

ADMINISTRATIVE PANEL DECISION

Fendi S.r.l. v. 王先生 (wang xian sheng) and Super Privacy Service LTD c/o
Dynadot / tianyu liu
Case No. D2022-1681

1. The Parties

The Complainant is Fendi S.r.l., Italy, represented by Dreyfus & associés, France.

The Respondents are 王先生 (wang xian sheng), China (“Previous Respondent”), and Super Privacy Service LTD c/o Dynadot, United States of America / tianyu liu, China (“Subsequent Respondent”).

2. The Domain Name and Registrar

The disputed domain name <9fendi.com> (“Disputed Domain Name”) at the time of filing the Complaint was registered with Hongkong Domain Name Information Management Co., Limited (the “Registrar”).

After appointment of the Panel, a cyberflight occurred and the Disputed Domain Name was transferred to the registrar Dynadot LLC (the “New Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 9, 2022. On May 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 19, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Registrar confirmed that the Disputed Domain Name has been locked and that the lock status will remain through the remaining pendency of the proceeding in accordance with paragraph 4 of the Rules.

On May 19, 2022, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on May 19, 2022. The Respondent did not comment on the language of the proceeding.

The Center verified that 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 Previous Respondent in English and Chinese of the Complaint, and the proceedings commenced on May 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 14, 2022. The Previous Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 15, 2022.

The Center appointed Kar Liang Soh as the sole panelist in this matter on June 21, 2022. 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.

The Center discovered that cyberflight has occurred, namely, the Registrar and registrant of the Disputed Domain Name had changed to Dynadot LLC and tianyu liu (of China) respectively on July 5, 2022. By the time the Center and the Panel became aware of the cyberflight, the Panel had already completed reviewing the documents in this proceeding. The Center attempted unsuccessfully to engage the Registrar and the New Registrar Dynadot LLC to understand how this change in the registration details of the Disputed Domain Name happened and whether it was possible to revert the same to that prior to July 5, 2022.

On July 28, 2022, the Panel issued Administrative Panel Procedural Order No. 1 which – notwithstanding an apparent breach of the Registrar's and New Registrar's ICANN obligations – ordered, *inter alia*, that the Complaint with Annexes and the Panel Order be delivered to the Subsequent Respondent for comments and Response to be submitted by August 11, 2022. The Center duly delivered the Complaint with Annexes and the Panel Order to the Subsequent Respondent. The Subsequent Respondent did not submit any comments or Response by August 11, 2022.

4. Factual Background

The Complainant is an Italian luxury fashion house established in 1925. The LVMH Group acquired a majority stake in the Complainant in 2001. The Complainant's name is FENDI Srl and has a long history of association with the fashion designer, Karl Lagerfeld. It has been actively operating stores in China over the last 14 years.

The Complainant owns trademark registrations for FENDI including the following International registrations:

Trademark No.	Registration date
906325	September 18, 2006
1250010	February 26, 2015

Both registrations designate China and protection has been granted in China for International registration no. 906325. The Complainant has a web presence under the domain name <fendi.com> registered on December 26, 1995 and the domain name <fendi.cn>, including operating an online retail store for China under the trademark FENDI resolved from the latter. The first page of a Google search on May 4, 2022 presented by the Complainant displays various links to webpages under the domain name <fendi.com>.

Both Respondents appear to be individuals. Little is known about either of them beyond the Whols information and the Registrars' verifications in this proceeding. The Previous Respondent's name on record is incomplete and simply stated as 王先生 (wang xian sheng) (Mr. Wang in Chinese). The Previous Respondent's various contact particulars on record (address and facsimile number were found to be invalid when attempts to communicate with the Respondent via these details were made. Similarly, the Subsequent Respondent's address on record is incomplete and/or invalid.

The Disputed Domain Name was registered on August 11, 2021. On or about February 10, 2022, the Disputed Domain Name resolved to a website which featured pornographic content and prominent advertising banners which redirect visitors to online pornography, gaming and gambling websites. The word "9fendi" does not appear anywhere on the website. The Complainant requested the Registrar to block the Disputed Domain Name and the website's hosting company to deactivate the website on February 10, 2022

and March 7, 2022 respectively but did not receive any response despite various reminders. After the occurrence of the cyberflight, the Disputed Domain Name resolves to a website with similar content.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

1) The Disputed Domain Name is identical or confusingly similar to the Complainant's trademark FENDI. It incorporates the trademark FENDI entirely with a mere adjunction of the number "9". The addition of generic terms, letters and numbers does not dispel any likelihood of confusion;

2) The Previous Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Previous Respondent is neither affiliated with the Complainant nor authorized by the Complainant to use and register its trademark or register a domain name incorporating the trademark. The Complainant's trademark registrations for FENDI precede the registration of the Disputed Domain Name. The Previous Respondent is not commonly known by the Disputed Domain Name. The commercial use of the Disputed Domain Name by the Previous Respondent to redirect to gambling and pornographic websites is not a fair or legitimate noncommercial use of the Disputed Domain Name; and

3) The Disputed Domain Name was registered and is being used in bad faith. The Previous Respondent knew or should have known of the Complainant's trademark rights when the Previous Respondent registered the Disputed Domain Name. The Complainant is well-known. The Previous Respondent registered the Disputed Domain Name based on the attractiveness of the Complainant's trademark to divert Internet traffic to its website. The Previous Respondent has a duty under the Policy to verify that the registration of the Disputed Domain Name does not infringe third party rights. An Internet search on the word "fendi" would reveal the existence of the Complainant, its trademarks and its products. It is not possible to conceive a plausible circumstance in which the Previous Respondent could legitimately use the Disputed Domain Name as it would invariably result in misleading diversion and taking unfair advantage of the Complainant's rights.

B. Respondents

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

6. Discussion and Findings

6.1 Language of Proceeding

The Registrar has verified that the Registration Agreement is in Chinese. Paragraph 11(a) of the Rules provides that unless otherwise agreed by the parties or specified otherwise in the registration agreement between the respondent and the registrar in relation to the disputed domain name, the language of the proceeding shall be the language of the registration agreement, subject to the Panel's authority to determine otherwise, having regard to the circumstances. The Complaint has been filed in English and the Respondent has not replied to the language of the proceeding nor filed a Response.

Having considered the Complainant's contentions and the present circumstances, the Panel grants the Complainant's request. In doing so, the Panel has taken into account the following factors:

- a) The Respondent has neither objected to the Complainant's request nor responded to the Complaint despite being notified of the same in both English and Chinese;

- b) The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner. The Complaint has already been filed in English. Since the Respondent has opted not to participate in the proceedings, there is no procedural benefit in requiring proceedings to be conducted in Chinese. Additionally, requiring so would place the burden of unnecessary translation cost to the Complainant and cause pointless delay to the proceeding; and
- c) The Panel is bilingual in both English and Chinese and could have dealt with a Response submitted in Chinese.

The Panel determines that English shall be the language of the proceeding.

6.2 Discussion

The Complainant must establish that the circumstances fall within the three limbs of paragraph 4(a) of the Policy to succeed in this proceeding:

- 1) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- 3) The Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

In view of International trademark registrations 906325 and 1250010, the Panel is satisfied that the Complainant has rights in the trademark FENDI. The Panel further notes that International trademark registration 906325 has been granted protection in China, where the Respondents are based. The Disputed Domain Name incorporates the trademark FENDI in its entirety, with the only difference being the addition of "9" to the Disputed Domain Name. The ".com" generic Top-Level Domain is disregarded in accordance with the established consensus of past panels as documented at section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel is of the view that the addition of "9" to the Disputed Domain Name does not prevent a finding of confusing similarity to the trademark FENDI. The Panel holds that the first limb of paragraph 4(a) is established.

B. Rights or Legitimate Interests

The Panel notes the Complainant's assertion that the Previous Respondent is not affiliated with the Complainant and is not authorized by the Complainant to register the Disputed Domain Name incorporating the trademark FENDI. There is similarly no evidence that the Subsequent Respondent is affiliated with the Complainant or authorized to receive the transfer of the Disputed Domain Name from the Previous Respondent. The Panel also notes that there is no evidence in this proceeding to even remotely suggest that either Respondent is commonly known by the Disputed Domain Name. What is obvious in the evidence is that the Disputed Domain Name is being used to redirect visitors to gaming, gambling and pornographic content on the Internet, which the Panel does not doubt on the face to be commercially driven. As such, in the absence of any contrary evidence, the Panel does not believe that either Respondent could be making a legitimate noncommercial or fair use of the Disputed Domain Name. The Panel is of the view that the Complainant has demonstrated a *prima facie* case that the Respondents have no rights or legitimate interests in the Disputed Domain Name, which has not been rebutted in this proceeding. Accordingly, the second limb of paragraph 4(a) is also established.

C. Registered and Used in Bad Faith

In view of the trademark rights of the Complainant and the long history of the Complainant's business operations around the world and in China, where the Respondent is purportedly based, the Panel finds it

implausible that the Respondents could not have known of the trademark FENDI when the Disputed Domain Name was registered. On the contrary, the Panel believes that the Previous Respondent was fully aware of the trademark FENDI when registering the Disputed Domain Name, and the Subsequent Respondent, in taking over as registrant must be imputed with the same awareness. As the Complainant rightly pointed out, a simple effortless Internet search on the word “fendi” or even “9fendi” would have revealed the Complainant’s website and trademark FENDI.

In view of the above, a very plausible circumstance for the Respondents to register the Disputed Domain Name is that outlined in paragraph 4(b)(iv) of the Policy, which states:

“by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The Panel notes that the Disputed Domain Name resolves to a website that featured links to content clearly targeted for commercial gain. There is nothing on the website that could explain the Respondents’ selection of the Disputed Domain Name. The word “9fendi” does not even appear in the content of the website. As such, there is an inevitable inference that the incorporation of the trademark FENDI in the Disputed Domain Name must have been to further the Respondents’ intention to attract Internet users to the website resolved from the Disputed Domain Name by creating a likelihood of confusion with the trademark FENDI as to source, sponsorship, affiliation or endorsement. On the evidence, the Panel is satisfied that the circumstances fall within the form of bad faith registration and use exemplified by paragraph 4(b)(iv).

The Panel’s conclusion is further corroborated by the Previous Respondent’s shifty attempts to hide the Previous Respondent’s identity and contact particulars in disregard of the Previous Respondent’s obligations under paragraph 2 of the Policy to provide complete and accurate statements in the Registration Agreement. Not only has the Previous Respondent provided an incomplete name of just “王先生(wang xian sheng)”, which cannot genuinely be a full disclosure of the Previous Respondent’s name, the Previous Respondent has provided invalid contact details which further prevents the Previous Respondent from being traced. Similarly, the Subsequent Respondent also provided invalid contact details. The suggestions that both the Respondents wish to be untraceable for its activities via the Disputed Domain Name, and that it is collaboratively engaging in cyberflight with the new registrant for this purpose, as well as to avoid the Policy and the proceeding are too strong to be ignored.

The cyberflight in the proceeding in transferring the Disputed Domain Name to the Subsequent Respondent further corroborates the questionable interests and actions of the Respondents in relation to the Disputed Domain Name and the bad faith finding above. Paragraph 8 of the Policy provides:

“a. Transfers of a Domain Name to a New Holder. You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded; ... We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.

b. Changing Registrars. You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.”

The Previous Respondent has clearly engaged in cyberflight and in allowing this, the Registrar seems to have breached paragraph 8(a) of the Policy in transferring the Disputed Domain Name to the new registrant while the proceeding is pending. Paragraph 8(b) also prohibits the Previous Respondent from changing registrars while the proceeding is pending save for the narrow permissible situation where there is a pending court action or arbitration, provided the Disputed Domain Name shall remain subject to the proceeding. There is no evidence before this Panel to suggest that there is a pending court action or arbitration in relation to the Disputed Domain Name permitting the change of Registrars. As such, on the face of the evidence, the Previous Respondent has also caused a breach of paragraph 8(b) of the Policy in requesting the Registrar to be changed to the new Registrar Dynadot LLC. Similarly, the new registrant, in engaging Dynadot LLC as Registrar, would have also caused a breach of paragraph 8(b) of the Policy.

It is clear from the literal words of paragraph 8(b) that even if there were a permissible change in Registrar during a pending court action or arbitration, the Disputed Domain Name remains subject to this proceeding. By implication, it must be the case that the Disputed Domain Name should also remain subject to this proceeding in the event of any non-permissible change in Registrar. Any other reading of paragraph 8(b) would not make sense. Therefore, the Panel holds that the Disputed Domain Name self-evidently continues to be subject to this proceeding. The Previous Respondent's non-permissible change of Registrar, the Previous Respondent's act of transferring the Disputed Domain Name, the Subsequent Respondent's act of receiving the transfer, and the changing of Registrars all go towards reinforcing the conclusion of bad faith registration and use of the Disputed Domain Name.

In the circumstances, the Panel holds that the Disputed Domain Name has been registered and is being used in bad faith and the third limb of paragraph 4(a) is also 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 Name, <9fendi.com>, be transferred to the Complainant.

/Kar Liang Soh/

Kar Liang Soh

Sole Panelist

Date: August 15, 2022