

ADMINISTRATIVE PANEL DECISION

Prada S.A. v. Client Care, Web Commerce Communications Limited
Case No. D2022-4776

1. The Parties

The Complainant is Prada S.A., Luxembourg, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <miumiudanmark.com>, <miumiufactoryoutlet.com>, <miumiugreece.com>, <miumiuindonesia.com>, <miumiuireland.com>, <miumiumalaysia.com>, <miumiunederlandoutlet.com>, <miumiuoutletfactory.com>, <miumiuoutletitalia.com>, <miumiuphilippines.com>, <miumiuportugal.com>, <miumiuschweiz.com>, <miumiusingaporeoutlet.com>, <miumiusuomi.com>, <miumiuuae.com>, <miumiuussale.com>, <pradabelgium.com>, <prada-chile.com>, <pradagermany.com>, <pradagreece.com>, <pradaindonesia.com>, <pradaireland.com>, <pradamalaysiaoutlet.com>, <pradanederland.com>, <prada-nz.com>, <pradaoutletcanada.com>, <pradaphilippines.com>, <pradaportugal.com>, <prada-schweiz.com>, <prada-suomi.com>, <prada-turkey.com>, and <pradauae.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 13, 2022. On December 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 15, 2023, 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 December 15, 2023, 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 December 16, 2023.

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 December 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 11, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on January 19, 2023. 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 Prada S.A., the owner of trademark registrations across various jurisdictions for the famous fashion brands PRADA and MIU MIU, including the PRADA United States of America Trademark Registration number 1264243, registered on January 17, 1984; and the MIU MIU Malaysia Trademark Registration number 93000242, registered on October 18, 1995.

The Complainant is also the owner of several domain names incorporating the trademarks MIU MIU and PRADA, such as <prada.com> and <miumiu.com>, respectively registered on June 9 and November 9, 1997.

The Respondent registered the disputed domain names <pradagermany.com>, <pradaindonesia.com>, <pradairland.com>, <pradamalaysiaoutlet.com>, <pradaphilippines.com>, and <pradauae.com> on March 17, 2022; the disputed domain name <prada-chile.com> on March 21, 2022; the disputed domain names <pradabelgium.com>, <prada-greece.com>, <prada-nederland.com>, <prada-portugal.com>, <prada-schweiz.com>, <prada-suomi.com>, and <prada-turkey.com> on March 24, 2022; the disputed domain names <miumiudanmark.com>, <miumiufactoryoutlet.com>, <miumiugreece.com>, <miumiuidonesia.com>, <miumiuireland.com>, <miumiumalaysia.com>, <miumiunederlandoutlet.com>, <miumiuoutletfactory.com>, <miumiuoutletitalia.com>, <miumiuphilippines.com>, <miumiuportugal.com>, <miumiuschweiz.com>, <miumiusingaporeoutlet.com>, <miumiusuomi.com>, <miumiuuae.com>, and <miumiuussale.com> on April 7, 2022; the disputed domain name <prada-nz.com> on April 14, 2022; and the disputed domain name <pradaoutletcanada.com> on May 5, 2022.

The Panel accessed the disputed domain names on January 26, 2023, at which time the disputed domain names were pointing to commercial websites respectively reproducing the Complainant's PRADA and MIU MIU trademarks and copyrighted logos to offer for sale products under such brands.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) The disputed domain names are identical or confusingly similar to the Complainant's trademark.

The Complainant is the owner of PRADA and MIU MIU trademarks. Where a complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. The disputed domain names capture, in its entirety, the Complainant's PRADA and MIU MIU trademarks and simply add to the trademarks a variety of geographical terms such as "Malaysia", "Ireland", "Belgium", "Chile" and dictionary terms related to the Complainant's industry such as "outlet" and "factory". The mere addition of these generic terms to the Complainant's trademarks does not negate the confusing similarity between the disputed domain names and the Complainant's trademarks under Policy 4(a)(i), and the disputed domain names must be considered

confusingly similar to each of the Complainant's trademarks. Additionally, the Respondent's use of the disputed domain names contributes to the confusion, considering the disputed domain names are linked to websites respectively featuring the Complainant's PRADA and MIU MIU trademarks and copyrighted logos whilst offering for sale PRADA and MIU MIU branded items.

(ii) The Respondent has no legitimate interests in the disputed domain names.

The Respondent is not sponsored by or affiliated with the Complainant in any way and the Complainant has not licensed, authorized, or permitted the Respondent to register the disputed domain names incorporating the Complainant's trademarks. The Respondent is not commonly known by the disputed domain names. The Respondent is not making a *bona fide* offering of goods or services or legitimate, noncommercial fair use of the disputed domain names. The Respondent's inclusion of the Complainant's PRADA and MIU MIU copyrighted logos on the disputed domain names' websites is a direct effort to take advantage of the fame and goodwill that the Complainant has built in its brands. Furthermore, the Respondent is using the disputed domain names in connection with commercial websites which offer and attempt to sell products branded with the PRADA and MIU MIU trademarks. The Respondent is not an authorized reseller of the Complainant's products and the products offered for sale at the disputed domain names look to be counterfeits.

(iii) The Respondent registered and is using the disputed domain names in bad faith.

The Complainant and its PRADA and MIU MIU trademarks are known internationally, with trademark registrations across numerous countries including in Malaysia where the Respondent is located. The Complainant has marketed and sold its goods and services using its trademark since 1913, which is well before the Respondent's registration of the disputed domain names. By registering 32 total disputed domain names that incorporate the Complainant's well-known PRADA and MIU MIU trademarks, the Respondent has created the disputed domain names that are confusingly similar to the Complainant's trademark, as well as its <prada.com> and <miumiu.com> domain names. As such, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. It is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brands at the time the disputed domain names were registered. The terms "prada" and "miu miu" are so closely linked and associated with the Complainant that the Respondent's use of this mark, or any minor variation of it, strongly implies bad faith – where a domain name is so obviously connected with such a well-known name and products, its very use by someone with no connection with the products suggests opportunistic bad faith. The Respondent seeks to create a likelihood of confusion with the Complainant and its trademarks by using the disputed domain names in connection with commercial websites, which prominently feature the PRADA and MIU MIU trademarks and logos, with the Respondent then attempting to profit from such confusion by offering for sale products branded with the Complainant's PRADA and MIU MIU trademarks which, at best, are the Complainant's own products and at worst, are counterfeits. The impression given by the disputed domain names and their websites would cause consumers to believe the Respondent is somehow associated with the Complainant when, in fact, it is not. The Respondent is using the fame of the Complainant's trademarks to improperly increase traffic to the websites listed at the disputed domain names for the Respondent's own commercial gain. The Respondent's use of the disputed domain names constitutes a disruption of the Complainant's business. The sheer number of disputed domain names registered by the Respondent demonstrates that the Respondent is engaging in a pattern of cybersquatting, which is evidence of bad faith registration and use. The Respondent has also previously been involved in a number of UDRP cases. Finally, on balance of the facts set forth above, it is more likely than not that the Respondent knew of and targeted the Complainant's trademarks, and the Respondent should be found to have registered and used the disputed domain names in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Consolidation of domain names in one proceeding

The Complainant made a request for the consolidation of the 32 disputed domain names. The request for consolidation was not challenged by the Respondent.

Paragraph 4(f) of the Policy provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.1.

The disputed domain names were also registered with the same Registrar and are linked to websites with very similar contents.

Therefore, the Panel accepts the consolidation request for such domain names, in the present case.

6.2 Merits

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain names, the Complainant shall prove the following three elements:

- (i) The disputed domain names are 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 names; and
- (iii) The disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Panel has no doubt that "Prada" and "Miu Miu" are terms directly connected with the Complainant's famous luxury goods.

Annex 1 to the Complaint shows registrations for PRADA and MIU MIU trademarks owned by the Complainant in different jurisdictions of the world since at least 1984 and 1995, respectively.

The trademarks PRADA or MIU MIU are wholly encompassed within the disputed domain names.

The disputed domain names differ from the Complainant's trademarks basically by the addition of the following terms to the trademark PRADA: "belgium", "-chile", "germany", "-greece", "indonesia", "ireland", "malaysiaoutlet", "-nederland", "-nz", "outletcanada", "philippines", "-portugal", "-schweiz", "-suomi", "-turkey", "uae"; and by the addition of the following terms to the trademark MIU MIU: "danmark", "factoryoutlet", "greece", "indonesia", "ireland", "malaysia", "nederlandoutlet", "outletfactory", "outletitalia", "philippines", "portugal", "schweiz", "singaporeoutlet", "suomi", "uae", "ussale", as well as of the generic Top-Level Domain ("gTLD") ".com".

Previous UDRP decisions have found that additions (such as "belgium", "chile", "germany", "greece", "indonesia", "ireland", "malaysiaoutlet", "nederland", "nz", "outletcanada", "philippines", "portugal", "schweiz", "suomi", "turkey", "uae", "danmark", "factoryoutlet", "malaysia", "nederlandoutlet", "outletfactory", "outletitalia", "singaporeoutlet" and "ussale") to a trademark in a domain name, does not prevent confusing similarity. This has been held in many UDRP cases (see, e.g., [WIPO Overview 3.0](#), section 1.8, and the cases cited therein).

It is also already well established that the addition of a gTLD extension such as ".com" is irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds the disputed domain names to be confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate a right or legitimate interest in a domain name:

- (i) Before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) The respondent has been commonly known by the domain name; or
- (iii) The 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 at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain names.

The Complainant has not licensed nor authorized the use of its trademark to the Respondent, and the Panel finds no indication that the Respondent is commonly known by the disputed domain names.

MIU MIU and PRADA are famous trademarks worldwide.

The Respondent has not indicated any reason to justify why it has chosen such well known trademarks to compose the 32 disputed domain names, together with merely descriptive / geographical additions, and pointing to websites that reproduce the Complainant's brands and logos in an alleged offering of the Complainant's good for sale, but yielding no information as to the website's affiliation (or lack thereof) to the Complainant. Evidently, the disputed domain names were intentionally constructed with the intent to run a risk of implied affiliation to the Complainant, which is compounded by the impersonating nature of the content found at the disputed domain names, all of which cannot confer rights or legitimate interests upon the Respondent.

Therefore, the use of the Complainant's trademarks in the context of the disputed domain names cannot qualify as a *bona fide* offering of services.

Consequently, the Panel is satisfied that the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) The respondent 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 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 its website or location or of a product or service on its website or location.

When the disputed domain names were registered by the Respondent in 2022, the terms "Prada" and "Miu Miu" were already well known for decades and directly connected to the Complainant.

The disputed domain names encompass the previously registered trademarks PRADA and MIU MIU.

According to [WIPO Overview 3.0](#), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Actually, the Panel considers that in the present case the addition to the Complainant's trademarks of descriptive terms related to the fashion market (such as "outlet" or "factory outlet") or of country names or abbreviations does not prevent the confusion, suggesting that the disputed domain names refer to official online stores of the Complainant.

This circumstance is emphasized by the fact that the websites linked to the disputed domain names present reproductions of the Complainant's trademarks and logos, allegedly offering for sale goods under the PRADA or MIU MIU brands without authorization.

Also, the fact that other previous UDRP cases were already filed against the Respondent and – especially – that the Respondent registered 32 domain names incorporating the Complainant's worldwide famous trademarks in less than three months indicate that the Respondent is engaging in a pattern of cybersquatting, which is further evidence of bad faith registration and use. See, e.g., *Calvin Klein Trademark Trust and Calvin Klein Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-2697](#); *Reebok International Limited v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-2523](#).

Accordingly, the Panel finds that the disputed domain names were registered and are being used in bad faith, and the Complainant has also satisfied the third element 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 disputed domain names <miumiudanmark.com>, <miumiufactoryoutlet.com>, <miumiugreece.com>, <miumiuidonesia.com>, <miumiuireland.com>, <miumiumalaysia.com>, <miumiunederlandoutlet.com>, <miumiuoutletfactory.com>, <miumiuoutletitalia.com>, <miumiuphilippines.com>, <miumiuportugal.com>, <miumiuschweiz.com>, <miumiusingaporeoutlet.com>, <miumiusuomi.com>, <miumiuuae.com>, <miumiuussale.com>, <pradabelgium.com>, <prada-chile.com>, <pradagermany.com>, <prada-greece.com>, <pradaindonesia.com>, <pradaireland.com>, <pradamalaysiaoutlet.com>, <prada-nederland.com>, <prada-nz.com>, <pradaoutletcanada.com>, <pradaphilippines.com>, <prada-portugal.com>, <prada-schweiz.com>, <prada-suomi.com>, <prada-turkey.com>, and <pradauae.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: February 2, 2023