

ADMINISTRATIVE PANEL DECISION

VALENTINO S.p.A. v. Luiz Correa

Case No. D2023-4120

1. The Parties

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

The Respondent is Luiz Correa, Brazil.

2. The Domain Name and Registrar

The disputed domain name <valentino.com> is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 3, 2023. On October 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 3, 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 (PERFECT PRIVACY, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 6, 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 October 9, 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 October 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2023. The Respondent did not submit a response by this date. Accordingly, the Center notified the Respondent’s default on November 3, 2023.

However, on November 6, 2023, the Center received an email sent from the email address which the Registrar confirmed as the email address of the Respondent.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on November 17, 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 November 28, 2023, the Panel issued Administrative Panel Order No. 1 inviting the Respondent to provide further information about the matters discussed further below by December 5, 2023. The Order also made provision for supplemental filing by the Complainant in the event the Respondent availed himself of the invitation. No further response was received from the Respondent.

4. Factual Background

The Complainant is fashion label. According to the Complaint, it was founded in 1960 and now provides a wide range of luxury products including haute couture, prêt-à-porter ranges and accessories including bags, shoes, small leather goods, silks and, through licensing arrangements, eyewear and perfume.

The Complainant's products under the "Valentino" brand are available in over 90 countries through 160 directly owned stores and more than 1,300 points of sale. The Complainant has dedicated VALENTINO stores in Brazil in Sao Paulo, Rio de Janeiro, Curitiba, Recife, and Iguatemi Sao Paulo, with its first store in Brazil opening in 2012.

The Complainant's products are also promoted and available through online stores including "www.valentino.com". In addition, the Complainant has an active social media presence. When the Complaint was filed, its Facebook page had 3.2 million followers; its Twitter (now X) account, 2.2 million followers; its Instagram account, 16.4 million followers; its Pinterest account, 273,800 followers; and its YouTube page has 73,700 subscribers.

The Complaint includes evidence that the Complainant owns numerous registered trademarks around the world for VALENTINO. The oldest example included in the Complaint is United States of America Registered Trademark No. 910955 which has been registered in the Principal Register in respect of clothing and accessories in International Class 25 since April 6, 1971. The Amended Complaint includes evidence that the Complainant owns at least three registered trademarks in Brazil including Brazilian Registered Trademark No. 007032315, which was filed on April 16, 1970 and registered on December 10, 1979 in class 25.

The disputed domain name was registered on June 26, 2013.

Screenshots from the Wayback Machine included in the Complaint show that at times in at least 2016 the disputed domain name resolved to a landing page showing pay-per-click (PPC) links to the Complainant and other fashion suppliers.

After the Complainant's lawyers sent a cease and desist letter (to the "shielded" email address provided by the then Registrar) in July 2016, the PPC page was taken down and the disputed domain name does not appear to resolve to an active website now. However, the MX record is still configured.

The Complainant has sent a number of follow-up letters to its cease and desist letter in the years following.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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.

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

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of numerous registered trademarks for VALENTINO, some examples of which have been referred to above.

The Panel also accepts the Complainant's contention that the Complainant's trademark is a well-known or famous make at least in the fashion field.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD, the disputed domain name consists of the Complainant's registered trademark with a double "t". This is an obvious misspelling of the Complainant's trademark and does not avoid a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.9. Apart from anything else, the Complainant's trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

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.

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.

The Respondent registered the disputed domain name many years after the Complainant began using its trademark and also well after the Complainant had registered its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name as notified by the Registrar. The Complainant submitted it had not found evidence of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

The Respondent was initially using the disputed domain name to resolve to a page with PPC links to both the Complainant and its competitors. That does not qualify as a noncommercial or other fair use under the Policy as such links have the potential to divert consumers away from the Complainant to competitors. See e.g., [WIPO Overview 3.0](#), section 2.9.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name.

In the informal response received by the Center on November 6, 2023, the Respondent claimed that he registered the disputed domain name because it corresponds to his name which, according to his email, is Luiz Henrique Valentino Corrêa. As a result, the Respondent contended that he has “a full right to use my surname however I want.” The email then invited a “value proposal” if the Complainant wished to buy a specific domain.

The Respondent's Response did not include any material supporting his claim to his name.

Generally speaking, a mere assertion unsupported by concrete evidence is not sufficient to support a claim to rights or legitimate interests under the Policy on the basis of being known by a particular name. See e.g., [WIPO Overview 3.0](#), section 2.3.

As the name the Respondent claims is different to the name confirmed by the Registrar as the name in which the disputed domain name is registered although the email address used was the email address confirmed by the Registrar, the Panel issued Administrative Panel Order No. 1 directing the Respondent's attention to section 2.3 of the [WIPO Overview 3.0](#) and providing the Respondent with an opportunity to verify his claimed identity.

As noted in section 3 above, however, the Respondent has not made any further submissions. The Panel of course does not know whether or not the Respondent's full name is the name he claimed in his informal Response. The Respondent registered the disputed domain name under the name "Luiz Corrêa", not a name that includes "Valentino". The Respondent has for whatever reason – and despite specifically being given a second chance to do so – not been prepared to provide any materials supporting that claim. Furthermore, the disputed domain name registered by the Respondent is different to the name "Valentino" – the former being a typo with two "t"s. In line with the position indicated in [WIPO Overview 3.0](#), section 2.3, therefore, the Panel is unable to accept the Respondent's claim.

In these circumstances, the Respondent has not rebutted the *prima facie* case established by the Complainant. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: See e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd.*, WIPO Case No. [D2010-0470](#).

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 (usually) the complainant.

The Respondent has not denied knowledge of the Complainant and its trademark. As noted in section 5A above, the Panel accepts that the Complainant's trademark is very well-known. The Panel has also been unable to accept the Respondent's claim that the disputed domain name was adopted because of its resemblance to the Respondent's own name. Accordingly, the Panel considers it likely that the Respondent was aware of the trademark significance arising from the resemblance of the disputed domain name to the Complainant's trademark and sought to take advantage of that resemblance. The very limited way the Respondent used the disputed domain name before the Complainant challenged the Respondent provides some support for that inference.

Such conduct constitutes registration in bad faith under the Policy.

The fact that the disputed domain name is not apparently presently active does not preclude a finding of use in bad faith. The disputed domain name was being used to take advantage of its resemblance to the Complainant's trademark through PPC links and those links appear to have stopped only following the Complainant's objections. Further, it is well established that passive holding of a disputed domain name can qualify as "bad faith" for the purposes of the Policy. See e.g., *Telstra Corporation v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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 name, <valentino.com> be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: December 18, 2023