

ADMINISTRATIVE PANEL DECISION

Gianni Versace S.r.l. v. Domain Administrator, See PrivacyGuardian.org /
Daniel Valverde
Case No. D2022-2987

1. The Parties

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

Respondent is Domain Administrator, See PrivacyGuardian.org, United States of America (“United States”) / Daniel Valverde, United States.

2. The Domain Name and Registrar

The disputed domain name <versace.dev> (the “Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 12, 2022. On August 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 12, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details for the Domain Name.

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 Respondent of the Complaint, and the proceedings commenced on August 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on September 12, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on September 16, 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

Complainant is an Italian limited liability company founded in 1978 in Milan, Italy, by the stylist Gianni Versace. It is one of the leading international fashion companies. It designs, manufactures, distributes and retails fashion and lifestyle products including haute couture, prêt-à-porter, accessories, jewellery, watches, eyewear, fragrances, and home furnishings, under the VERSACE trademark. Complainant's Group distributes its products through a world-wide network, including over 200 boutiques in the principal cities and over 1500 wholesalers worldwide. Complainant has been using the trademark VERSACE for over forty years and the trademark VERSACE has been also consistently used in most of the countries in the world.

Complainant has had a wide group of celebrities and models supporting its brand as well as wearing its clothing and accessories, such as Carolyn Murphy, Angela Lindvall, Daria Werbowy, Christy Turlington, Kate Moss. Complainant was also one of the first designers to link the music industry to the fashion industry (for instance, dressing Elton John and Michael Jackson) and designed clothing for Diana, the former Princess of Wales, and Princess Caroline of Monaco. Complainant also directly promotes its VERSACE brand and products via Internet, in particular with a strong presence online through the most popular social media, *i.e.* on Facebook, Twitter, YouTube, Instagram, Pinterest, WeChat and Weibo.

Complainant is the owner of numerous trademark registrations for VERSACE, including:

- European Union Trademark Registration No. 001665439, VERSACE, (word mark), filed on May 18, 2000, registered on September 10, 2001, for goods and services in international 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; and

- International Trademark Registration No. 648708, VERSACE, (word mark), registered on October 6, 1995, for goods and services in international classes 3, 9, 14, 18 and 25.

Complainant has registered numerous VERSACE domain names and variations thereof in numerous gTLDs and ccTLDs, including the domain name <versace.com>, registered on March 25, 1997, which is also Complainant's primary website for the global promotion and offer for sale of its VERSACE products online.

The Domain Name was registered on July 4, 2021. Originally it lead to a static page, requesting Internet users to confirm that they are trying to access the website, without any further content, and currently leads to an inactive website. Per Complaint, email exchanger records ("MX records") for use in connection with email communication were displayed in the DNS configuration of the Domain Name.

On April 22, April 28, and July 5, 2022, Complainant sent a cease-and-desist letter to Respondent to which Respondent did not reply.

5. Parties' Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements, which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Complainant has demonstrated rights through registration and use on the VERSACE trademark.

The Panel finds that the Domain Name is identical to the VERSACE trademark of Complainant.

The generic Top-Level Domain (“gTLD”) “.dev” is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons only (*Rexel Developments SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#)).

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, Respondent’s 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) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Name, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per Complainant, Respondent was not authorized to register the Domain Name.

Prior to the notice of the present proceeding, Respondent did not demonstrate any use of the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name resolved to an inactive page, while MX records have been configured on the Domain Name.

In addition, the Domain Name consists entirely of Complainant's mark and thus carries a high risk of implied affiliation (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.5.1).

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation, are evidence of the registration and use of the Domain Name in bad faith;

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or

(ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith.

Because the VERSACE mark had been widely used and registered by Complainant before the Domain Name registration and enjoyed reputation as repeatedly recognised (e.g. *Gianni Versace S.P.A. v. Nicolino Colonnelli - Europol SRL*, WIPO Case No. [D2008-0570](#); and *Gianni Versace S.r.l. v. Xiulin Wang aka Wangxiulin*, WIPO Case No. [D2020-0539](#)), the Panel finds it more likely than not that Respondent had Complainant's mark in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); and *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

Respondent should have known about Complainant's rights, as such knowledge is readily obtainable through a simple browser search and by virtue of the nature of Complainant's business, namely online travel information and search engine (See *Caesars World, Inc. v. Forum LLC*, WIPO Case No. [D2005-0517](#); and *Compart AG v. Compart.com / Vertical Axis Inc.*, WIPO Case No. [D2009-0462](#)).

Furthermore, Respondent could have conducted a trademark search and would have found Complainant's prior registrations in respect of VERSACE (*Citrix Online LLC v. Ramalinga Reddy Sanikommu Venkata*, WIPO Case No. [D2012-1338](#)).

The Domain Name currently leads to an inactive website. The non-use of a domain name would not prevent a finding of bad faith (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and [WIPO Overview 3.0](#), section 3.3). Furthermore, MX records for use in connection with email communication were displayed in the DNS configuration of the Domain Name. The presence of MX

records suggests the possible use of the Domain Name in connection with the receipt as well as the sending of emails from email addresses based on the Domain Name

Furthermore, Respondent has been involved as named respondent in a number of UDRP cases, such as *Compagnie Générale des Etablissements Michelin v. See PrivacyGuardian.org / Daniel Valverde*, WIPO Case No. [D2022-1163](#); *Monster Energy Company v. Daniel Valverde*, WIPO Case No. [D2021-2309](#), and *Monster Energy Company v. See PrivacyGuardian.org / Daniel Valverde*, WIPO Case No. [D2021-2308](#).

Under these circumstances and on this record, the Panel finds that Respondent registered and used the Domain Name in bad faith.

Complainant has established 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 Domain Name <versace.dev> be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: September 30, 2022