

ADMINISTRATIVE PANEL DECISION

FENICE S.R.L. v. Ling Xie
Case No. D2022-2694

1. The Parties

The Complainant is FENICE S.R.L., Italy, represented by Gianni & Origoni, Italy.

The Respondent is Ling Xie, China.

2. The Domain Name and Registrar

The disputed domain name <chiaraferragnishop.com> is 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 22, 2022. On July 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 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 sent an email communication to the Complainant on July 26, 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 amendment to the Complaint on August 1, 2022.

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 August 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 22, 2022.

The Center appointed Marilena Comanescu 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 FENICE S.R.L., an Italian limited liability company established and led by the Italian digital businesswoman and international fashion influencer Ms. Chiara Ferragni. The Complainant, *inter alia*, manages an Internet e-commerce website named “sChiara Ferragni Brand” under the domain name <chiaraferragnibrand.com> where a wide range of fashion products branded CHIARA FERRAGNI are sold. The Complainant also owns and runs social network accounts under the name CHIARA FERRAGNI Brand.

The Complainant owns several trademark registrations for the trademark CHIARA FERRAGNI in many jurisdictions around the world, including in China where the Respondent is apparently located, such as the following:

- the European Union trademark registration number 018531590 for the word CHIARA FERRAGNI, filed on June 27, 2013, and registered on October 10, 2013, and covering goods in Nice classes 3, 9, 14, 24, 25, 26, 27; and
- the International trademark registration number 1171027 for the word CHIARA FERRAGNI, registered on May 27, 2013, and covering goods in Nice classes 3, 9, 14, 18, 24, 25, 26 and 27, designating, *inter alia*, China.

The disputed domain name <chiaraferragnishop.com> was registered in December 2021. At the time of filing the Complaint, the disputed domain name was connected to a commercial website having the same look-and-feel and color scheme as the Complainant’s e-commerce website allegedly offering products marked CHIARA FERRAGNI with significant price reductions, displaying the Complainant’s CHIARA FERRAGNI trademark, logos and product images. Further, no adequate company information about the holder of the website was available under the “contacts” and “about us” sections and there was a copyright protection claim referring to another domain name comprising the Complainant’s trademark, which does not currently exist.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its distinctive and well-known trademark CHIARA FERRAGNI, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

In view of the Respondent’s default, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the CHIARA FERRAGNI trademark.

The disputed domain name <chiaraferragnishop.com> incorporates the Complainant's CHIARA FERRAGNI trademark with an additional term, "shop". However, such addition does not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether geographical, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name does not prevent a finding of confusing similarity, where the relevant trademark is recognizable within the domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is well established in decisions under the UDRP that the Top-Level-Domain ("TLD") (e.g., ".com", ".site", ".info", ".shop") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark CHIARA FERRAGNI, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the mark CHIARA FERRAGNI, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, "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". See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case.

There is nothing in the record suggesting that the Respondent has made a *bona fide* use of the disputed domain name, or has been known by this disputed domain name, or is making any legitimate noncommercial or fair use of the disputed domain name. In fact, at the time of filing the Complaint the disputed domain name resolved to a commercial website featuring the CHIARA FERRAGNI trademark and logos and offering purportedly discounted products branded CHIARA FERRAGNI for sale.

In certain cases, Panels have recognized that resellers or service providers using a domain name containing the complainant's mark to undertake sales or repairs related to the complainant's goods and services may have a legitimate interest in such domain name. Relevant UDRP panel decisions in relation to this issue are helpfully summarized in section 2.8 of the [WIPO Overview 3.0](#) as follows:

Normally, a reseller, distributor or service provider can be making a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements normally include the actual offering of goods and services at issue, the use of the site to sell only the trademarked goods, the site's accurately and prominently disclosing the registrant's relationship with the trademark holder and the respondent not trying to "corner the market" in domain names that reflect the

trademark.

This summary is based on UDRP panel decision *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). At least one condition that is outlined has clearly not been satisfied by the Respondent in this case: at the time of filing the Complaint, on the website under the disputed domain name there was no accurate and clear information regarding the Respondent's rights and its (lack of) relationship with the Complainant and no disclaimer. Further, images of the Complainant's trademarks and official pictures were displayed without any consent from the Complainant, thus generating a likelihood of confusion for the Internet users accessing the Respondent's website and suggesting a false commercial relationship between the website under the disputed domain name and the Complainant.

In addition, and without prejudice to the above, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds registered trademark rights for CHIARA FERRAGNI since at least 2013 and, according to the evidence provided, the Panel is satisfied that the CHIARA FERRAGNI gained worldwide reputation in the fashion industry world.

The disputed domain name was created in late 2021 and incorporates the Complainant's highly distinctive mark with an additional generic term "shop".

For the above reasons, the Panel finds that the disputed domain name was registered in bad faith, with knowledge of the Complainant, its business and particularly targeting the Complainant's trademark.

The Respondent is using without permission the Complainant's well-known trademark in order to get Internet traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant. This impression is created particularly by the incorporation of the Complainant's trademark in the disputed domain name, and the content on the website provided thereunder which includes the Complainant's trademarks, logo, and images of official products.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website 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 [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's trademark and the website operated under the disputed domain name copied the look-and-feel of the Complainant's website, displays the Complainant's trademarks, logos and product images and is offering very likely counterfeit copies of the Complainant's products, indeed in this Panel's view, the Respondent intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain.

Additionally, the Respondent did not participate in the present proceedings.

It was consistently found by previous UDRP panels that the mere registration of a domain name that is identical or confusingly similar to a third party's well-known trademark constitutes, by itself, a presumption of

bad faith registration for the purpose of Policy. See section 3.1.4 of the [WIPO Overview 3.0](#).

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 <chiaraferagnishop.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: August 30, 2022