

ADMINISTRATIVE PANEL DECISION

Azimut-Benetti S.p.A. v. Grace Huo, Benetti Sail Division Shanghai Shipyard
Corporatio

Case No. D2023-2143

1. The Parties

Complainant is Azimut-Benetti S.p.A., Italy, represented by IP Skill, Italy.

Respondent is Grace Huo, Benetti Sail Division Shanghai Shipyard Corporatio, China.

2. The Domain Name and Registrar

The disputed domain name <benettisaildivision-ss.com> is registered with Register SPA (the “Registrar”).

3. Procedural History

The Complaint was filed in Italian with the WIPO Arbitration and Mediation Center (the “Center”) on May 15, 2023. On May 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 18, 2023, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to Complainant on June 19, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on June 20, 2023.

On June 19, 2023, the Center informed the parties in English and Italian, that the language of the registration agreement for the disputed domain name is English. On June 20, 2023, Complainant submitted the amended Complaint translated into English. Respondent did not submit any comment on Complainant’s submission.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on June 21, 2023. In accordance with the Rules, paragraph 5, the due

date for Response was July 11, 2023. Respondent did not submit any formal Response. Accordingly, the Center notified Respondent's default on July 19, 2023. Complainant sent an informal communication to the Center on the same date.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on July 21, 2023. 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

Complainant is a company organized under the laws of Italy that is active in the motor yachts industry.

Complainant has provided evidence that it is the registered owner of several trademarks relating to its company name and brand BENETTI, including, but not limited to the following:

- word mark BENETTI, World Intellectual Property Organization (WIPO), registration number: 600959, registration date: June 2, 1993, status: active;
- word mark BENETTI, United States Patent and Trademark Office (USPTO), registration number: 2898880, registration date: November 2, 2004, status: active.

Respondent, according to the disclosed Whois information for the disputed domain name, is residing in China. The disputed domain name was created on April 10, 2015. Complainant has demonstrated that, at some point before the filing of the Complaint, the disputed domain name resolved to a website headed "BENETTI Sail Division Shanghai Shipyard" which promoted the construction and sale of motor yachts under the control of a Mr. Riccardo Benetti and a Mr. Bruce Lee.

In this context, Complainant has submitted a Settlement Agreement entered into on July 25, 2018, with, Portanuova Servizi S.r.l. ("Portanuova"), and Mr. Riccardo Benetti (Sole Director of Portanuova), in which Portanuova and Mr. Riccardo Benetti (directly or indirectly, in its own name or through subsidiary companies or third parties) undertook to refrain from registering domain names and trademarks containing the Complainant's BENETTI trademarks in the nautical field and from using any trademark or sign identical or similar to the BENETTI trademark for products and/or services related to the marine sector.

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that it is one of the world's leading manufacturers of luxury motor yachts and that its BENETTI trademark has been used in the nautical field since 1873 by Complainant's predecessor Cantieri Benetti and was acquired by Complainant in 1985.

Complainant submits that the disputed domain name is confusingly similar to Complainant's BENETTI trademark as it incorporates the latter identically, only associated with the non-distinctive English words "sail" as well as "division" and with the suffix "-ss", probably referring to the expression "Shanghai Shipyards" contained on the website under the disputed domain name. Also, Complainant claims that the website at the

disputed domain name identified Mr. Riccardo Benetti as one of the promoters of the commercial initiative conducted under the trademark “BENETTI SAIL DIVISION SHANGHAI SHIPYARDS”.

Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) the disputed domain name was registered after the registration and use of Complainant’s BENETTI trademark in the nautical field, and (2) the website under the disputed domain name contains a clear commercial offer in the nautical field marked by the expression “Benetti Sail Division Shanghai Shipyards”.

Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) the disputed domain name was registered after the registration and use of Complainant’s BENETTI trademark in the nautical field, (2) the website under the disputed domain name contains a clear commercial offer in the nautical field marked by the expression “Benetti Sail Division Shanghai Shipyards”, and (3) given the settlement agreement between Complainant and, *inter alia*, Mr. Riccardo Benetti, using the disputed domain name in the nautical field is a clear demonstration of bad faith.

B. Respondent

Respondent did not file a formal Response, however, contacted Mr. Riccardo Benetti on July 11, 2023, who in turn went back to the Center on July 19, 2023, to notify Respondent’s willingness to close the website under the disputed domain name.

Mr. Riccardo Benetti’s communication states the following:

“the Chinese company has not answered to your notification about the benettisaildivision-ss.com web site since we have convinced them to give up with this web site and close it. Because of that they have authorized my company to close the above mentioned web site (see attached letter). As soon as technically possible the mentioned web site will be definitely closed.”

The email communication included a letter from Respondent authorizing Mr. Riccardo Benetti “to answer to WIPO that we are ready to close the benettisaildivision-ss.com web site”.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant’s BENETTI trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

Based on the available record, the Panel finds Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

The Panel finds the entirety of the BENETTI trademark is reproduced within the disputed domain name,

merely added by the English words “sail” as well as “division” and the suffix “-ss”. Accordingly, the disputed domain name is confusingly similar to the BENETTI trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms (here, the English words “sail” as well as “division” and the suffix “-ss”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the BENETTI trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests, Registered and Used in Bad Faith and the Scope of the UDRP

Under paragraph 4(a)(ii) of the Policy, Complainant has the burden of establishing that Respondent has no rights or legitimate interests in respect of the disputed domain name, while paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate such rights or legitimate interests. Moreover, according to paragraph 4(a)(iii) of the Policy, Complainant needs to demonstrate that Respondent has registered and, as a conjunctive requirement, is using the disputed domain name in bad faith, with paragraph 4(b) of the Policy establishing circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith.

The Panel has well recognized that this case brought before it involves, *inter alia*, a quite complex relationship between Complainant on the one hand, and Mr. Riccardo Benetti on the other hand, who, in turn, is/was the Sole Director of Portanuova and also is/was economically engaged in Respondent to an extent that remains somewhat unclear, both from the case file and even after independent research undertaken by the Panel within its general powers set forth by paragraph 10 of the Rules. It is, however, undisputed between the Parties that the disputed domain name was registered as early as April 10, 2015, and that it expressly formed part of the Settlement Agreement of July 25, 2018, between Complainant and Portanuova as well as Mr. Riccardo Benetti, by which the parties to this agreement intended to settle a trademark dispute involving the name/word “Benetti” and in which they also aimed at including Respondent and the making use of the disputed domain name to operate the website “www.benettisaildivision-ss.com” thereunder. Also, the Panel has well noticed that Respondent, upon notification of the Complaint, immediately signaled through Mr. Riccardo Benetti its willingness to close down the website under the disputed domain, but did not comment whatsoever *e.g.* on its willingness to transfer the disputed domain name to Complainant and, if so, on which grounds.

In view of the above circumstances, the Panel considers that the disputed domain name is part of a wider and more complex dispute that is, *inter alia*, of a business nature with a considerable contractual component, and not a typical straight forward domain name dispute. Against this background, the Panel recalls that the Policy is not designed to adjudicate all types of disputes that relate in any way to domain names, but rather the Policy establishes a streamlined, inexpensive administrative dispute resolution procedure intended only for cases of “abusive cybersquatting” (see *e.g.*: *Boku, Inc. v. Phuc To*, WIPO Case No. [D2023-1338](#)). As such, the UDRP is not an appropriate process to adjudicate a complex business dispute given that panels do not have the powers granted to a competent court to first enlighten and finally resolve disputes, including *e.g.* witness testimony, disclosure of documents, or other procedural instruments (see: *Symphony Holdings Limited v. Jaimie Fuller, Fuller Consultancy F.Z.E.*, WIPO Case No. [D2019-2887](#), *Paradise International General Trading LLC v. Suwanna Mayeux*, WIPO Case No. [D2023-1569](#)).

Consequently, the Panel considers this is a more complex dispute that exceeds the typical “cybersquatting” scope of the UDRP and would be more appropriately addressed by a court of competent jurisdiction, or perhaps in mediation (see [WIPO Overview 3.0](#), section 4.14.6). Therefore, this Complaint may not be successful, however, not necessarily on the merits, but for procedural reasons only, and this Decision does not prevent either Complainant or Respondent from pursuing this dispute, including as regards a possible trademark infringement, in a court of competent jurisdiction.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: August 8, 2023