

ADMINISTRATIVE PANEL DECISION

Luigi Fedeli e Figlio S.r.l. v. fenglan zhao
Case No. D2023-2316

1. The Parties

The Complainant is Luigi Fedeli e Figlio S.r.l., Italy, represented by Carnelutti Law Firm, Italy.

The Respondent is fenglan zhao, China.

2. The Domain Name and Registrar

The disputed domain name <discount-fedeli.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 May 29, 2023. On May 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 30, 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 June 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 30, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on July 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, based in Italy, has since 1934 manufactured and distributed luxury knitwear clothing and accessory products under the FEDELI trade mark. It operates 13 flagship stores and distributes to more than 430 wholesale clients worldwide. The Complainant owns various trade mark registrations worldwide for its FEDELI mark, including International trade mark registration number 813883 for FEDELI design mark that is designated in China and which was registered on October 2, 2003; and Chinese trade mark registration number 20855719 for FEDELI which was registered on September 28, 2017. It operates its main website from the domain name <fedelicashmere.com> from which it offers its products for sale online.

The disputed domain name was registered on November 12, 2022 by the Respondent with an address in China. It resolves to a website which features a mark identical to the Complainant's FEDELI mark and which offers knitwear and clothing products that are presented as FEDELI products.

5. Parties' Contentions

A. Complainant

The Complainant submits that that it owns registered trade mark rights in its FEDELI mark as noted above and that the disputed domain name wholly incorporates its FEDELI mark and is therefore confusingly similar to it. It says that the mere addition of the word "discount" in the disputed domain name does not dispel the degree of confusing similarity.

The Complainant submits that the Respondent appears to be a Chinese person with no connection to the FEDELI mark or business and that he is using the disputed domain name for a commercial purpose, namely to misleadingly divert consumers to a website that pretends to be an outlet for the Complainant's original FEDELI products.

The Complainant submits that on this basis the Respondent has registered and is using the disputed domain name in bad faith for the purpose of disrupting the Complainant's business and that by using the disputed domain name in this way the Respondent is trying to attract consumers for commercial gain by causing a likelihood of confusion with the Complainant and its trade marks. The Complainant notes in this regard that the Respondent uses on the website at the disputed domain name the Complainant's registered trade marks and a layout using the same colours, font style, structure, and type of photographs. It notes that the Respondent even describes itself as "Fedeli [...] the king of fashion in cashmere industry. Its products are 100% made in Italy [...]. With years of experience". The Complainant submits that the Respondent's purpose is clearly to create a non-existing link with the Complainant in order to mislead and illicitly attract consumers to the website at the disputed domain name.

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 registered trade mark rights in its FEDELI mark, as mentioned in section 4 above. The Panel notes that the FEDELI mark is wholly incorporated into the disputed domain name which as a result is confusingly similar to the Complainant's registered marks. The addition of the common English word "discount" into the disputed domain name does not prevent a finding of confusing similarity.

Accordingly, the Complaint succeeds under this element of the Policy.

B. Rights or Legitimate Interests

The Complainant's FEDELI knitwear and accessory business appears to be well established in Italy and elsewhere, and its products are distributed worldwide and its trade marks are protected in numerous countries, including in China.

The Complainant has submitted that the Respondent based in China has no connection with the FEDELI mark or business and is using the disputed domain name for his own commercial purposes, namely to mislead and divert consumers to a website that pretends to be an outlet for the Complainant's original FEDELI products but which the Complainant asserts distributes counterfeit or illicit products. The Panel notes that the Respondent has used the Complainant's registered logo mark on his website and both the website text and the way in which the products are represented is calculated to suggest to Internet users that this website is the Complainant's own site or is affiliated with the Complainant when this is clearly not the case. Nor does the website accurately and prominently display any disclaimer regarding the relationship between the Complainant and the Respondent. This conduct is not consistent with the Respondent having rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. As the Complainant's case has not been rebutted by the Respondent, the Panel finds for these reasons and as set out under section 6.C below, that the Complainant has successfully made out its case and that the Complaint also succeeds under the second element of the Policy.

C. Registered and Used in Bad Faith

The disputed domain name was registered in November 2022, many years after the registration of the Complainant's FEDELI marks. The fact that the website to which the disputed domain name resolves features the use of the FEDELI mark and of the Complainant's registered combined word and logo mark and statements concerning the FEDELI mark and business, strongly suggests that the Respondent was well aware of the Complainant's business and FEDELI mark when he registered the disputed domain name.

Under paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of the disputed domain name in bad faith where the Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation, or endorsement of the website.

The website to which the disputed domain name resolves appears to be operated by or affiliated with the Complainant when this is not the case. It features the registered combined word and logo mark of the Complainant and represents the products on the site as FEDELI products. The Respondent has plainly sought to use the disputed domain name to confuse Internet users arriving at this website to incorrectly believe that they are dealing with the Complainant or an authorised affiliate when this is not the case. The Respondent has failed to explain his unauthorised use of the Complainant's trade marks, whether in the disputed domain name or at the website to which it resolves. The Panel finds that this conduct falls squarely within the terms of paragraph 4(b)(iv) of the Policy and is therefore evidence of registration and use in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and has been used in bad faith and that the Complaint succeeds under this 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 <discount-fedeli.com> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: July 25, 2023