

ADMINISTRATIVE PANEL DECISION

Valentino S.p.A. v. Xuemei Liao, Yunzheng Wang, Lihua Peng, Onbch Tbew, Enjcedj Ybxw, Uncjdnj Onxncd, bo shen, DAOHON ZHOU, Hefang Zhou, Qing He, Domain Administrator
Case No. D2023-1700

1. The Parties

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

The Respondents are Xuemei Liao, China; Yunzheng Wang, China; Lihua Peng, China; Onbch Tbew, Hong Kong, China; Enjcedj Ybxw, Hong Kong, China; Uncjdnj Onxncd, Hong Kong, China; bo shen, China; DAOHON ZHOU, China; Hefang Zhou, China; Qing He, China; and Domain Administrator, country not disclosed.

2. The Domain Names and Registrars

The disputed domain name <discountvalentinos.shop> is registered with Gandi SAS; the disputed domain names <soldesvalentino.store>, <mujervalentino.store>, and <esvalentino.store> are registered with Name.com, Inc.; the disputed domain names <redvalentino-us.shop> and <newvalentino.shop> are registered with GoDaddy.com, LLC; the disputed domain name <valentinoutlet.shop> is registered with NameSilo, LLC; and the disputed domain names <valentinofashion.website>, <valentino-garavani.shop>, <valentinoshoe.shop>, and <valentinode.shop> are registered with Dynadot, LLC.

Gandi SAS, Name.com, Inc., GoDaddy.com, LLC, NameSilo, LLC, and Dynadot, LLC are separately and collectively referred to below as the “Registrar”.

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on April 18, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 18, 19, and 21, 2023, the Registrar transmitted by email to the Center its verification responses disclosing registrant and contact information for the disputed domain names, some of which differed from the named Respondents (Yunzheng Wang, Lihua Peng, Xuemei Liao, PrivacyGuardian.org LLC, Domain Protection Services, Inc., Dynadot Privacy Service, and Not Disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 24, 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 in English on April 27, 2023.

On April 24, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant submitted its request that English be the language of the proceeding on April 24, 2023. The Respondents did not comment on the language of the proceeding.

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 Respondents in English and Chinese of the Complaint, and the proceedings commenced on May 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on May 31, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on June 5, 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.

On June 5, 2023, the Center sent further emails to the Registrar regarding the disputed domain names <valentinoutlet.shop> and <valentino-garavani.shop>. On June 5 and June 6, 2023, the Registrar sent replies confirming the identity of these registrants.

4. Factual Background

The Complainant is a fashion house founded in 1960 by the designer Valentino Garavani and his business partner Giancarlo Giammetti. The Complainant produces fashion and accessories, including shoes, belts, and bags. The Complainant holds multiple trademark registrations in multiple jurisdictions including the following:

- International trademark registration number 570593 for VALENTINO, registered on April 24, 1991, designating multiple jurisdictions including China, and specifying goods in classes 3, 14, 18, and 25;
- International trademark registration number 764790 for VALENTINO, registered on November 20, 2000, designating multiple jurisdictions including China, and specifying goods and services in classes 3, 9, 14, 16, 18, 19, 20, 21, 24, 25, 27, 34, and 35;
- International trademark registration number 969844 for VALENTINO GARAVANI, registered on July 2, 2008, designating multiple jurisdictions including China, and specifying goods and services in classes 8, 11, 19, 20, 21, 27, 36, 42 and 43;
- International trademark registration number 1000386 for a semi-figurative RED VALENTINO mark, registered on February 25, 2009, designating multiple jurisdictions including China, and specifying goods and services in classes 25 and 35; and
- International trademark registration number 1522424 for a figurative mark (the “V logo”), registered on December 19, 2019, and specifying goods and services in classes 3, 9, 14, 18, 25, and 35.

The above trademark registrations remain current. The Complainant has also registered multiple domain names including <valentino.com>, registered in 1998, that it uses in connection with its main website where it offers its products for sale, and <redvalentino.com>, registered in 2005, that it uses in connection with a website where it offers its Red Valentino line of products for sale.

The Respondents are identified in the Registrar's Whois database as various individuals and a "Domain Administrator".¹

The disputed domain names were registered on the dates and in the names shown below:

| No. | Date of registration | Disputed domain name | Registrant |
|-----|----------------------|-----------------------------|----------------------|
| 1 | April 30, 2022 | <redvalentino-us.shop> | Xuemei Liao |
| 2 | May 6, 2022 | <newvalentino.shop> | Lihua Peng |
| 3 | June 28, 2022 | <valentinode.shop> | bo shen |
| 4 | July 7, 2022 | <valentinofashion.website>* | DAOHON ZHOU |
| 5 | July 12, 2022 | <valentino-garavani.shop>* | Hefang Zhou |
| 6 | July 13, 2022 | <valentinoshoe.shop> | Qing He |
| 7 | July 16, 2022 | <soldesvalentino.store>* | Uncjdnj Onxncd |
| 8 | July 27, 2022 | <discountvalentinos.shop> | Yunzheng Wang |
| 9 | August 19, 2022 | <mujervalentino.store>* | Enjcedj Ybxw |
| 10 | August 19, 2022 | <esvalentino.store>* | Onbch Tbew |
| 11 | October 9, 2022 | <valentinoutlet.shop>* | Domain Administrator |

The disputed domain names resolve to websites that offer "Valentino" clothing, shoes, bags and belts for sale at discount prices. The websites associated with the disputed domain names marked with an asterisk (*) in the above table prominently display the Complainant's V logo, while those associated with <redvalentino-us.shop> and <valentinode.shop> are titled "Red Valentino". The sites associated with <newvalentino.shop>, <valentinoshoe.shop> and <discountvalentinos.shop> are titled "Vanto Store", "Valentino Shoe" and "Discount Valentinos", respectively, with different logos, but all three refer to "Valentino Garavani" in product descriptions and display the V logo in product images. The websites associated with <esvalentino.store> and <mujervalentino.store> are in Spanish, the site associated with <soldesvalentino.store> is in French, the site associated with <valentinode.shop> is in German, with prices displayed in EUR, while the sites associated with the other seven disputed domain names are in English, with prices displayed in USD.

5. Parties' Contentions

A. Complainant

The disputed domain names are confusingly similar to the Complainant's VALENTINO mark. The disputed domain name <valentino-garavani.shop> is also identical or at least confusingly similar to the Complainant's VALENTINO GARAVANI mark. The disputed domain name <redvalentino-us.shop> is also confusingly similar to the Complainant's RED VALENTINO mark.

The Respondents have no rights or legitimate interests in respect of the disputed domain names. The Respondents are not licensees or authorized agents of the Complainant or in any other way authorized to use the Complainant's trademarks. Specifically, the Respondents are not authorized resellers of the Complainant and have not been authorized to register or use the disputed domain names. The Respondents are not commonly known by the disputed domain names. There is no evidence that the Respondents are using the disputed domain names in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names.

The disputed domain names were registered and are being used in bad faith. The Respondents could not possibly have ignored the existence of the VALENTINO trademark when they registered the disputed domain names. The use of the disputed domain names with commercial websites displaying the Complainant's trademarks and offering for sale *prima facie* counterfeit VALENTINO-branded products clearly

¹ The Registrar of the disputed domain name <valentinoutlet.shop> confirmed to the Center that "[a]ccount owner has not completed their registrant details/account", and "[t]hey provided a fake/placeholder Registrant name: 'Domain Administrator'".

indicates that the Respondents' 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 their own websites for commercial gain. Moreover, the Respondents have registered the disputed domain names in order to prevent the Complainant from reflecting its trademarks in corresponding domain names and have clearly engaged in a pattern of such conduct. Two of the Respondents were found by prior panels under the UDRP to have registered and been using other domain names in bad faith.

B. Respondents

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

6. Discussion and Findings

6.1 Preliminary Issues

A. Consolidation: Multiple Domain Name Registrants

The amendment to the Complaint initiates disputes in relation to 11 nominally different domain name registrants regarding 11 different domain names. The Complainant alleges that the domain name registrants are all under the control of the same individual or entity or, at least, reflective of a group of individuals acting in concert. The Complainant points out commonalities among the disputed domain names, their registration contact details, and the associated websites.

The Complainant requests consolidation of the disputes against the 11 nominally different domain name registrants pursuant to paragraph 10(e) of the Rules. The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. In addressing the Complainant's request, the Panel will consider: (i) whether the disputed domain names or associated websites are subject to common control; and, if so, (ii) whether the consolidation would be fair and equitable to all Parties. See *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#) and WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes the following:

- all disputed domain names were registered within a relatively short period of time, they all wholly incorporate the VALENTINO mark with additional words or letters; they all use Cloudflare name servers, and they are all put to the same use, which is to resolve to online stores with similar content and layouts selling purported VALENTINO products;
- disputed domain names 1 and 2 in the above table were registered with the same Registrar and their associated websites display the same Terms and Conditions and the same contact postal address in Texas, United States of America ("United States");
- the website associated with disputed domain name 3, which is mostly in German, displays a title identical to that of the website associated with disputed domain name 1 ("Red Valentino") while the two websites identify their respective operators as "RED Valentino Sales" and "RED Valentino Verkäufe", which is the same name in English and German;
- disputed domain names 4, 5 and 6 were registered soon after with the same Registrar as disputed domain name 3. The websites associated with disputed domain names 4, 5, 6 and 8 display the same Terms and Conditions as each other, while those associated with disputed domain names 6 and 8 also display the same contact address in Kansas, United States;

- disputed domain names 7, 9 and 10 were registered with the same Registrar, (the latter two on the same day) and all three share the same Hong Kong, China contact telephone number in the Whois database. The websites associated with these disputed domain names display the same Terms and Conditions as the websites associated with disputed domain names 4, 5 and 6, translated into French or Spanish. The websites associated with disputed domain names 9 and 10 also display the same contact address in Spain; and
- the website associated with disputed domain name 11 displays the same About Us text, Privacy Policy and Terms and Conditions as the websites associated with disputed domain names 1 and 2.

In view of the above circumstances, the Panel is persuaded that all the disputed domain names or the associated websites, or both, are under common control.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes regarding all the disputed domain names would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the Complaint regarding all the disputed domain names held in the names of Xuemei Liao; Yunzheng Wang; Lihua Peng; Onbch Tbew; Enjcedj Ybxw; Uncjdnj Onxncd; bo shen; DAOHON ZHOU; Hefang Zhou; Qing He; and Domain Administrator (individually and collectively referred to below as “the Respondent”) in this single proceeding under the Policy.

B. Language of the Proceeding

Paragraph 11(a) of the Rules provides that “unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”. The Registrar confirmed that the Registration Agreements for the disputed domain names are in English with the exception of the Registration Agreement for the disputed domain name <discountvalentinos.shop>, which is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main arguments are that translation of the Complaint, its amendment, and its annexes, into Chinese would cause delay; and that the Respondent has demonstrated that it understands English by entering into 10 Registration Agreements in English, composing most disputed domain names with English terms, and publishing associated websites in English.

Paragraph 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); and *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that the Complaint and the amendment to the Complaint were filed in English. Despite the fact that the Registration Agreement for one of the disputed domain names is in Chinese, the website associated with that same disputed domain name is in English, as are the Registration Agreements for all other disputed domain names, from which it is reasonable to infer that the Respondent is able to communicate in that language. Despite the Center having sent emails regarding both the language of the proceeding and the notification of the Complaint in English and Chinese, the Respondent has not commented on the language of the proceeding or expressed any interest in participating otherwise in this proceeding. Therefore, the Panel considers that requiring the Complainant to translate the Complaint into Chinese would create an undue burden and delay.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements with respect to each disputed domain name:

- (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.

A. Identical or Confusingly Similar

Based on the evidence presented, the Panel finds that the Complainant has rights in the VALENTINO mark, the RED VALENTINO mark, and the VALENTINO GARAVANI mark.

The disputed domain names all wholly incorporate the VALENTINO mark. They also include a word (variously, “discount”, “fashion”, “new”, “outlet”², “red”, “shoe”, “mujer” (meaning “woman” in Spanish) or “soldes” (meaning “sales” in French), or a name (“-garavani”), or letters (variously, a plural “s” or “de”, “es”, or “-us” that are references to Germany, Spain and the United States, respectively). The addition of these words, name and letters does not prevent a finding of confusing similarity because the VALENTINO mark remains clearly recognizable in every disputed domain name. See [WIPO Overview 3.0](#), section 1.8.

In addition, the disputed domain name <redvalentino-us.shop> wholly incorporates the RED VALENTINO mark, with the addition of a hyphen and the letters “us” while the disputed domain name <valentino-garavani.shop> wholly incorporates the VALENTINO GARAVANI mark with the addition of a hyphen. The addition of these letters and punctuation does not prevent findings of confusing similarity with these marks because each mark remains clearly recognizable in one of these disputed domain names.

The only other element in each disputed domain name is a generic Top-Level Domain (“gTLD”) (variously “.shop”, “.store”, or “.website”). As a standard requirement of domain name registration, this element may be disregarded in the comparison between a domain name and a trademark unless it has some impact beyond its technical function, which is not the case here. See [WIPO Overview 3.0](#), section 1.11.

Therefore, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (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

² In this case, the first letter of “outlet” overlaps with the last letter of the VALENTINO mark.

- (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.

With respect to the first and third circumstances set out above, the Respondent uses the disputed domain names to resolve to online stores that prominently display the Complainant's VALENTINO mark or the Complainant's V logo, or both, and offer for sale what are purported to be the Complainant's clothing, shoes, and accessories at discounted prices. The Complainant submits that the Respondent is not a licensee or authorized agent of the Complainant or in any other way authorized to use the Complainant's trademarks. Regardless of whether the products offered for sale are genuine or counterfeit, the websites do not display any disclaimer of a relationship between the Respondent and the Complainant; on the contrary, they give the false impression that the websites are outlet stores affiliated with the Complainant. These circumstances indicate that the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods and services, and that it is not making a legitimate noncommercial or fair use of the disputed domain names.

With respect to the second circumstance set out above, the Respondent is identified in the Registrar's Whois database by various personal names, apparently random strings of letters, and the designation "Domain Administrator", none of which resembles any of the disputed domain names. Nothing indicates that the Respondent has been commonly known by the disputed domain names.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent failed to rebut that *prima facie* case because it did not respond to the Complaint.

Therefore, based on the record of this proceeding, the Complainant has satisfied the second element in paragraph 4(a) of the Policy

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

- (iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.

As regards registration, the disputed domain names were all registered in 2022, years after the Complainant registered its VALENTINO mark, including in China, where the Respondent is at least partly based. The disputed domain names wholly incorporate the VALENTINO mark and resolve to websites that display the VALENTINO mark, in six cases with the Complainant's V logo in the title or in product images, in some cases with the name of the Complainant's founder designer, and in all cases with images of what are purported to be the Complainant's products. In these circumstances, the Panel finds that the Respondent had the Complainant and its VALENTINO mark in mind at the times when it registered the disputed domain names.

As regards use, the disputed domain names all resolve to online stores that offer for sale what are purported to be the Complainant's products at discount prices. Given these circumstances and the findings in Section 6.2B above, the Panel finds that this use of the disputed domain names intentionally attempts to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites and of the products on those websites as set out in paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the disputed domain names have been registered and are being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) of the Policy.

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, <discountvalentinos.shop>, <esvalentino.store>, <mujervalentino.store>, <newvalentino.shop>, <redvalentino-us.shop>, <soldesvalentino.store>, <valentinode.shop>, <valentinofashion.website>, <valentino-garavani.shop>, <valentinoshoe.shop>, and <valentinoutlet.shop>, be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: June 14, 2023