

ADMINISTRATIVE PANEL DECISION

Dixie S.r.l. v. Li Liu
Case No. D2023-1130

1. The Parties

The Complainant is Dixie S.r.l., Italy, represented by Bugnion S.p.A., Italy.

The Respondent is Li Liu, China.

2. The Domain Name and Registrar

The disputed domain name <dixie-shop.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 March 14, 2023. On March 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 16, 2023, 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 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 the Respondent of the Complaint, and the proceedings commenced on March 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 12, 2023.

The Center appointed Torsten Bettinger as the sole panelist in this matter on April 27, 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 company established in the late 1980s. Since then, it has been producing, promoting, and distributing fashion articles and accessories under the DIXIE mark, particularly ready-to-wear fashion.

The Complainant's retail network now includes more than 46 branded stores in Italy and abroad.

The Complainant is the registered owner of a substantial number of trademark registrations around the world in respect of DIXIE, including

- European Union trademark number 013083845 for DIXIE (word), registered on February 6, 2015;
- European Union trademark number 012544251 for DIXIE (figurative), registered on June 17, 2016; and
- European Union trademark number 009329319 for DIXIE (word), registered on December 22, 2011.

The Complainant operates a website at "www.dixiefashion.com", promoting and offering for sale its products.

The disputed domain name was registered on September 19, 2022, and resolves to a website whose webpages all include in the header the mark DIXIE. The various pages purport to offer for sale the Complainant's products and comprise a photo copied from the Complainant's Facebook social media site.

5. Parties' Contentions

A. Complainant

The Complainant claims that the mark DIXIE has achieved significant success and renown as an international fashion company in particular in ready-to-wear-fashion and is extensively promoted and advertised on national and international fashion markets.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that the disputed domain name is confusingly similar to its registered trademark DIXIE as:

- the trademark DIXIE is recognizable in the disputed domain name; and
- the mere addition of the term "shop" is descriptive in relation to the fashion field and does therefore not prevent a finding of confusing similarity.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the Respondent has no rights or legitimate interests in the disputed domain name;
- based on the Complainant's research, the Respondent's address on the Respondent's website, appear to be fake; and
- the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the disputed domain name resolves to a website whose webpages all include the Complainant's trademark DIXIE;
- the home page of the Respondent's website features the same photo that was used on the Complainant's Facebook social media site;
- the various pages of the Respondent's website offer for sale products with the trademark DIXIE, which is also present on the label of the articles;
- the visitors to the Respondent's website will believe that goods displayed are those of the Complainant; and
- it is implausible that the Respondent was unaware of the Complainant when the disputed domain name was registered.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns multiple trademark registrations for the mark DIXIE prior to the registration of the disputed domain name on September 19, 2022.

It is well-established that the test of identity or confusing similarity between the trademark and the disputed domain name under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

In this case, the disputed domain name contains the Complainant's trademark DIXIE in its entirety and only differs from the Complainant's trademark DIXIE by the addition of the term "shop".

The Panel notes that it has long been established under the UDRP that the addition of descriptive wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of the [WIPO Overview 3.0](#)). The Panel therefore agrees with the Complainant's assertion that the addition of the term "shop" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark DIXIE.

Furthermore, it is well accepted under the UDRP that the Top-Level Domain ("TLD") designation (such as ".com", ".net", or ".org") is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable TLD suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#), section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant's DIXIE trademark.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a 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 you [the Respondent] of the dispute, your 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) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [the Respondent] are 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 Complainant has stated and provided screenshots show that the disputed domain name, which contains the Complainant’s trademark in its entirety together with the descriptive term “shop”, resolves to a website which offers fashion articles under the Complainant’s brand Dixie and appears to provide false address.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 disputed domain name. If the respondent fails to submit 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 chose not to contest the Complainant’s allegations, and has failed to come forward with any evidence to refute the Complainant’s *prima facie* showing that the Respondent lacks rights or legitimate interests.

From the record in this case, the Respondent has also not used the disputed domain name in connection with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use. The Respondent is using the disputed domain name to sell products which purport to be those of the Complainant, however, the website at the disputed domain name does not accurately and prominently disclose the Respondent’s relationship with the Complainant (see section 2.8 of the [WIPO Overview 3.0](#)). Further, the composition of the disputed domain name, which adds the descriptive term “shop” relating to the Complainant’s business, carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

On this basis, the Panel concludes that the Respondent lacks rights or legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

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

- (iv) by using the disputed 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 the Respondent's website or location or of a product or service on the Respondent's website or location.

Bad faith registration

The Complainant holds multiple trademark registrations for the DIXIE trademark in various countries that predate the registration of the disputed domain name. The DIXIE mark is distinctive and clearly associated with the Complainant and its products through widespread use.

Given that the disputed domain name contains the Complainant's trademark DIXIE in its entirety with the addition of the descriptive term "shop" and that the disputed domain name resolves to an online store which offers fashion articles under the Complainant's mark DIXIE, the Panel has no doubt that the Respondent registered the disputed domain name with actual knowledge of the Complainant's rights in the DIXIE mark.

The Panel thus finds that the Respondent registered the disputed domain name in bad faith.

Bad faith use

To prove bad faith use of the disputed domain name, the evidence provided by the Complainant indicates that the Respondent has used the disputed domain name to resolve to an online store offering fashion articles which purport to be those offered by the Complainant and that the home page of the Respondent's website features the same photo that has been used on the Complainant's Facebook social media site.

Such use constitutes bad faith pursuant to paragraph 4(a)(iii) of the Policy as it indicates that the Respondent has intentionally registered and is using the disputed domain name to attract, for commercial gain, Internet users to his website in accordance with paragraph 4(b)(iv) of the Policy. Such use of the disputed domain name also disrupts the Complainant's business.

The Panel is therefore satisfied that the Complainant has also shown that the disputed domain name has been registered and is being used in bad faith satisfying the third limb 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 <dixie-shop.com> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: May 10, 2023