

ADMINISTRATIVE PANEL DECISION

Fiorucci Holdings Limited v. shuai yang
Case No. D2023-1102

1. The Parties

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

The Respondent is shuai yang, China.

2. The Domain Name and Registrar

The disputed domain name <fiorucciiceberg.shop> (the “Disputed Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 13, 2023. On March 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 14, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Unknown / Redacted for Privacy, Dynadot Privacy Service) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 30, 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 April 3, 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 April 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 26, 2023.

The Center appointed Alvaro Loureiro Oliveira as the sole panelist in this matter on May 11, 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 Fiorucci Holdings Limited, the Italian fashion company established in 1967. Its product range includes clothing, footwear and accessories, sold under the FIORUCCI brand. The Complainant has advertised, marketed, promoted, distributed and sold such products all over the world under the trademark FIORUCCI, at least since the early 70's. In addition to its flagship store in London, United Kingdom, the Complainant's goods are sold through various retailers in different countries, including by major online retailers including Asos.com, Zalando.com and Endclothing.com.

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

- European Union Registration No. 014755573 for FIORUCCI, registered on March, 31, 2020;
- European Union Registration No. 000367250, for FIORUCCI, registered on February 20, 2001;
- United Kingdom Registration No. UK00001119863 for FIORUCCI, registered on August 30, 1979;
- United States of America Registration No. 1264655 for FIORUCCI, registered on January 24, 1984.

The Complainant enjoys significant goodwill and reputation in the FIORUCCI marks. A list of these FIORUCCI trademark registrations is provided in Annex 4 to the Complaint.

The Complainant also owns a number of domain names, including <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 Name was registered on June 28, 2022, and resolves to a website which purports to offer for sale clothing, footwear and accessories under the Complainant's trademark as well as under another brand Iceberg.

5. Parties' Contentions

A. Complainant

The Complainant states that the Disputed Domain Name is intended to imitate and take advantage of the Complainant's FIORUCCI marks since the Disputed Domain Name incorporates the entirety of this mark. In addition to the FIORUCCI mark, the Disputed Domain Name also incorporates the trademark ICEBERG which belongs to the Italian company Gilmar SpA, according to the extract from their website (Annex 5 to the Complaint). Gilmar SpA has confirmed that it has not authorized the use of the ICEBERG trademark in relation to the Disputed Domain Name, and it has no objection to the Complainant's filing against the Disputed Domain Name. The addition of another party's mark in the Disputed Domain Name, also unauthorized, does not avoid a finding of confusing similarity.

The Complainant informs that the Disputed Domain Name resolves to a website, which purportedly offers for sale clothing, footwear and accessories branded with the FIORUCCI and the ICEBERG marks, as well as the Complainant's "Angels" logo, which is registered in over 40 jurisdictions.

According to the Complainant, consumers are certainly misled into thinking that the website corresponding to the Disputed Domain Name is a legitimate outlet site for the Complainant's genuine FIORUCCI goods, operated by the Complainant or by an authorized third party, 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 the Respondent is not commonly known by the Disputed Domain Name, and that the Respondent has no rights or legitimate interests in respect of them.

In addition, by using the Disputed Domain Name in connection with a website that falsely appears to be a website for, or otherwise associated with, the Complainant – and by offering FIORUCCI goods that are clearly counterfeited, the Respondent has failed to create a *bona fide* offering of goods or services.

The Complainant provides evidence showing that it attempted to carry out a purchase from the Respondent's website – a hoodie with the Angels logo on it – which resulted in payment being taken without the purchased item being received. Rather, the Complainant ended by receiving a package with a counterfeit Cartier ring.

Also, the Complainant mentions that the contact details reproduced on the website corresponding to the Disputed Domain Names are false, and that the Respondent registered the Disputed Domain Name in bad faith for the purpose of intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trademark FIORUCCI.

In sum, the Complainant alleges that the registration and use of the Disputed Domain Name is intentional to mislead Internet users, that it is clear that the Respondent has no rights or legitimate interests in the Disputed Domain Name, and that the Disputed Domain Name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

The Policy, in its paragraph 4(a), determines that three elements must be present and duly proven by a complainant to obtain relief. These elements are:

- i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- ii. the respondent has no rights or legitimate interests in respect to 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 Disputed Domain Name is, indeed, confusingly similar to the FIORUCCI trademark, as the latter is entirely incorporated in the Disputed Domain Name. The Disputed Domain Name also incorporates the trademark ICEBERG, owned by the Italian company Gilmar SpA.

The Complainant has presented consistent evidence of ownership of the trademark FIORUCCI in jurisdictions throughout the world, by presenting a substantial number of registrations for them, as well as comprehensive evidence of the use of the trademark.

The Disputed Domain Name incorporates the Complainant's trademark FIORUCCI in its entirety. 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

The addition of the third party trademark ICEBERG 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 Name. See section 1.12 of the [WIPO Overview 3.0](#).

The generic Top-Level Domain ("gTLD"), ".shop" in this case, is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel concludes that the Disputed Domain Name is confusingly similar to the registered trademark of the Complainant.

B. Rights or Legitimate Interests

Given the clear evidence that the trademark FIORUCCI is registered in the name of the Complainant and is widely known as identifying the Complainant's activities, and that the Complainant has not licensed this to the Respondent, the Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

In the absence of a Response, the Respondent has not rebutted such *prima facie* case. Furthermore, the Respondent does not appear to be commonly known by the Disputed Domain Name.

It has also been shown that the disputed domain name resolves to a website that is presented as if it is offering for sale the Complainant's goods under the mark FIORUCCI, and third party products. The goods offered for sale on the Website are suspected to be counterfeits of the Complainant's genuine FIORUCCI products and seek to take unfair advantage of the Complainant's trademark and reputation. In addition, the Complainant made a trap purchase of a hoodie under the Complainant's brand, but received a counterfeited Cartier ring.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In the absence of a Response, the Respondent has not rebutted such *prima facie* case.

The Panel, thus, finds for the Complainant under the second element of the Policy.

C. Registered and Used in Bad Faith

Given the circumstances of this case, the facts outlined in sections 6A and 6B above, the Panel finds the Respondent's bad faith in the registration and use of the Disputed Domain Name.

The Respondent has intended to give an overall impression that the Disputed Domain Name is associated with the Complainant, and the Panel accepts that the Disputed Domain Name may be intended to capitalize on the fame and goodwill of the Complainant's trademark. The fact that the Disputed Domain Name resolves to a website purportedly offering for sale the goods of the Complainant but may actually offer for sale the counterfeited goods of unrelated third parties as evidenced by the Complainant's trap purchase supports a finding of bad faith in these circumstances.

All the points above lead to the conclusion by this Panel that the Respondent was fully aware of the Complainant when registering the disputed domain name and that the Respondent registered and is using the Disputed Domain Name in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The Panel finds that the Complainant has also proved 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 Name <fiorucciiceberg.shop> be transferred to the Complainant .

/Alvaro Loureiro Oliveira/

Alvaro Loureiro Oliveira

Sole Panelist

Date: June 1, 2023