

ADMINISTRATIVE PANEL DECISION

Kelin S.r.l. v. Privacy Service provided by Withheld for Privacy ehf / Vincent Cammarata

Case No. D2022-0746

1. The Parties

The Complainant is Kelin S.r.l., Italy, represented by Barzanò & Zanardo Milano SpA, Italy.

The Respondent is Privacy Service provided by Withheld for Privacy ehf, Iceland / Vincent Cammarata, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <givi.space> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 3, 2022. On March 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 4, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on March 8, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2022. The Respondent did not submit a formal response. The Center received a short email from the Respondent on March 10, 2022. On March 30, 2022, the Center informed the Parties that it would proceed to panel appointment

The Center appointed John Swinson as the sole panelist in this matter on April 12, 2022. 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.

4. Factual Background

The Complainant is a corporation based in Italy that designs and sells motorcycle helmets and other motorcycle equipment such as bags.

One of the Complainant's products in 2014 was a motorcycle helmet called the GIVI 11.2 Space Jet Helmet.

The Complainant owns registered trademarks for GIVI, including International Registration No 837911, registered on June 3, 2004, for products in classes 09, 12, 18, 25 and 35, valid also for the United States.

The Respondent did not file a formal Response. The Respondent appears to be a computer programmer and artist from Missouri, United States, who operates websites at <vinrata.com> and <viniverse.io>. The later website is about an ancient alien species from outer space called "Vinnies" that appear to be represented as NFTs.¹

The disputed domain name was registered on January 22, 2022.

The disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The Complainant owns numerous trademark registrations for GIVI including in China and the United States.

The disputed domain name is identical to the Complainant's GIVI trademark.

The Respondent is not an authorized dealer, agent, distributor, wholesaler or retailer of the Complainant. The Complainant has never authorized any third party to include its trademarks in a domain name, nor to make any other use of its trademarks in any manner whatsoever.

The Complainant is not in possession of, nor aware of the existence of, any evidence tending to demonstrate that the Respondent is commonly known by the disputed domain name, as individual, business, or other organization. The Respondent does not own any trademark registrations for GIVI.

The fact that GIVI is a fanciful word strengthens the assumption that the disputed domain name was registered for the sole scope of misleading potential consumers, to tarnish the Complainant's trademark and to prevent the Complainant from reflecting its trademark in a corresponding domain name. This is even true considering that the disputed domain name is identical to GIVI; its use in association with the extension .space certainly strengthen the possible confusion for Internet users that could be misled about the control of the disputed domain name, as it could be considered an official website or online presence of the Complainant and one of its most known products. The GIVI SPACE is one of the line of GIVI helmet products.

¹ According to the Panel's independent research

Considering that the disputed domain name entirely reproduces the Complainant's trademark, it is very difficult to conceive any possible right or legitimate interest which the Respondent could have in the disputed domain name.

As far as registration in bad faith is concerned, the Respondent could not ignore the existence of the GIVI trademark at the time of the registration of the disputed domain name. The disputed domain name has been registered long after the registration of the Complainant's trademarks and the registration of the domain name <givi.com>.

This assumption is further proved by the fact that the disputed domain name entirely contains the Complainant's trademark.

Moreover, the GIVI trademark is – in light of its extensive use and international distribution - a well-known trademark and therefore the Respondent registered a domain name containing a well-known third party's trademark without authorization. The misappropriation of a well-known trademark as domain name by itself constitutes bad faith registration for the purposes of the Policy.

With respect to the use in bad faith, the disputed domain name is not currently redirected to an active website. However, "passive holding" or non-use of a domain name could support a finding of bad faith.

B. Respondent

The Respondent did not submit a formal reply to the Complainant's contentions.

On March 10, 2020, the Respondent sent an email to the Center that stated:

"Hi, I just read this email. I buy givi.space from namecheap. Do you own a "givi space" ? I can delete it if you need me to. I haven't done anything with the domain it is just sitting.
Best,
Vincent"

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent 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.

The *onus* of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns trademark registrations for GIVI.

The disputed domain name is identical to the GIVI trademark.

It is well established that the generic Top-Level Domain (“gTLD”), in this case “.space”, does not affect the disputed domain name for the purpose of determining whether it is identical or confusingly similar to the Complainant’s Trademark. *Lidl Stiftung & Co. KG v. Ravshan Nabiev*, WIPO Case No. [D2020-3108](#).

The Complainant succeeds on the first element of the Policy in relation to the disputed domain name.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] 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 [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The *onus* of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant asserts that the Respondent is not an authorized dealer, agent, distributor, wholesaler or retailer of the Complainant, and that the Complainant has never authorized any third party to include its trademarks in a domain name, nor to make any other use of its trademarks in any manner whatsoever. The Complainant also asserts that the Complainant is not in possession of, nor aware of the existence of, any evidence tending to demonstrate that the Respondent is commonly known by the disputed domain name, as individual, business, or other organization. The Complainant states that the Respondent does not own a trademark registration for GIVI.

The Panel considers that, based upon the above, the Complainant has established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain name and thereby the burden shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the disputed domain name.

The Respondent has chosen not to file a formal Response. The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the disputed domain name.

Based on the evidence before the Panel, none of the circumstances listed in paragraph 4(c) apply in the present circumstances. Accordingly, the Panel finds that the Respondent has no rights or any legitimate interests in the disputed domain name.

The Complainant succeeds on the second element of the Policy in relation to the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by the complainant. *Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*, WIPO Case No. [D2014-1747](#) (the “*Fifth Street Capital LLC*” case).

The Complainant asserts that it would have been inconceivable that the Respondent was not aware of the Complainant’s GIVI trademark when he registered the disputed domain name. According to the Complainant, this is because the disputed domain name was registered long after the Complainant’s trademarks were registered, the Complainant has a United States website at <giviusa.com>, the Complainant is well known, the disputed domain name is identical to the Complainant’s GIVI trademark and GIVI is a fanciful term. The Complainant also states: “GIVI is a trademark registered to the Trademark Clearing House, therefore - considering that .space is a new generic Top Level Domain – respondent has been notified of the existence of the trademark GIVI at the moment of the registration.”

The Complainant provided little detail or evidence to support its claim that the Complainant and the GIVI trademark are well known. The Complainant provided screenshots of its Facebook, Instagram, and Youtube account pages, that show approximately half a million Facebook followers and 100,000 Youtube followers. The Complainant also provided a list of the Complainant’s Chinese distributors. The Respondent lives in Missouri, United States. There is no information that sets out the number of United States customers, sales in the United States, number of visitors to the Complainant’s United States website, advertising in the United States or social media followers from the United States. Based on the evidence before the Panel, the Panel cannot conclude that it is more probable than not that the Respondent was aware of the Complainant when selecting the disputed domain name. The Complainant appears to have a reputation in relation to motorcycle accessories, but there is no evidence that the Respondent has any interest in or knowledge about motorcycles. In short, there is no evidence that the Respondent selected the disputed domain name because of the Complainant or the Complainant’s GIVI trademark.

An asserting party needs to establish that it is more likely than not that the claimed fact is true. An asserting party cannot meet its burden by simply making conclusory statements unsupported by evidence. To allow a party to merely make factual claims without any supporting evidence would essentially eviscerate the requirements of the Policy as both complainants or respondents could simply claim anything without any proof. For this reason, UDRP panels have generally dismissed factual allegations that are not supported by any *bona fide* documentary or other credible evidence. *Snowflake, Inc. v. Ezra Silverman*, WIPO Case No. [DIO2020-0007](#).

The Complainant states that the GIVI trademark was registered with the Trademark Clearinghouse, and thus, the Respondent would have been put on notice of the Complainant’s trademark rights at the time of registration. The Complainant has provided insufficient evidence to support this argument. In the *Fifth Street Capital LLC* case, the learned panelist was presented with a similar argument, and stated:

“The Complainant says the Respondent must have known about its trademark rights because they were registered with the Trademark Clearinghouse. The Complainant does not state when the trademarks were so

registered. However, the Respondent points out that the sunrise period for the “.finance” gTLD expired on August 30, 2014 and he did not register the disputed domain name until September 10, 2014, after that expiry. So it does not follow that he would have been notified of the Complainant’s trademarks.”

The same logic applies in the present case.

Even if the Respondent had been made aware of the Complainant’s trademark at the moment of registration, that is, after the Respondent had decided to register the disputed domain name, this is insufficient to demonstrate that the Respondent registered the disputed domain name in bad faith or to trade off the reputation of the Complainant. The Complainant’s trademark rights are in relation to particular goods and services, and the Respondent could use GIVI in respect of other goods and services, or use GIVI not as a trademark (e.g., in relation to one of the Respondent’s alien characters or planets).

As an aside, there are other businesses who use GIVI as a trademark, such Standard & Poors who own a trademark registration for GIVI in some countries and operates the GIVI (Global Intrinsic Value Index), a company called GIVI MISURE S.r.l. (from Milan), a pub in Texas called “Givi’s Pub”, and the GIVI app for charitable donations (see <getgivi.com>). These examples show that GIVI is not unique to the Complainant and that others can legitimately use GIVI in good faith. The Panel regards the Complainant’s statement that it “is also not conceivable a use of the [disputed] domain name not related to the Complainant’s activities” to be an overstatement.

In *Givi Srl and G. Visenzi Motomarket Srl v. Anup Shahi*, WIPO Case No. [D2005-0392](#), which involves the Complainant’s group of companies, the panel did not find bad faith use by the respondent in that case in respect of <givi.com> because that respondent was unaware of the Complainants’ existence or products and did not know of the Complainants’ trademark. Admittedly, that case was 16 years ago, and the facts were different to the present case. However, in light of this decision, one would expect that the Complainant in the present case provide evidence of its reputation in the United States to demonstrate that the Respondent was likely to have known of the Complainant at the time of registration of the disputed domain name. The Complainant chose not to do so.

(It is also troubling that the Complainant did not make the Panel aware of this decision, even though the Complainant referred to the <givi.com> domain name in the Complaint.)

The Complainant asserts that “the GIVI SPACE is one of the line of GIVI helmet products”, inferring that it is not a coincidence that the Respondent registered the disputed domain name. However, the only evidence provided regarded the GIVI SPACE helmets is a 2014 catalogue and a link to a Google search that returns little relevant information. The Panel has reviewed the Complainant’s current international and United States websites and current catalogs, and the “Space” product does not appear to be currently available. It is entirely possible that in 2022 the Respondent registered the disputed domain name without knowledge of the GIVI SPACE helmets from 2014.

The Respondent is a young artist, who goes by the name Vinny, and draws space aliens from the “Vini” race. Maybe the Respondent registered the disputed domain name for his Vini space aliens project? That is equally a likely conclusion based on the materials before the Panel.

The Respondent has not used the disputed domain name in the 3-month period since he registered it, has not used it in relation to motorcycle products or accessories, has not contacted the Complainant about the disputed domain name, and has not offered to sell the disputed domain name. The Respondent is not a competitor of the Complainant. There is no evidence that the Respondent has registered other domain names that are trademarks.

On balance, there is insufficient evidence before the Panel to demonstrate that the Complainant registered the disputed domain name in bad faith.

In relation to bad faith use, the Complainant relies on the doctrine of passive holding to demonstrate bad faith use, in accordance with the principles set out in well-known cases cited by the Complainant, namely *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), *Jupiter Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#); and *Virgin Enterprises Limited v. Ceasr Alvarez*, WIPO Case No. [D2016-2140](#). In the *Nuclear Marshmallows* case, the Complainant's trademark was one of the most famous in Australia, the complainant provided substantial evidence of its reputation in Australia, the respondent had an Australian address and was likely aware of the complainant, and the respondent used a fake name (Nuclear Marshmallows) to conceal his or her identity. In *Jupiter Limited*, the respondent lived near the complainant's Gold Coast casino that is well known on the Gold Coast, and offered to sell the disputed domain names to the complainant. In *Virgin Enterprises Limited*, the respondent offered to sell the disputed domain name to the complainant, and the complainant's trademark was internationally famous. The Complainant in the present case has not provided sufficient evidence to establish that there is passive holding under the test set out in the *Nuclear Marshmallows* case and thus does not demonstrate bad faith use.

At the present time, in light of privacy laws, use of a privacy service is not strong evidence of bad faith.

The Complainant is unsuccessful in respect of the third element of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/John Swinson/

John Swinson

Sole Panelist

Date: April 16, 2022