

ADMINISTRATIVE PANEL DECISION

Fiorucci Holdings Limited v. Whois Agent, Domain Protection Services, Inc. /
Bqoplu Ygdue
Case No. D2022-2542

1. The Parties

The Complainant is Fiorucci Holdings Limited, United Kingdom, represented by Bird & Bird LLP, United Kingdom.

The Respondent is Whois Agent, Domain Protection Services, Inc., United States of America ("U.S.") / Bqoplu Ygdue, Hong Kong, China.

2. The Domain Names and Registrars

The disputed domain names <fioruccisale.com> and <fiorucciwomen.com> are registered with Name.com, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 12, 2022. On July 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on July 20, 2022 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 on July 25, 2022.

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 Respondent of the Complaint, and the proceedings commenced on July 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 18, 2022.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on August 23, 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 Fiorucci Holdings Limited, the Italian fashion company established in 1967. Its product range includes clothing, footwear and accessories, sold under the FIORUCCI brand. In addition to its flagship store in London, United Kingdom, the Complainant's goods are sold through various retailers in different countries, including online retailers.

The Complainant owns an extensive international portfolio of trademark registrations for FIORUCCI, in over 80 jurisdictions, including the following:

- European Union Registration No. 14755573 for FIORUCCI, registered on March, 31, 2020;
- European Union Registration No. 367250, for FIORUCCI, registered on February 2, 2001;
- United Kingdom Registration No. 1119863 for FIORUCCI, registered on August 30, 1979;
- U.S. Registration No. 1264655 for FIORUCCI, registered on January 24, 1984.

The Complainant also owns a number of domain names, including "www.fiorucci.com", created on May 13, 2002, which resolves to the Complainant's website, through which the Complainant operates an online store that sells and offers its authentic FIORUCCI branded products.

The disputed domain names were registered on February 12, 2022 and resolve to websites which purport to offer for sale clothing, footwear and accessories under the Complainant's trademarks.

5. Parties' Contentions

A. Complainant

The Complainant initially informs that the Respondent used a privacy protection organization for the registration of the disputed domain names.

The Complainant argues that the disputed domain names are intended to imitate and take advantage of the Complainant's FIORUCCI marks since they are identical, except for the descriptive words "sale" and "women," which are commonly used in the fashion industry and can only serve to reinforce the connection with the Complainant's well-known marks.

Additionally, the Complainant says that the disputed domain names resolve to websites, which purportedly offer for sale clothing, footwear and accessories branded with the FIORUCCI mark, as well as the Complainant's "Angels" logo mark, which is registered in over 40 jurisdictions.

According to the Complainant, consumers will be misled into thinking that the websites corresponding to the disputed domain names are legitimate outlet sites for the Complainant's genuine FIORUCCI goods, operated by the Complainant, since they reproduce photographs, identical font and stylization and several other elements of the Complainant's official website, including the original price for each item, but significantly discounted.

Additionally, the Complainant argues that the Respondent has not been authorized to use its trademark, that it is not commonly known by the disputed domain names, and that it has no rights or legitimate interests in respect of them.

According to the Complainant, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names but is instead using them in bad faith, as they resolve to websites offering the same goods as the Complainant's and even reproducing the Complainant's website images to divert consumers for commercial gain.

The Complainant states that it attempted to carry out a purchase from the Respondent's website related to <fiorucciwomen.com> which resulted in payment being taken without an item being received. The Complainant also argues that the attempt to purchase a product from the website related to <fioruccisale.com> failed, indicating that the disputed domain names are not being used to operate a legitimate business.

Also, the Complainant mentions that the contact addresses reproduced in the websites corresponding to the disputed domain names are false and that the Respondent registered the disputed domain names in bad faith for the purpose of intentionally attempting to attract, for commercial gain, Internet users to the Respondent's websites, by creating a likelihood of confusion with the Complainant's trademark FIORUCCI.

Finally, the Complainant requests the transfer of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

As per paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

A. Identical or Confusingly Similar

The evidence demonstrates that the Complainant is the owner of trademark registrations for FIORUCCI.

The disputed domain names incorporate the Complainant's trademark FIORUCCI in its entirety. The addition of the terms "women" and "sale" does not avoid a finding of confusing similarity between the disputed domain name and the Complainant's trademark, as the Complainant's trademark is recognizable within the disputed domain names.

It is the general view among UDRP panels that the addition of other terms (whether descriptive, geographical, or otherwise) to a trademark in a domain name would not prevent a finding of confusing similarity under the first element of the UDRP. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

As numerous prior UDRP panels have also recognized, the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that a domain name is identical or confusingly similar to the complainant's mark. See section 1.7 of the [WIPO Overview 3.0](#).

The Panel finds that paragraph 4(a)(i) of the Policy has been proved by the Complainant, *i.e.*, the disputed domain names are confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

The Respondent has not submitted any response to the Complaint.

There is no evidence that the Respondent has any authorization to use the Complainant's trademark or to register domain names containing the Complainant's trademark FIORUCCI.

There is no evidence that the Respondent is commonly known by the disputed domain names.

There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain names or that before any notice of the dispute the Respondent has made use of, or demonstrable preparations to use the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services. Moreover, the terms "sale" and "women" in the disputed domain names give the idea that the disputed domain names refer to websites where the Complainant's products "can be purchased at a discounted price" and "where customers find the Complainant's items exclusively for women." Thus, the construction of the disputed domain names themselves is such to carry a risk of implied affiliation that cannot constitute fair use. See section 2.5.1, [WIPO Overview 3.0](#).

The Panel finds that the use of the disputed domain names, which incorporate the Complainant's trademark, does not correspond to a *bona fide* use of the disputed domain names under the Policy.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(ii) of the Policy has been satisfied, *i.e.*, the Respondent has no rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

The trademark FIORUCCI is registered by the Complainant in different jurisdictions (as reflected in section 4 of this Decision), these registrations predate the registration date of the disputed domain names, and the disputed domain names incorporate it in its entirety. The Respondent has no rights or legitimate interests in the disputed domain names.

The Complainant's FIORUCCI mark is distinctive and very well-known worldwide. Thus, a domain name that comprises such a mark is undoubtedly already suggestive of the registrant's bad faith.

The disputed domain names include the terms "sale" and "woman," which in this case may indeed serve as additional evidence of the registration of the disputed domain names in bad faith, considering that such terms are related to the Complainant's business activities. It is easy for a consumer to be deceived into thinking that the websites corresponding to the disputed domain names refer to a platform for discounted "FIORUCCI" products or exclusive for women, even more with the reproduction of the same images/photographs/elements from the Complainant's original website.

In addition, based on the claims, and evidence provided with the Complaint, the Panel finds that the websites related to the disputed domain names are being used in bad faith. The website related to <fiorucciwomen.com> resulted in payment being taken without an item being received. The Complainant's attempt to purchase a product from the website related to <fioruccisale.com> failed.

Finally, the Respondent has chosen not to respond to the Complainant's allegations. According to the panel's decision in *The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. [D2009-0610](#): "the failure of the Respondent to respond to the Complaint further supports an inference of bad faith."

The Respondent also used a privacy protection service to hide its identity, which also confirms bad faith registration and use.

Therefore, this Panel finds that the Respondent has intentionally attempted to cause confusion with the Complainant's trademark and that the Respondent's attempt of taking undue advantage of the trademark FIORUCCI for as described in paragraph 4(b)(iv) of the Policy has been demonstrated.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(iii) of the Policy has been satisfied, *i.e.*, the disputed domain names have been registered and are being 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 names, <fioruccisale.com> and <fiorucciwomen.com>, be transferred to the Complainant.

/Mario Soerensen Garcia/

Mario Soerensen Garcia

Sole Panelist

Date: September 2, 2022