6.4) the following day with:

*"Dear Sirs,
Thanks, and \$1700 for this domain name. Regards,
Zhaxia"*

xiv. The Complainant through its representatives again made repeated offers to the Respondent reimbursement of the out of pocket costs for registration and maintenance of the Disputed Domain Name which were refused by the former indicating the offer was "too low" (Annex 6.5, Annex 6.6, Annex 6.7). The Complainant's representatives sent further reminders to the Respondent, on 30 August 2016 and 5 October 2016, however the Respondent reiterated its quote of 1700 USD for the transfer of the Disputed Domain Name to the legitimate trademark owner (Annex 6.8).

xv. On 16 December 2016, the Respondent contacted the Complainant's representatives via email asking for the payment of 1700 USD for transfer <brioni.in> to the legitimate trademark's owner (Annex 6.9). The Complainant's representatives replied on 19 December 2016, reiterating the requests set out in the cease and desist letter and the offer to reimburse the



Respondent's out of pocket costs. There was no reply from the Respondent after this.

xvi. In the meantime, Complainant's representatives ascertained that the contact details displayed in the WhoIs database for <brioni.in> were partially amended, possibly as a consequence of the foregoing communications, and the registrant name "Zhaxia, Pfister Hotel" was changed to "Doublefist Limited". However, the email address indicated in the WhoIs database remained identical i.e. ymgroup@msn.com. From this it was inferred that though the Respondent's names and address were changed, these are merely aliases used by the same individual or entity (Annex 1). The Complainant relies on decisions issued in prior INDRP proceedings in which the Panel therein confirmed that Respondent in this proceeding (Doublefist Limited) is known to associate different aliases to the email address ymgroup@msn.com, for instance [INDRP/936](#) concerning the domain name <goldmansachs.in> states this at paragraph 7.17.

xvii. On 16 February 2021, the Complainant's representatives sent a final reminder of the previous cease and desist letter to the Respondent, addressing it to the email address indicated in the WhoIs database i.e. ymgroup@msn.com (Annex 7.1). The Respondent replied asking for the amount of 1700 USD for the Disputed Domain Name, thereby confirming the Complainant's suspicion that Zhaxia, Pfister Hotel and Doublefist Limited are indeed aliases used by the same individual or entity (Annex 7.2).

xviii. Due to the Respondent's continued failure to comply with Complainant's requests for transfer of the Disputed Domain Name and its continued use of the Disputed Domain Name, which is identical to the Complainant's registered trademark, by redirecting it to a pay-per-click landing page and offering it for sale, the Complainant instructed its representatives to file the present Complaint under the INDRP.

5. Respondent's case:



The Respondent, though duly served on its email address ymgroup@msn.com as provided in the WhoIs database, has not filed a statement of defense or participated in any manner in these domain name dispute proceedings.

6. Legal grounds:

Under Paragraph 4 of the Policy, the Complainant must establish the following three elements to succeed:

- (a) the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name has been registered or is being used in bad faith.

7. Discussion and findings:

The Panel has gone through the complaint and annexures submitted by the Complainant. Since the Respondent has not submitted a statement of defense in these proceedings, the Panel must proceed on the basis of the Complainant's uncontroverted submissions in the complaint and an unbiased appreciation of the documents placed on record by the Complainant. The below discussion analyzes whether the Complainant has established the presence of the aforesaid three elements in this case so as to succeed in the Domain Name Dispute.

A. Whether the Disputed Domain Name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights

The Disputed Domain Name is <BRIONI.IN>. The Complainant has shown that it has rights in the trademark BRIONI by virtue of:



- i. registrations in India for the BRIONI trademark under Nos. 571718, 1544769, 2338882 and 3892895 (Annex 2.3, Annex 2.1, Annex 2.2 and Annex 2.4 respectively);
- ii. notably, the earliest of the Complainant's Indian registrations i.e. registration No. 571718 in class 25 is dated 23 April 1992;
- iii. registration of the domain name <brioni.com> on 2 March 1997 as per the WhoIs records (Annex 4.1);
- iv. the operation of a website at www.brioni.com which is accessible in India and confirms the online presence of the Complainant's products.

The Panel considers BRIONI to be an inherently distinctive trademark in the Indian context since it has no known meaning in English or Indian languages. Trademark jurisprudence is clear that inherently distinctive trademarks deserve a higher degree of protection as compared to suggestive, and even arbitrary, marks.

Even otherwise, the statutory protection granted to the Complainant's trademark BRIONI in India confirms that it has strong and enforceable rights in the said mark. The UDRP decisions in favour of the Complainant are also supportive of its claims of proprietorship and recognition of the mark at a broader level.

The trademark BRIONI is replicated in entirety in the Disputed Domain Name.

For the above reasons, the Panel finds that the Disputed Domain Name is identical to the trademark BRIONI in which the Complainant clearly has an exclusive right.

B. Whether the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name

The Panel accepts that Complainant's submission that the Respondent, Doublefist Limited, is an alias for the same entity i.e., "Zhaxia, Pfister Hotel", with which it had a previous history of prolonged communications. The documents at Annex 1 and Annex 6 (collectively) unequivocally bear out this conclusion. The communications also show that the Respondent was on strict notice of the Complainant's rights in the trademark BRIONI as far back as September 2015.



It is also seen from the history of past correspondence between the Complainant's representatives and the Respondent that the Respondent did not attempt to explain or justify its choice of the Disputed Domain Name or shy from the fact that this domain name was up for sale. In fact, the Respondent appears to have initially quoted a sum of USD 2690 to transfer the Disputed Domain name to the legitimate owner, which offer it later revised to USD 1700.

The conduct of the Respondent is self-speaking as to the absence of any legitimate interest in respect of the Disputed Domain Name. Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

C. Whether the Disputed Domain Name has been registered or is being used in bad faith

Section 3 of the INDRP clearly stipulates that by applying to register a domain name, or by asking a Registrar to maintain or renew a domain name registration, the Registrant thereby represents and warrants that:

- (a) the credentials furnished by the Registrant for registration of Domain Name are complete and accurate;
- (b) to the knowledge of registrant, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;
- (c) the Registrant is not registering the domain name for an unlawful and malafide purpose; and
- (d) the Registrant will not knowingly use the domain name in violation or abuse of any applicable laws or regulations."

The Respondent has an express duty of care which it did not exercise when it applied to register the Disputed Domain Name and, in the opinion of the Panel, the Respondent did not comply with any part of Section 3, beginning with its failure to furnish complete and accurate credentials for registration of the Disputed Domain Name. The Respondent also had actual knowledge from the Complainant's cease and desist letter of 22 September 2015 that the latter has statutory rights in the



mark BRIONI in several countries. The Panel notes that the Complainant did not specifically reference its statutory rights in the trademark BRIONI in India in the said cease and desist letter, however this does not take away from the fact that such rights existed, and the Respondent could have questioned the Complainant in this regard if it wanted to. Instead, the Respondent brazenly asked for a disproportionate sum of money to transfer the Disputed Domain Name to the legitimate owner with an undisguised motive of profiteering.

In this background, the Panel cannot find any redeeming factor in the Respondent's favour and the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.

Decision:

In the facts and circumstances, and for the reasons discussed above, the Panel finds that the Complainant has satisfied all three elements required under Paragraph 4 of the Policy to obtain the remedy of transfer of the Disputed Domain Name. Therefore, the Arbitrator directs that the Disputed Domain Name <BRIONI.IN> be transferred to the Complainant.

No order is made as to costs.

Signed:



(Binny Kalra)

Arbitrator

Date: 7 June 2021