

ADMINISTRATIVE PANEL DECISION

Valentino S.p.A. v. Client Care, Web Commerce Communications Limited
Case No. D2023-1138

1. The Parties

The Complainant is Valentino S.p.A., Italy, represented by Studio Barbero S.p.A, Italy.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <borsevalentinooutlet.com>, <valentinoitaliaoutlet.com>, and <valentinosingapore.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2023. On March 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 16, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent [as to which, see below] and contact information in the Complaint. The Center sent an email communication to the Complainant on March 17, 2023, 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 20, 2023.

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 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 28, 2023.

The Center appointed Delia-Mihaela Belciu as the sole panelist in this matter on May 3, 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

The Complainant, Valentino S.p.A., is a company incorporated in Italy. Founded in 1960, the Complainant is a world leading company on the fashion scene and offers a wide range of luxury products from Haute Couture and Prêt-à-Porter to an extensive accessories collection that includes bags, shoes, small leather goods, belts, eyewear, silks, and perfumes. The brand Valentino is available in over 90 countries in 160 Valentino directly-operated stores as well as in over 1,300 points of sale.

The Valentino's advertising campaigns have been published in important international fashion magazines with broad circulation such as, Vogue and Harpers Bazaar, and in the Chinese magazine Shangliu Tatler (Annex 5.5 to the Complaint). In addition, fashion magazines frequently publish articles about the Valentino's fashion shows and new collections (Annex 5.6 to the Complaint).

The Complainant is the owner of numerous trademark registrations for VALENTINO, including the following:

- International Trademark Registration for VALENTINO No. 570593, registered on April 24, 1991, for goods in classes 3, 14, 18, and 25;

- International Trademark Registration for VALENTINO No. 764790, registered on November 20, 2000, for goods and services in classes 3, 9, 14, 16, 18, 19, 20, 21, 24, 25, 27, 34, and 35;

- European Union Trademark Registration for VALENTINO No. 001990407, registered on September 18, 2008, for goods and services in classes 3, 9, 14, 16, 18, 19, 20, 21, 24, 25, 27, 34, and 35;

- United States of America Trademark Registration for VALENTINO No. 0910955, registered on April 6, 1971, for goods in class 25;

- International Trademark Registration for VALENTINO GARAVANI No. 969844, registered on July 2, 2008, for goods and services in classes 8, 11, 19, 20, 21, 27, 36, 42, and 43;

- International Trademark Registration for  VALENTINO GARAVANI No. 975800, registered on July 22, 2008, for goods in classes 18 and 25;

- International Trademark Registration for  No. 1522424, registered on December 19, 2019, for goods and services in classes 3, 9, 14, 18, 25, and 35;

- International Trademark Registration for VLTN No. 1392762, registered on July 24, 2017, for goods and services in classes 18, 25, 28, and 35;

- Malaysian Trademark Registration for VALENTINO No. M/075735, registered on July 25, 1977, for goods in class 25; and

- Malaysian Trademark Registration for V VALENTINO (figurative) No. 89006610, registered on October 25, 1989, for goods in class 25.

The Complainant is the owner of over 1,000 domain names identical to or comprising the trademark VALENTINO (Annex 7 to the Complaint). Among those domain names, is the domain name <valentino.com>, which the Complainant uses to resolve to its official website since 1998, and at which the Complainant's branded goods are advertised and offered for sale (Annexes 8 and 9 to the Complaint).

The disputed domain name <borsevalentinooutlet.com> was registered on August 11, 2022, while the other two disputed domain names <valentinoitaliaoutlet.com> and <valentinosingapore.com> were registered on August 5, 2022.

The Complainant sent to the Respondent a cease-and-desist letter via the Registrar regarding the disputed domain names <borsevalentinooutlet.com> and <valentinoitaliaoutlet.com>, requesting immediately cease any use of these two disputed domain names and transfer them to the Complainant (Annex 13 to the Complaint), without receiving any response.

The Complainant has sent a cease-and-desist letter also to the hosting provider of the websites published at disputed domain names <borsevalentinooutlet.com> and <valentinoitaliaoutlet.com>, requesting the deactivation of the websites (Annex 14 to the Complaint), without receiving any response.

The Complainant has sent a further communication to the Respondent - addressing the communication to the abuse email address of the Registrar, disputing also the additional disputed domain name <valentinosingapore.com> and reiterating its arguments and requests (Annex 15 to the Complaint). No response was received.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to its VALENTINO trademarks.

To this end, such underlines that the disputed domain names incorporate the Complainant's VALENTINO trademark in whole and that the addition of the elements "outlet", "borse", "italia", and "singapore" does not affect the confusing similarity.

The Complainant further alleges that, whilst the addition to the VALENTINO trademark of a geographical term and/or of a descriptive term related to online sale and/or to the Complainant's core businesses (*i.e.*, manufacturing and sale of handbags) is, *per se*, not a distinguishing feature, it may to the contrary be apt to increase confusion since users could believe that the disputed domain names are used by the Complainant or, at least, by a Complainant's affiliated entity, in connection with its official VALENTINO web portals.

In respect of the addition of the generic Top-Level Domain ("gTLD") suffix ".com", the Complainant underlies that such is merely instrumental to the use of Internet and shall thus be disregarded in the assessment of confusing similarity.

For these reasons, the Complainant concludes that the disputed domain names are confusingly similar to the Complainant's prior registered trademark VALENTINO.

The Complainant further contends that the Respondent does not have any rights or legitimate interests in the disputed domain names for a number of reasons.

First, the Complainant asserts that the Respondent is not an employee, licensee, affiliated entity, authorized agent, nor an authorized reseller of the Complainant nor that such was authorized in any way to use the Complainant's VALENTINO trademark or to register and use the disputed domain names.

Second, the Complainant contends that, the Respondent cannot reasonably claim to be commonly known by the disputed domain names.

Thirdly, the Complainant alleges that the Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services before any notice of the dispute and that there is no evidence that the Respondent might have used the disputed domain names in connection with a legitimate noncommercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Fourthly, the Complainant underlines that the disputed domain names have been redirected by the Respondent to websites featuring the Complainant's trademarks and official advertising images (Annex 9.2 to the Complaint), and promoting the sale of purported VALENTINO products at discounted prices, without providing any disclaimer as to the Respondent's lack of relationship with the Complainant.

In the Complainant's view, the Respondent's use of the disputed domain names is, therefore, certainly apt to confuse and mislead Internet users into believing that the websites are operated by the Complainant or by an affiliated entity with the Complainant's consent.

The Complainant further contends that, by offering for sale *prima facie* counterfeit VALENTINO products on the websites corresponding to the disputed domain names, the Respondent has engaged in an illegitimate activity that is undoubtedly commercial and not *bona fide* in nature.

In the Complainant's view, indication of the counterfeit nature of the products offered for sale under the Complainant's trademarks can be found in the circumstance that the products are offered for sale at substantially lower prices than the prices of original VALENTINO products.

The Complainant further alleges that, irrespective of the nature of the products offered for sale on the Respondent's websites, no fair use could be possibly invoked in this case by the Respondent, since it has undoubtedly failed to accurately and prominently disclose its (lack of) relationship with the trademark holder, thus generating a clear likelihood of confusion amongst Internet users.

The Complainant mentions further the cumulative requirements from the *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#):

- “(i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to 'corner the market' in domain names that reflect the trademark.”

In the Complainant's view, at least the third condition is not met since the Respondent has failed to provide accurate and prominent disclaimers as to the lack of affiliation with the Complainant.

Furthermore, in the Complainant's view, the Respondent's use of the disputed domain names cannot be considered a legitimate noncommercial or fair use without intent for commercial gain because the Respondent has undoubtedly attempted to gain from the sales of purported VALENTINO products featured on its websites and it is clear in the Complainant's view that the Respondent's intention was and still is to illegitimately trade on the Complainant's fame for commercial gain.

For these reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant further contends that the disputed domain names were registered and are being used in bad faith.

To this end, the Complainant argues that, in light of the extensive use of the trademark VALENTINO since as early as 1960s, and the amount of advertising and sales of the Complainant's products worldwide, the

Respondent could not have possibly ignored the existence of the Complainant's trademark when it registered the disputed domain names, confusingly similar to the trademark VALENTINO.

Further, the Complainant asserts that, the well known character of the trademark VALENTINO has been recognized also by prior UDRP decisions.

Moreover, the Complainant asserts that such is using its trademark VALENTINO in connection with the advertising and sale of its fashion products also in Malaysia and a Valentino boutique is also present in Kuala Lumpur, Malaysia.

Therefore, in the Complainant's view, it is inconceivable that the Respondent was not well aware of the Complainant's trademark rights at the time of the registration of the disputed domain names.

In the Complainant's view, the fact that purported VALENTINO products were offered for sale and the Complainant's trademarks have been published on the websites to which the disputed domain names resolve, indicates that the Respondent was fully aware of the Complainant and its trademarks.

Further, the Complainant contends that, the use of the disputed domain names in connection with the commercial websites, displaying the Complainant's trademarks and official advertising images and offering for sale *prima facie* counterfeit VALENTINO branded products, clearly indicates that the Respondent's purpose in registering the disputed domain names was to capitalize on the reputation of the Complainant's trademark, by attracting Internet users seeking the Complainant's branded products to its own websites for commercial gain and intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its websites, and the goods offered and promoted through said websites.

The Complainant alleges that irrespective of whether the goods offered on the Respondent's website are in fact counterfeit, the reproduction of the Complainant's trademarks on the Respondent's websites corresponding to the disputed domain names without also displaying a clear disclaimer of a lack of relationship between the Respondent and the Complainant, is indication of bad faith.

Moreover, in the Complainant's view, the Respondent registered the disputed domain names in order to prevent the Complainant from reflecting its trademarks in corresponding domain names and has clearly engaged in a pattern of such conduct.

The Complainant contends that the fact the Respondent did not reply to the Complainant's cease-and-desist letters and subsequent communication sent to its attention, is a further circumstance evidencing the Respondent's bad faith as well as the fact that the Respondent has provided incomplete and inaccurate contact details in the public Whois records, as at least the street is not specified but just the suburb of Kuala Lumpur "Bukit Jalil" is indicated. In the Complainant's view, this supports the conclusion that the Respondent was indeed well aware that it was engaging in an unlawful conduct by registering and using the disputed domain names and indicated inaccurate and incomplete contact details to avoid being reached and prosecuted for its activities by the Complainant.

The Complainant also asserts that, as a further circumstance supporting the application of paragraph 4(b)(ii) in this case, the Respondent "Client Care, Web Commerce Communications Limited" was involved in several prior UDRP proceedings concerning domain names corresponding to third party trademarks, including the most recent *Puma SE v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-0285](#); *Reebok International Limited v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-0277](#); and *Prada S.A. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4776](#), all concluded with the transfer of the domain names to the complainants.

For all these reasons, the Complainant concludes that, the disputed domain names were registered and are being used in bad faith.

B. Respondent

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

6. Discussion and Findings

The Panel notes that the Complaint stated that the Registrar did not disclose any details for the Respondent, not even a field in its WHOIS database; the only fields the Registrar provided were: Registrant City, Registrant State/Province, Registrant Country, Registrant Email, and Registry Registrant ID [being "Not Available From Registry"].

6.1. Substantive Issues

In order for the Complainant to succeed, such must prove, according to paragraph 4(a) of the Policy, that:

- (i) the disputed domain names are 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 with respect to the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

In case all three elements above have been fulfilled, the Panel is able to grant the remedy requested by the Complainant. Thus, the Panel will deal with each of the requirements in turn.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, the Complainant has to show that the disputed domain names are (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

With respect to the requirement of having rights pursuant to paragraph 4(a)(i) of the Policy, the Complainant owns several VALENTINO registered trademarks, in several jurisdictions. Consequently, the Panel finds that this requirement is fulfilled.

With regard to the assessment of identity or confusing similarity of the disputed domain names with the VALENTINO trademarks, it is generally accepted that this involves a side-by-side comparison of the domain names and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain names. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the disputed domain names are confusingly similar to the VALENTINO trademarks as all three incorporate the VALENTINO mark in its entirety, and the addition of terms "outlet", "borse" ("handbags" translated in English from Italian), "italia", and "singapore" does not prevent a finding of confusing similarity. The VALENTINO mark remains clearly recognizable within the disputed domain names.

Previous UDRP panels have held that such additions do not prevent a finding of confusing similarity (see *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); and *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#)).

In what concerns the addition of the gTLD ".com", this is not to be taken into consideration when examining the confusing similarity between the Complainant's trademarks and the disputed domain names, as such is viewed as a standard registration requirement and such is disregarded under the first element confusing similarity test (see section 1.11.1 of the [WIPO Overview 3.0](#)).

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. Once such *prima facie* case is made out, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain names. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see section 2.1 of the [WIPO Overview 3.0](#)).

In this case, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, which has not been rebutted by the Respondent, as the Respondent has not submitted any response.

Thus, based on the available evidence, the Respondent does not appear to be commonly known by the disputed domain names. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its VALENTINO trademarks in the disputed domain names.

Moreover, based on the evidence filed by the Complainant, the disputed domain names have been redirected by the Respondent to websites featuring the Complainant's trademarks and advertising images from the official website of the Complainant and promoting the sale of purported VALENTINO products at discounted prices, without providing any disclaimer as to the Respondent's lack of relationship with the Complainant, leading thus to confusion and misleading Internet users into believing that the websites are operated by the Complainant or by an affiliated entity with the Complainant's consent.

The above does not amount to a *bona fide* offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain names.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, a complainant must show that the domain names have been registered and are being used in bad faith.

In this case, the Complainant's rights to the VALENTINO trademark predate the registration date of all three disputed domain names.

The VALENTINO trademark enjoys of a well known character, recognized by earlier UDRP panels as well (see *Valentino S.p.A. v. hong chen, chen hong*, WIPO Case No. [D2014-2129](#); *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#); *Valentino S.p.A. v. Wu Dong*, WIPO Case No. [D2018-0641](#); and *Valentino S.p.A. v. Lijin Liu*, WIPO Case No. [D2020-0011](#)).

Based on the available evidence in the file, the Complainant is using its trademark VALENTINO in connection with advertising and sale of its fashion products in Malaysia and also has a Valentino boutique in Kuala Lumpur, the capital of Malaysia.

In light of the well known character of the VALENTINO trademarks and also the presence of the Complainant with its products in Malaysia, the country from where the Respondent appears to be located, considering the verification response received from the Registrar, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the disputed domain names without knowledge of the Complainant's VALENTINO mark, which support a finding of bad faith registration.

The Respondent's incorporation into the disputed domain names of the Complainant's VALENTINO mark in its entirety, followed by the addition of terms "outlet" (corresponding to online sale of products at discounted prices), "borse" ("handbags" translated in English from Italian, which is one of the products related to the Complainant's core business), "italia" ("italy" translated in English from Italian), and "singapore", the use of the disputed domain names in connection with commercial websites, displaying the Complainant's trademarks and advertising images from the official website of the Complainant lead to a finding that such was made intentionally in order to capitalize on the reputation of the Complainant's trademark, by attracting Internet users seeking the Complainant's branded products to its own websites for commercial gain and intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its websites and the goods offered and promoted through said websites, which support a finding of bad faith registration and use according to paragraph 4(b)(iv) of the Policy.

Further, based on the available evidence in the file, the Respondent was involved in several prior UDRP proceedings concerning domain names corresponding to third party trademarks, including *Puma SE v. Client Care, Web Commerce Communications Limited, supra*; *Reebok International Limited v. Client Care, Web Commerce Communications Limited, supra*; and *Prada S.A. v. Client Care, Web Commerce Communications Limited, supra*, all concluded with the transfer of the domain names to the complainants, which support a finding of a pattern of bad faith conduct of preventing a trademark holder from reflecting its mark in a domain name according to paragraph 4(b)(ii) of the Policy (see also section 3.1.2 of the [WIPO Overview 3.0](#)).

For all these reasons, the Panel finds that the disputed domain names have been registered and are being used in bad faith and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names, <borsevalentinooutlet.com>, <valentinoitaliaoutlet.com>, and <valentinosingapore.com>, be transferred to the Complainant.

/Delia-Mihaela Belciu/

Delia-Mihaela Belciu

Sole Panelist

Date: May 17, 2023