

ADMINISTRATIVE PANEL DECISION

Gianni Versace S.r.l. v. domain admin
Case No. DCO2023-0012

1. The Parties

The Complainant is Gianni Versace S.r.l., Italy, represented by Studio Barbero, Italy.

The Respondent is domain admin, China.

2. The Domain Name and Registrar

The disputed domain name <versace.co> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 10, 2023. On February 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 11, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 16, 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 February 17, 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 February 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 24, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on April 12, 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 is an international fashion company and has used the VERSACE trademark for over forty years in Italy. It has also obtained registration of this trademark in many other jurisdictions, including the European Union Trademark Registration No. 001665439 VERSACE (word mark), filed on May 18, 2000, registered on September 10, 2001, and duly renewed, in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, and 42; International Trademark Registration No. 648708 VERSACE (word mark), registered on October 6, 1995, and duly renewed, in classes 3, 9, 14, 18, and 25, designating, amongst others, China; International Trademark Registration No. 726311 VERSACE (word mark), registered on December 2, 1999, and duly renewed, in classes 8, 19, 20, 21, and 24, designating, amongst others, China; and International Trademark Registration No. 1018595 VERSACE (word mark), registered on September 3, 2009, and duly renewed, in class 9, designating, amongst others, China.

The Complainant also operates a website at the domain name “www.versace.com” as its primary portal for global promotion and offers its VERSACE products for sale online.

The disputed domain name was registered on October 8, 2017, and resolves to a website with sponsored links relating to clothing and sunglasses, products for which the VERSACE trademark has been registered by the Complainant. The Respondent also offered to sell the disputed domain name to the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant points out that it is an Italian limited liability company founded in 1978, by the fashion designer Gianni Versace, who opened its first boutique in Milan. The Complainant and the Versace Group now distribute products through a worldwide D.O.S network, including over 200 city boutiques and over 1500 wholesalers. Fifty-three VERSACE stores are located in China. The Complainant says that it has strong public links with celebrities, models, the music industry and high profile social events, and deploys much advertising globally by way of television and other means, including social media platforms.

The disputed domain name resolves to a website with sponsored links. However, the Complainant says that it also contained a link “Acquistare questo dominio” (“Purchase this domain name”) which redirected to an internal page where <versace.co> is offered for sale. At the time the disputed domain name was first accessed by the Complainant it was there offered for sale for GBP 7,999 whereas at the time of drafting of the present Complaint it was offered for sale for GBP 5,500, the latter says.

The Complainant initially requested a web agency to contact the then registrant of the disputed domain name. The agency concerned emailed the registrant at the email address indicated in the WhoIs records at that time inquiring about the disputed domain name and posing as a prospective client. The reply received was as follows: “Hello, this domain (versace.co) is for sale, price 7999 GBP, thank you”. In view of the total lack of rights of the registrant, the Complainant says that it instructed its solicitors to then send a cease-and-desist letter on October 3, 2018, to which no reply was received. The Registrar's identity then changed, and the registrant information was redacted, so the Complainant, on January 8, 2019, instructed the web agency to contact the previous registrant again to obtain confirmation that it still owned the disputed domain name. Again, a reply was received from the prior registrant reiterating the offer to transfer the disputed domain name for the same amount as previously. A further cease and desist letter was then sent and remained similarly unanswered, and the disputed domain name's registration was in the meantime renewed. The Complainant then caused another cease and desist letter to be sent on March 10, 2022, which again remained unanswered, whereupon the Complainant instigated the present proceeding.

The Complainant points out that the disputed domain name is identical to its VERSACE registered trademark.

Further, the Complainant says that it is sufficient for it to set out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not been authorized to use the VERSACE trademark by the Complainant, who says that it is well-established that in the absence of any license or permission from a complainant, no *bona fide* or legitimate use of the disputed domain name can reasonably be claimed. The Complainant also says that the Respondent is not the owner of any trademark or service mark that is identical to its VERSACE trademark, and to its knowledge the Respondent is not commonly known by the disputed domain name. The VERSACE trademark corresponds to the surname of the founder of the Complainant and is accordingly not one a trader would legitimately choose unless intending to create the impression of a connection with the Complainant, or so the latter maintains. There is no evidence, the Complainant says, of any *bona fide*, noncommercial or fair use of the disputed domain name by the Respondent.

By visiting the site to which the disputed domain name resolves, Internet users are redirected to internal pages displaying additional links to third-party websites, where products of the Complainant's competitors are advertised and offered for sale. The Complainant says that such use does not amount to a *bona fide* offering of goods or services or to a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain, also in view of the fact that the Respondent is certainly making gains, for example from the click-through commissions on the sponsored links.

Moreover, via the link "Acquistare questo dominio" ("Purchase this domain name") published at the bottom of the home page of the site to which the disputed domain name resolves, users are redirected to an internal page of the "sedo.com" website, where the disputed domain name is offered for sale, previously for GBP 7,999 while, at the time of the drafting of the Complaint, it was offered for sale for GBP 5,500.

In any case, the Complainant points out, the nature of the disputed domain name, identical to the trademark VERSACE, creates a high risk of implied affiliation or association with the Complainant, in accordance with section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant further points out that in view of its use of the VERSACE trademark since 1978, and its very widespread reputation, it is almost inconceivable that the Respondent was not aware of it when the disputed domain name was registered. In any case, the appropriation of a trademark said to be well-known is in and of itself in bad faith. The Complainant attaches significance to a number of prior decisions in this regard, where Panelists said that the VERSACE trademark was a well-known mark. The Respondent was clearly acting with opportunistic bad faith, the Complainant says, seeking to take commercial advantage of the disputed domain name it registered. In any case, given the presence of the Complainant on the web, a most cursory search would have revealed the Complainant and its rights in the VERSACE trademark. Seeking commercial gain from then pointing Internet users, via sponsored links, to various commercial websites, is clearly a bad faith activity, according to the Complainant. The links displayed resolve to websites where clothing and sunglasses are offered, goods for which the Complainant's VERSACE trademarks are registered. This demonstrates a deliberate effort to trade off the Complainant's goodwill and diverts traffic from the Complainant's legitimate web presence.

The disputed domain name was and is also offered for sale at prices well above out-of-pocket expenses, and for that reason the Complainant says that paragraph 4(b)(i) of the Policy is applicable, since the Respondent registered the disputed domain name with the purpose of selling it, in all likelihood to the legitimate trademark owner, for valuable consideration in excess of the out-of-pocket cost.

Finally, the failure of the Respondent to answer the multiple cease-and-desist letters of the Complainant also indicates bad faith, the Complainant maintains, pointing to a number of previous Panel decisions to that effect.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is identical to the VERSACE registered trademark of the Complainant.

Accordingly, the Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

The Complainant did not authorize or license the Respondent to use its VERSACE registered trademark in any way. There is no evidence before the Panel that the Respondent is known by the name VERSACE or by the disputed domain name, or has acquired legitimate trademark rights in VERSACE or anything similar. The Respondent did not reply to any of the contentions of the Complainant in the present proceeding and did not reply to the cease and desist letters sent by the latter. The Respondent did however offer to transfer the disputed domain name to the Complainant for amounts far exceeding reasonable out of pocket expenses.

The disputed domain name resolves to a website where sponsored links are displayed which point to commercial websites where competing goods are offered for sale. This amounts to the Respondent profiting from the misleading impression worked upon Internet users, that the disputed domain name has a legitimate connection with the Complainant, which is obviously not the case. This dishonest activity is not of a kind that can result in the recognition of some legitimate interest or right vesting in the entity that engages in it.

Therefore the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

It is almost impossible to imagine that the Respondent was not aware that VERSACE is a registered trademark belonging to the Complainant. It is a mark to which very substantial goodwill attaches in many jurisdictions, and being a fashion brand, it is particularly well recognized in the Internet environment.

In any case, the fact that the disputed domain name resolves to a website with sponsored links to other fashion sites indicates that the Respondent deliberately chose the distinctive brand of the Complainant in an attempt to mislead Internet users in a manner that would generate unwarranted financial benefits.

Further, the Respondent did not enter into any meaningful correspondence with the Complainant, nor seek to make any justification for its acquisition of the disputed domain name. Rather, the Respondent sought to sell the latter back to the Complainant, for a sum far exceeding the out-of-pocket expenses of registration. The Respondent thus sought to profit dishonestly from misappropriating the property of the Complainant, that being the latter's registered trademark and attendant goodwill.

Therefore the Panel holds that the disputed domain name was registered and used in bad faith.

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 name <versace.co> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: April 26, 2023