

## **ADMINISTRATIVE PANEL DECISION**

FENICE S.R.L. v. 赵永健 (Zhao Yong Jian), 温州富捷金融信息服务有限公司 (Wen Zhou Fu Jie Jin Rong Xin Xi Fu Wu You Xian Gong Si), and 胡燕 (Yan Hu)

Case No. D2023-3385

### **1. The Parties**

The Complainant is FENICE S.R.L., Italy, represented by Gianni & Origoni, Italy.

The Respondents are 赵永健 (Zhao Yong Jian), 温州富捷金融信息服务有限公司 (Wen Zhou Fu Jie Jin Rong Xin Xi Fu Wu You Xian Gong Si), China (the “First Respondent”), and 胡燕 (Yan Hu), China (the “Second Respondent”).

### **2. The Domain Names and Registrar**

The disputed domain names <chiaraferragni-it.shop>, <chiaraferragniit.shop>, <chiara-ferragni.shop>, and <chiaraferragni.shop> are registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on August 7, 2023 regarding the disputed domain names <chiaraferragniit.shop> and <chiaraferragni-it.shop> (the “original disputed domain names”). On August 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the original disputed domain names. On August 9, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrants and contact information for the disputed domain names which differed from the named Respondents (Redacted For Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 9, 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 amended Complaint in English on August 14, 2023.

On August 9, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreements for the original disputed domain names is Chinese. On August 11, 2023, the Complainant submitted a request that English to be the language of the proceeding. The Respondents did not submit any comment on the 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 the Respondents in Chinese and English of the Complaint, and the proceedings commenced on August 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on September 19, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on September 25, 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 August 30, 2023, the Complainant sent an email communication to the Center, requesting to add the disputed domain names <chiara-ferragni.shop> and <chiaraferragni.shop> (the “additional disputed domain names”) to the proceeding.

On October 16, 2023, the Panel informed the Center that it may accept the additional disputed domain names. The Panel also instructed the center to acquire verification from the Registrar including the registrant information for the additional disputed domain names.

On October 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the additional disputed domain names. On October 17, 2023, the Registrar transmitted by email to the Center its verification response disclosing that the Second Respondent is the registrant of the additional disputed domain names and that the language of their Registration Agreements is in Chinese.

Accordingly, on October 20, 2023, the Panel issued a procedural order, inviting the Complainant to add comments (if any) regarding the consolidation of multiple registrants by October 24, 2023, and inviting the Second Respondent to comment on the Complainant’s submissions including the consolidation of multiple registrants, and the language of the proceeding, and/or to file a Response as it may deem appropriate by October 28, 2023. On the same day, the Complainant confirmed that it would not be necessary for it to add any further comments to its request for consolidation provided in the Complaint and amended Complaint. The Panel notes that the Respondent did not reply to the procedural order.

#### **4. Factual Background**

The Complainant is a company registered in Italy and, *inter alia*, manages an Internet e-commerce website named “Chiara Ferragni Brand” under the domain name <chiaraferragnibrand.com>, where a wide range of CHIARA FERRAGNI-branded fashion products (including, e.g., clothing, footwear, accessories, jewelry, make-up, and sunglasses) are sold. The Complainant is the owner or majority co-owner of the CHIARA FERRAGNI trademarks.

The Complainant provides evidence that it owns an international portfolio of trademark registrations and applications for CHIARA FERRAGNI (both word and figurative trademarks). These registrations include, but are not limited to, European Union Trademark Registration number 018531590 for CHIARA FERRAGNI, registered on October 10, 2013; and International Trademark Registration No. 1171027 for CHIARA FERRAGNI, registered on May 27, 2013 and designating, *inter alia*, Japan and China. The Complainant also has a strong online presence with a particularly large following on social media networks.

The disputed domain names were all registered between May and August, 2023. The disputed domain names are therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain names previously directed to websites

impersonating the Complainant by using the Complainant's trademarks and product images and purportedly offering for sale the Complainant's products or possibly counterfeit products. However, the Panel notes that on the date of this Decision, the disputed domain names direct to inactive webpages.

## **5. Parties' Contentions**

### **A. Complainant**

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

Notably, the Complainant contends that the disputed domain names are confusingly similar to its registered trademarks for CHIARA FERRAGNI, that the Respondents have no rights or legitimate interests in respect of the disputed domain names, and that the disputed domain names were registered, and are being used in bad faith to divert Internet users to the Respondents' webpages which impersonated the Complainant and offered for sale counterfeit products.

The Complainant essentially contends that the disputed domain names are confusingly similar to the Complainant's famous trademarks as each of them incorporates the Complainant's CHIARA FERRAGNI trademark in its entirety. The Complainant also argues that the disputed domain names were diverting Internet users to websites that impersonated the Complainant's website. The Complainant particularly contends that the websites at the disputed domain names used the Complainant's trademarks and product images to create the same commercial impression as the Complainant's, which, according to the Complainant, confers no rights or legitimate interests in the disputed domain names on the Respondents, and which means that the Respondents are gaining a commercial benefit through such use of the Complainant's marks. The Complainant also argues that the Respondents had or can be expected to have had prior notice of the Complainant's trademarks at the time each of the disputed domain name was registered, since the Complainant registered its trademarks for CHIARA FERRAGNI many years prior to the registration of the disputed domain names and since these marks are well known in the fashion industry. Finally, the Complainant also contends that the Respondents have been involved in previous domain name disputes where the panels have concluded that they have registered and used the domain names in bad faith, and that there is therefore a pattern of bad faith behavior. The Complainant argues that the registration and use of the disputed domain names in such circumstances constitutes registration and use in bad faith.

The Complainant requests the transfer of the disputed domain names.

### **B. Respondent**

The Respondents did not reply to the Complainant's contentions

## **6. Discussion and Findings**

### **6.1 Procedural Issues**

#### **A. Addition of Domain Names**

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.12.2, "Requests for addition of domain names to a complaint after it has been notified to the respondent and the proceedings have formally commenced would be addressed by the panel on appointment". On August 30, 2023, the Complainant requested to include the additional disputed domain names to the proceeding because it had become aware that the additional disputed domain names resolved to the same websites associated with the original disputed domain names, and the Complainant asserted that the filing of a separate complaint for the additional disputed domain names would result in the same

facts and arguments already presented in the Complaint and would be against the principle of cost-effectiveness that underpins the Rules.

Considering the above, and the Second Respondent is the registrant for the additional disputed domain names, and in the absence of any objection from the Respondents, the Panel finds that it would be practical and fair to allow the additional disputed domain names to this proceeding. Therefore, the Complainant's request for the additional disputed domain names is granted.

## **B. Consolidation: Multiple Respondents**

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are connected and the disputed domain names are under common control. The Complainant requests the consolidation of the Complaint against the multiple domain name registrants pursuant to paragraph 10(e) of the Rules.

The Respondents 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 whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See [WIPO Overview 3.0](#), section 4.11.2.

As regards common control, the Panel notes that each of the disputed domain names was registered via the same Registrar and was registered within a short time span, namely between May and August, 2023. Furthermore, all disputed domain names target the same mark of the Complainant, namely CHIARA FERRAGNI, and resolved to virtually identical e-commerce websites using the Complainant's trademarks and product images, thereby exposing a pattern. The Panel deduces from these facts that the disputed domain names are likely under common control.

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

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different domain name registrants (referred to below as "the Respondent") in a single proceeding.

## **C. Language of the Proceeding**

The language of the Registration Agreements for the disputed domain names is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Complainant is an Italian company and does not understand Chinese, and that it would therefore be burdensome, expensive and cause delays for the Complainant to have to translate the Complaint and Annexes into Chinese, the fact that the Respondent operated its websites in Italian and not in Chinese; if the Respondent is able to understand and operate the websites in Italian, it must be able to understand English, which is the most widely used language in international business and commercial activities, and the fact that the disputed domain names are written in Latin letters and not in Chinese characters.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to all parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time, and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, and noting although the Respondent has been notified in Chinese and English of the language of the proceeding and the commencement of the proceeding, the Respondent has chosen not to comment on the language of the proceeding or to file any Response in either Chinese or English, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

## **6.2 Substantive Issues**

### **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 the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the 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 mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, the letters "it" in two of the disputed domain names, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain names and the mark 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**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Moreover, the Panel notes that, based on the evidence submitted by the Complainant, the Respondent has used the disputed domain names to connect them to websites impersonating the Complainant by using the Complainant's trademarks and product images. In this case, the Panel also accepts the Complainant's argument that, given the significant price reductions, unclear origin, the lack of any clear disclaimer and false suggestions of affiliation on the website linked to the disputed domain name, it is very likely that the products offered by the Respondent on such websites were counterfeit products.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

However, the Panel notes that on the date of this Decision, the disputed domain names direct to an inactive webpage. In this regard, the Panel finds that holding a domain name passively, without making any use of it, also does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#) and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

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

### **C. Registered and Used in Bad Faith**

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered the disputed domain names, which are confusingly similar to the Complainant's intensely used and distinctive trademarks. The Panel deduces from this fact that by registering the disputed domain names, the Respondent deliberately and consciously targeted the Complainant's prior trademarks for CHIARA FERRAGNI. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states "[p]anels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Furthermore, the Panel also notes that the Complainant's trademarks for CHIARA FERRAGNI were registered several years before the registration date of the disputed domain names, and were displayed on the websites associated with the disputed domain names. The Panel deduces from these elements that the Respondent knew of the existence of the Complainant's trademarks at the time of registering the disputed domain names. In the Panel's view, these elements indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain names in bad faith.

As to use of the disputed domain names in bad faith, the Panel notes that, based on the evidence submitted by the Complainant, the Respondent has used the disputed domain names to connect them to websites impersonating the Complainant by using the Complainant's trademarks and product images. In this case, the Panel also accepts that, given the significant price reductions, the unclear origin, the lack of any prominent and clear disclaimer and false suggestions of affiliation on the websites linked to the disputed domain names, it is very likely that the products offered by the Respondent on such websites were counterfeit products.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods) constitutes bad faith.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

However, on the date of this Decision, the disputed domain names link to inactive websites.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, the misleading use made of the disputed domain names by the Respondent before the relevant websites were deactivated, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

Finally, the Panel also accepts the Complainant's argument that the Respondent has engaged in a trademark-abusive pattern of domain name registrations, based on its involvement and the findings of bad faith on the Respondent by the respective panels in a number of prior UDRP cases, including *Jott Market & Distribution*, *SAS v. 胡燕 (Yan Hu)*, WIPO Case No. [D2022-3820](#), and *Benda Bili v. 赵永健 (Zhao Yong Jian)*, *温州富捷金融信息服务有限公司 (Wen Zhou Fu Jie Jin Rong Xin Xi Fu Wu You Xian Gong Si)*, WIPO Case No. [D2022-4156](#).

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

## 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 <chiaraferragni-it.shop>, <chiaraferragniit.shop>, <chiara-ferragni.shop>, and <chiaraferragni.shop> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: November 13, 2023