

ADMINISTRATIVE PANEL DECISION

PRADA S.A. v. 徐勇 (yong xu)

Case No. D2023-1615

1. The Parties

The Complainant is PRADA S.A., Luxembourg, represented by Studio Barbero, Italy.

The Respondent is 徐勇 (yong xu), China.

2. The Domain Name and Registrar

The disputed domain name <prada.club> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on April 13, 2023. On April 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 14, 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. On April 17, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On April 17, 2023, the Complainant confirmed its request that English be the language of the proceeding. On April 18 and April 19, 2023, the Respondent sent two emails in Chinese including a request for Chinese to be the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on April 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2023. The Respondent did not submit any formal response. Accordingly, on May 30, 2023, the Center notified the Parties that it would proceed to panel appointment.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on June 1, 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 a global luxury fashion house founded in 1913 and headquartered in Luxembourg. The Complainant has large international business operations and is currently active in 70 countries with approximately 13,988 employees. The Complainant also has a strong business presence in the Respondent's jurisdiction China through its wholly owned subsidiary PRADA Fashion Commerce (Shanghai) Co., Ltd and through its retail stores located in Beijing, Chengdu, Dalian, Guangzhou, Hangzhou, Harbin, Qingdao, Shanghai, Shenyang, Shenzhen, Tianjin, Wenzhou and Xi'an.

The Complainant owns an extensive international trademark portfolio for the mark PRADA, including the following registrations: PRADA, European Union mark, registered on May 13, 2014 under No. 012443362; and PRADA, Chinese word mark, registered on April 14, 1999 under No. 1263052. The Complainant also has a strong online presence and owns a large domain name portfolio of official domain names which contain its trademark PRADA, including <prada.com>.

The disputed domain name was registered on January 31, 2023, and is therefore of a later date than the abovementioned trademark registrations of the Complainant. The Complainant submits evidence that the disputed domain name directs to an inactive webpage.

The Complainant also provides evidence that it attempted to resolve this dispute amicably through its cease-and-desist letter of March 29, 2023, to which the Respondent did not reply.

5. Parties' Contentions

A. Complainant

The Complainant essentially contends that the disputed domain name is identical to its trademarks for PRADA, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainant claims that its trademarks are intensively used and well-known and provides evidence of its company and marketing materials. The Complainant also refers to a number of prior UDRP decisions in which earlier panels have recognized the Complainant's rights in the PRADA marks and considered that such marks are internationally well known, see for instance, *Prada S.A. v. Chen Mingjie*, WIPO Case No. [D2015-1466](#), and *PRADA S.A. v. Carlo Tafuri, IDT Spa*, WIPO Case No. [D2015-1421](#). The Complainant particularly contends that the Respondent is holding the disputed domain name passively, without making any concrete use of it. The Complainant also argues that given the international fame of its trademarks, the Respondent cannot have been unaware of them at the time of registration of the disputed domain name. Moreover, the Complainant contends that the Respondent is merely passively holding the disputed domain name and attempting to sell the disputed domain name for an amount in excess of the Respondent's out-of-pocket costs. The Complainant argues that there are no justifications for the use of its trademarks in the disputed domain name and that such registration and use were conducted in bad faith.

The Complainant requests that the disputed domain name be transferred to it.

B. Respondent

The Respondent did not reply formally to the Complainant's contentions. However, in its informal email

communication of April 18, 2023, the Respondent mainly argues without, however, submitting any evidence to substantiate its claims, that he is using the disputed domain name to set up a blog website for his pet turtle whose name is Prada, and that he purchased the disputed domain name from a legitimate domain marketplace and paid a fair amount at the time of that transaction. The Respondent also refers to other famous third party brand names registered under the “.club” generic Top-Level Domain (“gTLD”) and that are allegedly also not owned by those third party brands.

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar’s verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint in English, and requests that English be the language of the proceeding. The Panel notes that the Respondent requested Chinese to be the language of the proceeding.

In considering the language of this proceeding, the Panel has carefully taken into account all elements of this case, and considers the following elements particularly relevant: the Complainant’s request that the language of the proceeding be English; the lack of a formal and substantiated response on the merits of this proceeding by the Respondent; the fact that the disputed domain name contains the Complainant’s PRADA trademark in its entirety and that it is written in Latin letters and not in Chinese characters; the fact that the pre-Complaint communication between the Parties (or their representatives) was conducted in English, from which the Panel deduces that the Respondent is capable of reading and writing in English and, finally, the fact that Chinese as the language of this proceeding could lead to unwarranted delay of the proceeding and costs for the Complainant. In view of all these elements, the Panel grants the Complainant’s request, and decides that the language of this proceeding shall be English.

6.2. Discussion and Findings on the Merits

The Policy requires the Complainant to prove three elements:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Based on the evidence and arguments submitted, the Panel’s findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has shown that it has valid rights in the mark PRADA, based on its use and registration of the same as a trademark in a large number of jurisdictions.

Moreover, as to whether the disputed domain name is identical or confusingly similar to the Complainant’s mark, the disputed domain name consists of only the Complainant’s registered trademark for PRADA, followed by the gTLD, “.club”. The Panel refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.11.1, which states: “The applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration

requirement and as such is disregarded under the first element confusing similarity test". The Panel concludes that the disputed domain name contains only the Complainant's trademark PRADA, and that the disputed domain name is therefore identical to this trademark owned by the Complainant.

Accordingly, the Panel finds that the disputed domain name is identical to the Complainant's registered trademark for PRADA, and concludes that the Complainant has satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel accepts that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainant, is not a good faith provider of goods or services under the disputed domain name and is not making a legitimate noncommercial use or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Further, reviewing the facts of this proceeding, the Panel notes that the disputed domain name directs to an inactive webpage and that there are no elements in this case that point to the Respondent having made any reasonable and demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent's claims in this regard are merely unsubstantiated statements and can therefore not be accepted by the Panel. The Panel therefore finds that the Respondent is holding the disputed domain name merely passively, without making any substantive use of it, and that such use does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#) and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

Furthermore, the Panel finds that the nature of the disputed domain name, being identical to the Complainant's trademarks for PRADA, carries a high risk of implied affiliation and cannot constitute fair use, as it effectively impersonates the Complainant and its products or suggests sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

On the basis of the foregoing elements, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and finds that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the registration of the disputed domain name, which is identical to the Complainant's internationally well-known trademarks for PRADA, is clearly intended to mislead and divert consumers away from the Complainant's official website to a website which may be linked to the disputed domain name by the Respondent. The Panel has also considered that the Complainant has a strong Internet presence and has a strong business presence in China and that previous panels under the UDRP have also recognized the PRADA marks as internationally well known (see for instance *Prada S.A. v. Chen Mingjie*, WIPO Case No. [D2015-1466](#) and *PRADA S.A. v. Carlo Tafuri, IDT Spa*, WIPO Case No. [D2015-1421](#)). Based on these facts, the Panel finds that the Respondent's registration of the disputed domain name constitutes an intentional attempt to target the Complainant's well-known trademark, of which the Respondent could not reasonably be unaware. The fact that the Respondent claims (but does not provide any evidence) that it has legally acquired the disputed domain name from a domain name marketplace does not alter these clear elements indicating bad faith. Furthermore, even a cursory Internet search at the time of registration (or alleged acquisition) of the disputed domain name would have shown that the Complainant owned the registered trademarks in PRADA and uses them extensively, including in China where the Respondent is

located. Based on the above elements, the Panel finds that the registration of the disputed domain name was obtained in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directs to an inactive website. In this regard, the [WIPO Overview 3.0](#), section 3.3 provides: “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.” The Panel has reviewed all elements of this case, and attributes particular relevance to the following elements: the fact that the disputed domain name is identical to the Complainant’s trademarks for PRADA, the international fame and high degree of distinctiveness of the Complainant’s trademarks, the fact that the Respondent did not reply to the Complainant’s cease-and-desist letter and the unlikelihood of any good-faith use to which the disputed domain name might be put by the Respondent. Finally, the Complainant provides evidence that in the pre-Complaint communication between the Parties (or their representatives), the Respondent offered to sell the disputed domain name to the Complainant for the amount of EUR 30,000. This leads the Panel to conclude that the Respondent is using the disputed domain name to sell it in excess of the documented out-of-pocket costs related to the disputed domain name. In these circumstances, the Panel considers that the passive holding of the disputed domain name by the Respondent constitutes use in bad faith.

Finally, the Respondent has failed to provide any formal response or evidence to establish its good faith or absence of bad faith. The Panel therefore finds that the Complainant has satisfied the requirements of the third element under 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 <prada.club> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: June 14, 2023