

ADMINISTRATIVE PANEL DECISION

Premiata S.r.l v. 张禹, SONG HE, Shenzhen Yuanhai Zhilian Technology Co.,
松贺
Case No. D2023-2278

1. The Parties

Complainant is Premiata S.r.l, Italy, represented by Dr. Modiano & Associati S.p.A., Italy.

Respondents are 张禹, China, SONG HE, Shenzhen Yuanhai Zhilian Technology Co., China, and 松贺, China.

2. The Domain Names and Registrars

The disputed domain name <negoziopremiata.online> is registered with Name.com, Inc. (the “Registrar”).

The disputed domain names <premiataitalia.com> and <premiataitstore.com> are registered with NameSilo, LLC (the “Registrar”).

The disputed domain name <premiatastore.com> is registered with Dynadot, LLC (the “Registrar”).

Hereinafter, the disputed domain names will be referred to collectively as the “Domain Names” unless otherwise indicated.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 25, 2023. On May 25, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the Domain Names. On May 25, 26, and 28, 2023, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the Domain Names which differed from the named Respondent (PrivacyGuardian.org llc / Dynadot Privacy Service / REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to Complainant on May 29, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 31, 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 Respondents of the Complaint, and the proceedings commenced on June 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2023. Respondents did not submit any response. Accordingly, the Center notified Respondents' default on June 23, 2023.

The Center appointed Marina Perraki as the sole panelist in this matter on July 13, 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. Procedural Issue: Consolidation of Respondents

The Panel has considered the possible consolidation of the Complaint for the Domain Names at issue. According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2, "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario".

The Panel notes the following features of the Domain Names and arguments submitted by Complainant in favor of the consolidation:

- the Domain Names <premiataitalia.com> and <premiataitstore.com> have the same registrant;
- the Domain Names are almost identical in their structure: they all contain the trademark PREMIATA of Complainant combined with the terms "store", "negozi" (which means "shop" in Italian), "it" (which is the country code for Italy) and "Italia";
- the Domain Names were all registered within a short period of time, namely between November 2022 and January 2023;
- all Domain Names target Complainant;
- all Domain Names were used at least until January 19, 2023 to promote purportedly Complainant's goods;
- three out of four Domain Names, namely <premiataitstore.com>, <premiataitalia.com>, and <negoziopremiata.online> were used at least until January 19, 2023 for websites with the same content (the "Websites"), namely with a number of Complainant's copyright-protected official product images and marketing materials;
- the Domain Name <negoziopremiata.online> is currently not reachable, and similarly the Domain Names <premiatastore.com>, <premiataitstore.com>, and <premiataitalia.com> are currently inactive;
- although the contents of the Websites were exclusively in Italian, the contact (and return) address on the website linked to the Domain Name <premiatastore.com> was in China (Global Shoes Building, Fase II, Haopan, Shanmei Village, Shanmei Community, Houjie Town, Dongguan, Guangdong) and the only available detail concerning the Domain Name <negoziopremiata.online>, places its registrant, an individual, in China;
- the Domain Names <premiataitstore.com> and <premiataitalia.com> are listed in the name of Shenzhen Yuanhai Zhilian Technology Co./SONG HE; for the Domain Name <negoziopremiata.online> the listed contact name is: 松贺 (*i.e.* Song He), while the registrant of the fourth Domain Name <premiatastore.com> is listed as 张禹 (ZhangYu), and shares the same province as the other registrants, *i.e.* Anhui Province.

Considering all the above, the Panel also notes that the contact details including the postal addresses for Respondents are apparently fake, and thus finds that, as Complainant has argued, there appears *prima facie*

to be one single Respondent, providing possibly fake contact details, or at least all Domain Names are under the common control. Furthermore, named Respondents did not submit any arguments to rebut this inference.

The Panel finds that consolidation is fair to Parties, and all nominal Respondents have been given an opportunity to object to consolidation through the submission of pleadings to the Complaint but have chosen not to respond (see [WIPO Overview 3.0](#), section 4.11.2; *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. [D2016-2302](#)). Based on the file, the Panel finds that it is more likely than not that the Domain Names are in common control of one entity, and hence the Panel grants the consolidation (and will refer to these Respondents as “Respondent”).

5. Factual Background

Complainant, a company incorporated under Italian law, was founded in 1885 and is active in the field of footwear manufacture and sale. Complainant has been using the PREMIATA brand since 1991. In 2019, Complainant produced over 700,000 pairs of PERMIATA sneakers which were distributed in more than 1,200 multi-brand stores and in Complainant’s own stores, including its flagship store in Milan. Complainant’s official websites are located at “www.premiata.it” and “www.premiata.us”.

Complainant is the exclusive licensee of the PREMIATA trademarks, including the international trademark registration No. 1294336 PREMIATA (word), registered on December 9, 2015, for goods and services in international classes 18, 25, and 35, in the name of Complainant’s majority shareholder and Managing Director. As Complainant demonstrated, it is empowered by the trademark owner to enforce the PREMIATA trademark rights and to register the Domain Names in its own name.

Complainant is also the holder of various PREMIATA domain name registrations, including <premiata.it>, registered on January 30, 2001.

The Domain Names were registered as follows:

<negoziopremiata.online> on November 12, 2022;
<premiataitalia.com> on January 6, 2023;
<premiataitstore.com> on January 10, 2023; and
<premiatastore.com> on November 28, 2022.

The Domain Names were used for hosting websites mimicking that of Complainant (the “Websites”) selling purported PREMIATA goods at highly discounted prices. On the Websites the PREMIATA trademark was prominently displayed and in three out of four Websites (*i.e.* under the <premiataitstore.com>, <premiataitalia.com> and <negoziopremiata.online> Domain Names) a number of Complainant’s copyright-protected official product images and marketing materials were also included.

6. Parties’ Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a cancellation of the Domain Names.

B. Respondent

Respondent did not reply to Complainant’s contentions.

7. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements, which Complainant must satisfy with respect to the Domain Names:

- (i) the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Domain Names incorporate Complainant's PREMIATA trademark in its entirety. This is sufficient to establish confusing similarity ([WIPO Overview 3.0](#), section 1.7).

The additional terms "store", "negozi" (which means "shop" in Italian), "it" (which is the country code for Italy), and "Italia", as the case may be, do not avoid a finding of confusing similarity ([WIPO Overview 3.0](#), section 1.8).

The Panel also notes the content of the Websites to which the Domain Names lead, which reproduced Complainant's trademark and logo in three out of four of the Websites (*i.e.* under <premiataitstore.com>, <premiataitalia.com> and <negoziopremiata.online>) a number of Complainant's copyright-protected official product images and marketing materials was included ([WIPO Overview 3.0](#), section 1.15).

The generic Top-Level Domains ("gTLD") ".com" and ".online" are disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Names are confusingly similar to Complainant's trademark.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Names, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the Domain Names or a name corresponding to the Domain Names in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Names, even if Respondent has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Names.

Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Domain Names. As per Complainant, Respondent was not authorized to register the Domain Names.

Respondent has not demonstrated any preparations to use, or has not used the Domain Names or a trademark corresponding to the Domain Names in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Names were used to host the Websites to impersonate Complainant. Such use demonstrates neither a *bona fide* offering of goods nor a legitimate interest of Respondent (*Arkema France v. Aaron Blaine*, WIPO Case No. [D2015-0502](#)).

The Domain Names all falsely suggested that the Websites were official sites of Complainant or of an entity affiliated to or endorsed by Complainant. The Websites extensively reproduced, without authorization by Complainant, Complainant's trademarks and three of them also included a number of Complainant's copyright-protected official product images and marketing materials, without any disclaimer of association (or lack thereof) with Complainant.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Names.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the Domain Names in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Domain Names registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Names; or
- (ii) that Respondent has registered the Domain Names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Names primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Names in bad faith.

Because Complainant's mark had been used and registered by Complainant before the Domain Names registrations, and noting the content of the Websites, it is clear that Respondent had Complainant's mark in mind when registering the Domain Names (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

Furthermore, the content of the Websites to which the Domain Names lead, gave the impression that they originated from Complainant, prominently displaying Complainant's trademarks and three of them also product photographs and marketing materials on the Websites, thereby giving the false impression that the Websites emanated from or were endorsed by Complainant. This further supports registration in bad faith reinforcing the likelihood of confusion, as Internet users are likely to consider the Domain Names as in some way endorsed by or connected with Complainant ([WIPO Overview 3.0](#), section 3.1.4).

The Domain Names incorporate entirely Complainant's trademark plus additional words. This further indicates that Respondent knew of Complainant and chose the Domain Names with knowledge of Complainant and its industry (*Safepay Malta Limited v. ICS Inc.*, WIPO Case No. [D2015-0403](#)).

As regards bad faith use, Complainant demonstrated that the Domain Names were employed to host the Websites which appeared falsely to be those of or endorsed by Complainant.

Furthermore, the Domain Names have been operated by intentionally creating a likelihood of confusion with Complainant's trademark and business. This further supports the finding of bad faith use (*Arkema France v. Aaron Blaine, supra*; *Aktiebolaget Electrolux v. Priscilla Quaiotti Passos*, WIPO Case No. [D2011-0388](#); and [WIPO Overview 3.0](#), sections 3.1.4 and 3.2.1).

The Panel notes that three of the Domain Names currently lead to inactive websites and one leads to a non-reachable website. The non-use of a domain name does not prevent a finding of bad faith under the circumstances of this proceeding (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3).

Under these circumstances and on this record, the Panel finds that Respondent registered and is using the Domain Names in bad faith.

Complainant has established Policy, paragraph 4(a)(iii).

8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names, <negoziopremiata.online>, <premiataitalia.com>, <premiataitstore.com>, and <premiatastore.com> be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: July 27, 2023