

ADMINISTRATIVE PANEL DECISION

Gianni Versace S.r.l. v. Eng.Tamer Maher Eldebes, Royalways Roads Contracting L.L.C.
Case No. D2022-2159

1. The Parties

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

The Respondent is Eng.Tamer Maher Eldebes, Royalways Roads Contracting L.L.C., United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <versacecafe.com> (“Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 14, 2022. On June 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 15, 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 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 Respondent of the Complaint, and the proceedings commenced on June 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 7, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on July 15, 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.

4. Factual Background

The Complainant is an Italian fashion and luxury goods company founded in 1978 by the stylist Gianni Versace, specializing in fashion, accessories, jewelry, watches, eyewear, fragrances and home furnishings. Since 2000, its VERSACE brand has also been used for hospitality services. The Complainant operates numerous websites under the VERSACE brand including its primary portal at “www.versace.com”.

The Complainant is the owner of trade marks in various jurisdictions consisting of the word “Versace” (the “VERSACE Mark”), including a United Arab Emirates registration for the VERSACE Mark (Registration No. 50946, registered on January 31, 2005) for goods in class 18.

The Domain Name was registered on July 16, 2012. Since then the Domain Name has either been inactive, or has resolved to a website offering pay-per-click (“PPC”) advertisements that refer to the Complainant and its competitors. Over the last seven years, the Respondent has made various offers to sell the Domain Name to the Complainant, all of which were for sums that *prima facie* were larger (and in some cases vastly larger) than any likely out-of-pocket costs directly related to the Respondent’s registration of the Domain Name.

5. Parties’ Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainant’s VERSACE Mark;
- (ii) that the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the VERSACE Mark, having registered the VERSACE Mark in the European Union, United Arab Emirates and other locations around the globe. The Domain Name is confusingly similar to the VERSACE Mark, wholly incorporating the VERSACE Mark and adding the descriptive word “cafe”.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the VERSACE Mark nor is the Respondent commonly known by the Domain Name. The Respondent does not use the Domain Name for a *bona fide* purpose or legitimate noncommercial purpose. Indeed the Domain Name does not presently resolve to an active webpage and previously resolved to a website with PPC links. In addition, the Respondent has, multiple times, offered the Domain Name for sale for significant sums. Such use of the Domain Name cannot and does not constitute *bona fide* commercial use, sufficient to legitimize any rights and interests the Respondent might have in the Domain Name and therefore the Respondent has no rights or legitimate interests in the Domain Name under paragraph 4(a)(ii) of the Policy.

The Respondent has registered and uses the Domain Name in bad faith. There is no plausible circumstance under which the Respondent could legitimately use the Domain Name, which combines the VERSACE Mark and the descriptive term “cafe”, other than in bad faith. Based on the Respondent’s repeated offers to sell the Domain Name either to the third parties or to the Complainant, the only possible motive held by the Respondent in registering the Domain Name was for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the Complainant or to a competitor of that the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the Domain Name.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

To prove this element, the Complainant must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the VERSACE Mark, having a valid registration for the VERSACE Mark as a trade mark, *inter alia*, in the United Arab Emirates.

The Domain Name incorporates the VERSACE Mark in its entirety with the addition of the word "cafe". Other UDRP panels have repeatedly held that where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element; see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Domain Name is confusingly similar to the Complainant's VERSACE Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant may make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If such a *prima facie* case is made out, the respondent then has the burden of demonstrating rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii) [of the Policy]:

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

(iii) you are making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue."

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the VERSACE Mark or a mark similar to the VERSACE Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name.

There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial fair use or a *bona fide* offering of goods or services. Simply holding the Domain Name and making various offers to sell the Domain Name for multiple sums

greater than out-of-pocket costs does not, in the absence of other evidence, amount to use for a *bona fide* offering of goods or services. Nor does the use of the Domain name for a parking page with PPC links unrelated to a dictionary meaning of the Domain Name. The Panel notes the statements in the [WIPO Overview 3.0](#) on the question of whether “parked” pages comprising PPC links support the Respondent’s rights or legitimate interests. The [WIPO Overview 3.0](#) notes under section 2.9 that:

“Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.

Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant’s (or its competitor’s) trademark.”

Moreover, in the instance of this proceeding, some of the links (*e.g.*, “Gucci Eyewear”) resolve Internet users to “eyewear products” in direct competition with Complainant, illustrating the intent of Respondent to use the Domain Name to capitalize on the reputation and goodwill associated with Complainant’s VERSACE Mark.

In the present case, the use of the Complainant’s VERSACE Mark in the Domain Name has no inherent meaning and hence the Respondent’s use of the confusingly similar Domain Name to host a parking page with PPC links does not, absent any further explanation, provide the Respondent with rights or legitimate interests in the Domain Name.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has chosen not to respond to the Complaint and thus has failed to provide any evidence of rights or legitimate interests in the Domain Name. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the Domain Name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registrations to the Complainant who is the owner of the trade mark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or
- (ii) the Respondent has registered the Domain Name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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.

The Domain Name was registered well after the VERSACE Mark was first used and registered. The Panel finds, on the balance of probabilities, that the Respondent would have been aware of the Complainant and its reputation in the VERSACE Mark at the time the Respondent registered the Domain Name. There is no obvious reason, nor has the Respondent offered an explanation, for the Respondent to register a domain name incorporating the VERSACE Mark unless, as suggested by the Complainant and not denied by the Respondent, there was an intention to create a likelihood of confusion between the Domain Name and the VERSACE Mark.

In the 10 years since the registration of the Domain Name, the Domain Name has been either inactive or used for a parking page with PPC links for which the Respondent might have received some commercial gain. In these circumstances where the Respondent has offered no plausible explanation for the registration of the Domain Name, the Panel finds that the Respondent is using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the VERSACE Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. As such the Panel finds that the Domain Name is being used in bad faith pursuant to 4(b)(iv) of the Policy.

Furthermore, since 2015 the Respondent has made a series of offers to sell the Domain Name to the Complainant for significant sums far greater than any out-of-pocket costs. The existence of those offers, along with the lack of any evidence supporting any other explanations as to the possible (legitimate) use of the Domain Name leads the Panel to conclude that the Respondent registered the Domain Name for the purpose of selling it for an amount in excess of its out-of-pocket costs. Pursuant to 4(b)(i) of the Policy the Respondent has registered and used the Domain Name in bad faith.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) 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 Domain Name <versacecafe.com> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: July 19, 2022