

ADMINISTRATIVE PANEL DECISION

Fiorucci Holdings Limited v. 杨智超 (Zhi Chao Yang)
Case No. D2022-4839

1. The Parties

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

The Respondent is 杨智超 (Zhi Chao Yang), China.

2. The Domain Names and Registrars

The disputed domain names <comfiorucci.com>, <diorucci.com>, <ffiorucci.com>, <fiorucci.com>, <fiirucci.com>, <fioeucci.com>, <fioorucci.com>, <fiorcuci.com>, <fiorrucci.com>, <fioruccci.com>, <fioruccii.com>, <fioruccl.com>, <fiorucco.com>, <fioruccu.com>, <fiorucic.com>, <fiorucvi.com>, <fioruxci.com>, <fioruucci.com>, <fioruvci.com>, <fioruxci.com>, <fiorycci.com>, <fiotuucci.com>, <fiourcci.com>, <fiprucci.com>, <fiouucci.com>, <fi0rucci.com>, <foiruucci.com>, <fooruucci.com>, <foruucci.com>, <fuoruucci.com>, <ioruucci.com>, and <myfiorucci.com> are registered with eName Technology Co., Ltd. (the "Registrar").

The disputed domain names <fiorcci.com>, <fiorucc.com>, <fioucci.com>, and <firuucci.com> are registered with Chengdu West Dimension Digital Technology Co., Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on December 16, 2022. On December 19, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On December 20, 2022, the Registrars transmitted by email to the Center their 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 27, 2022, providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on December 30, 2022.

On December 27, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On December 30, 2022, the Complainant submitted its

request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on January 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 26, 2023.

The Center appointed Rachel Tan as the sole panelist in this matter on February 10, 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 an Italian fashion brand established in 1967. The Complainant’s product range includes clothing, footwear, and accessories which are sold under the “FIORUCCI” brand.

The Complainant is the owner of the FIORUCCI mark in a range of jurisdictions, including China Trade Mark Registration No. 136498, registered on April 5, 1980, in class 25; European Union Trade Mark Registration No. 014755573, registered on March 31, 2020, in classes 9, 16, 18, 25, 35, and 41; and United Kingdom Trade Mark Registration No. UK00001119863, registered on August 30, 1979, in class 25.

The Complainant is also the owner of <fiorucci.com>.

The Respondent is 杨智超 (Zhi Chao Yang), China.

The disputed domain names were registered on different dates between January to May 2022. The disputed domain names <fiorcci.com>, <fioucci.com>, and <firucci.com> expired on February 10, 2023 and were not renewed. The disputed domain name <fiorucc.com> was set to expire on January 26, 2023, however, at the date of this Decision, this disputed domain name remains active (*i.e.*, did not expire) and according to the Whois information, its current expiry date is January 26, 2024.

Apart from the disputed domain names <fiorcci.com>, <fioucci.com>, and <firucci.com>, all other disputed domain names in this Complaint resolve to active pay-per-click (“PPC”) webpages that list out multiple third-party links related to contents such as “Off White T Shirt”, “Off White shirt”, and “Designer T Shirts”.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain names are identical or confusingly similar to the FIORUCCI mark. The disputed domain names are typosquatting domain names which correspond to the FIORUCCI mark. These minor typographical differences are insufficient to distinguish between the disputed domain names and the FIORUCCI mark.

The Complainant further alleges that the Respondent is not known by any of the disputed domain names, nor does it hold any trade mark or intellectual property rights in the FIORUCCI mark. The Complainant has not authorised, licensed, approved, or otherwise permitted the Respondent to register or use the disputed

domain names, the FIORUCCI mark, or to operate the Respondent's websites in any capacity. The Respondent's use of the disputed domain names to redirect consumers away from the Complainant's website to websites of the Complainant's competitors is not legitimate or fair use.

The Complainant finally asserts that the Respondent must have been aware that in registering the disputed domain names and using them to redirect consumers to third party websites offering identical goods and services to those protected under the FIORUCCI mark, it was misappropriating the valuable intellectual property of the Complainant. The Respondent's pattern of registering disputed domain names which are confusingly similar to the FIORUCCI mark and the Complainant's domain name provides clear evidence that the Respondent must have known that it was misappropriating the Complainant's FIORUCCI mark. The Respondent's websites, which present links to the websites of the Complainant's competitors, constitute evidence of the Respondent's bad faith. The Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the FIORUCCI mark. The Respondent has also engaged in a pattern of typosquatting and bad faith conduct.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Initially, the Panel must address the language of the proceeding. Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The Panel may choose to write a decision in either language, or request translation of either party's submissions.

In this case, the Registrars have confirmed to the Center that the language of the Registration Agreements as used by the registrant for the disputed domain names is Chinese. However, the Complainant has requested that English be adopted as the language of the proceeding for the reasons summarized below:

- (a) the disputed domain names are all registered in Latin characters, rather than Chinese characters;
- (b) the disputed domain names all resolve to the Respondent's websites with content and commercial links in English;
- (c) the Registrar, eName Technology Co., Ltd.'s Registration Agreement is in English, which concerns majority of the disputed domain names in this Complaint;
- (d) both Registration Agreements refer to ICANN's Dispute Resolution Policy which is in English;
- (e) English is the language most widely used in international relations;
- (f) the Complainant is located in the United Kingdom and has no knowledge of Chinese;
- (g) in order to proceed in Chinese, the Complainant would need to retain specialised translation services at a cost very likely to be higher than the overall cost of these proceedings and the proceedings would be delayed, which is directly at odds with stated objectives of the UDRP that proceedings be conducted in a timely and cost-effective manner; and
- (h) the Respondent is a serial offender.

It is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding. The Panel has considered the above circumstances, and finds that English shall be the language of this proceeding. The reasons are set out below:

- (a) the Complainant is a company based in the United Kingdom. Requiring the Complainant to submit documents in Chinese would lead to delay and cause the Complainant to incur translation expenses;
- (b) the Respondent's choice of English letters for the disputed domain names and the websites with links in English which the disputed domain names resolve to indicate that the Respondent is familiar with the English language;
- (c) even if the Respondent does not possess a sufficient command of English to understand the Complaint, there were ample opportunities for the Respondent to raise an objection. The Center notified the Parties in English and Chinese of the Complainant's request for English to be the language of the proceeding, but the Respondent did not protest against this request;
- (d) the Respondent has failed to participate in the proceeding even though the Center sent the notification of the Complaint in English and Chinese, and has been notified of his/her default; and
- (e) the Complaint has been submitted in English. No foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

6.2 Preliminary Issue: Domain Names Expiry

The disputed domain names <fiorcci.com>, <fioucci.com>, and <firucci.com> have an expiry date of February 10, 2023, and seem not to have been renewed by the Complainant (as invited by the Center). Prior to that they had been placed on Registrar lock status by the concerned Registrar. The disputed domain name <fiorucc.com> was also set to expire on January 26, 2023. However, at the date of this Decision, these disputed domain names remain active (*i.e.*, did not fully expire) according to the WHOIS information.

By email of December 27, 2022, the Center notified the Parties of the concerned Registrar's indication that "The domain name(s) has (have) been placed on registrar lock and will remain so during the course of these proceedings. However, after expiration, if the domain name(s) has (have) not been renewed or restored per applicable domain life cycle, it (they) will be deleted". The Center also notified the Parties that "the Center accepts no responsibility for the consequences if the necessary steps to ensure the renewal of the disputed domain names are not taken. Such consequences may include the deemed withdrawal of non-renewed expired or deleted domain names from the Complaint, or the dismissal (at the sole discretion of a Panel to be appointed) of the Complaint in relation to those domain names".

On January 17, 2023, the Complainant notified the Center that in the event that the disputed domain names <fioucci.com>, <firucci.com>, and <fiorcci.com> expire on February 10, 2023, and/or that the disputed domain name <fiorucc.com> expires on January 26 2023, the Complainant requested that these disputed domain names be deemed withdrawn from the Complaint rather than the Complaint being dismissed in relation to these disputed domain names. However, if any or all of these four disputed domain names are renewed, the Complainant wished to maintain the Complaint against these disputed domain names.

Paragraph 3.7.5.7 of the Expired Domain Deletion Policy (EDDP) states that, "In the event that a domain which is the subject of a UDRP dispute is deleted or expires during the course of the dispute, the complainant in the UDRP dispute will have the option to renew or restore the name under the same commercial terms as the registrant. If the complainant renews or restores the name, the name will be placed

in Registrar HOLD and Registrar LOCK status, the Whois contact information for the registrant will be removed, and the Whois entry will indicate that the name is subject to dispute. If the complaint is terminated, or the UDRP dispute finds against the complainant, the name will be deleted within 45 days. The registrant retains the right under the existing redemption grace period provisions to recover the name at any time during the Redemption Grace Period, and retains the right to renew the name before it is deleted.”

The Panel notes that the Complainant requested that the expired disputed domain names be deemed withdrawn from the Complaint. In this regard, and as the disputed domain names have not yet fully expired, the Panel will continue to further process the Complaint regarding all the disputed domain names.

6.3 Analysis of the Complaint

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has adduced evidence to demonstrate its established rights in the FIORUCCI mark, and that the disputed domain names are confusingly similar to the Complainant’s mark.

The Panel also notes that many of the disputed domain names are misspellings of the FIORUCCI mark. In cases where a domain name consists of a common, obvious, or intentional misspelling of a trade mark, the domain name will normally be considered confusingly similar to the relevant mark for purposes of UDRP standing. See section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”); *Mediarex Enterprises Limited v. Yong Woon Chin, Webolutions*, WIPO Case No. [DCO2020-0014](#).

Lastly, it is permissible for the Panel to disregard the Top-Level Domain in the disputed domain names, *i.e.*, “.com”. See section 1.11.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s FIORUCCI mark. Accordingly, the Complainant has satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

In circumstances where the Complainant possesses exclusive rights to the FIORUCCI mark, whereas the Respondent seems to have no trade mark rights, and considering the facts and arguments set out above, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, and the burden of production shifts to the Respondent. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not provided evidence of a legitimate or fair use of the disputed domain names or reasons to justify the choice of the disputed domain names that are confusingly similar to the Complainant’s FIORUCCI mark. Further, there is no indication to show that the Respondent is commonly known by the disputed domain names or otherwise has rights or legitimate interests in any of them. In addition, the Complainant has not granted the Respondent a license or authorisation to use the Complainant’s FIORUCCI mark or register the disputed domain names. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain names in the terms of paragraph 4(c)(iii) of the Policy since the disputed domain names resolve to PPC websites with links to third-party websites, which are related to or compete with the Complainant’s business. Such usage may reasonably be assumed to be commercial in its intent and effect. Prior UDRP 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 of goods or services where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users. See section 2.9 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names. Accordingly, the Panel finds that the Complainant has satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant's FIORUCCI mark has been registered across multiple jurisdictions. The disputed domain names were registered well after the registration of the Complainant's FIORUCCI mark. Through extensive use and advertising, the Complainant's FIORUCCI mark is known throughout the world. Search results using the keyword "fiorucci" on Internet search engines direct Internet users to the Complainant and its business, which indicates that an exclusive connection between the FIORUCCI mark and the Complainant has been established. Moreover, most of the disputed domain names are misspellings of the Complainant's trade mark. As such, the Respondent either knew or should have known of the Complainant's FIORUCCI mark when registering the disputed domain names, see section 3.2.2 of the [WIPO Overview 3.0](#).

Section 3.1.4 of the [WIPO Overview 3.0](#) states that "[...] mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trade mark by an unaffiliated entity can by itself create a presumption of bad faith". In this case, the disputed domain names are confusingly similar (and comprising typos) to the widely known FIORUCCI mark and were registered by the Respondent who has no relationship with the Complainant, which means that a presumption of bad faith can be created.

Section 3.5 of the [WIPO Overview 3.0](#) states that "[p]articularly with respect to 'automatically' generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links *ipso facto* vest the respondent with rights or legitimate interests)". The Panel notes that the disputed domain names resolve to parked pages comprising PPC advertising links that divert Internet users to content which are related to and competing with the Complainant's business. The Panel finds the use of confusingly similar disputed domain names to lure Internet users to competing third-party websites is evidence of bad faith. See *Sodexo v. 杨智超 (Zhi Chao Yang)*, WIPO Case No. [D2020-1171](#).

The Panel also notes that the Respondent appears to be engaged in a pattern of abusive registration having registered multiple domain names comprising third-party trade marks. The Panel finds this case is a continuation of that bad faith pattern. See *Asurion, LLC v. 杨智超 (Zhichao Yang)*, WIPO Case No. [D2021-4231](#). Moreover, in this case the Respondent has registered a long list of disputed domain names incorporating typo variations of the Complainant's mark. Such behavior constitutes evidence of bad faith registration and use as contemplated under paragraph 4(b)(ii) of the Policy.

The Respondent has kept silent in the face of the Complainant's allegations of bad faith. Taking into account these circumstances, the Panel finds that the Respondent must have known of the Complainant before registering the disputed domain names and, considering the Respondent's lack of rights or legitimate interests, and by registering and using the disputed domain names as discussed above, the Panel is led to conclude that the disputed domain names were registered and are being used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied the third element under paragraph 4(a) 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 <fioucci.com>, <firucci.com>, <fiorcci.com>, <comfiorucci.com>, <diorucci.com>, <ffiorucci.com>, <fiiorucci.com>, <fiirucci.com>, <fioeucci.com>, <fiiorucci.com>, <fiorcuci.com>, <fiorrucci.com>, <fiorucchi.com>, <fiorucc.com>, <fioruccii.com>, <fioruccl.com>, <fiorucco.com>, <fioruccu.com>, <fiorucic.com>, <fiorucvi.com>, <fiorucxi.com>, <fioruucci.com>, <fioruvci.com>, <fioruxci.com>, <fiorycci.com>, <fiotucci.com>, <fiourcci.com>, <fiprucci.com>, <firoucci.com>, <fi0rucci.com>, <foirucci.com>, <foorucci.com>, <forucci.com>, <fuorucci.com>, <iorucci.com>, and <myfiorucci.com> be transferred to the Complainant.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: February 24, 2023