

ADMINISTRATIVE PANEL DECISION

Valentino S.p.A. v. Client Care, Web Commerce Communications Limited
Case No. D2023-2868

1. The Parties

The Complainant is Valentino S.p.A., Italy, represented by Studio Barbero S.p.A., Italy.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <pantofivalentinoromania.com>, <scarpevalentinosaldi.com>, <valentinoargentina.com>, <valentinoaustraliasale.com>, <valentinobelgie.com>, <valentinocanada.com>, <valentinochile.com>, <valentinocolombia.com>, <valentinodeutschland.com>, <valentinofrance.com>, <valentinogreece.com>, <valentinohungary.com>, <valentinoindonesia.com>, <valentinoireland.com>, <valentinomalaysia.com>, <valentinomexico.com>, <valentinonorge.com>, <valentinonz.com>, <valentinooutletfactory.com>, <valentinophilippines.com>, <valentinoportugal.com>, <valentinosaleaustria.com>, <valentinosk.com>, <valentinosouthafrica.com>, <valentinospain.com>, <valentinosuomi.com>, <valentinosverige.com>, <valentinotaskedanmark.com>, <valentino-turkey.com>, <valentinouae.com>, <valentinoukoutlet.com>, and <valentinoussale.com> (the “Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 5, 2023. On July 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On July 7, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Not Disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 7, 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 amendment to the Complaint on July 7, 2023.

The Center verified that the Complaint together with the amendment to 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 July 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 9, 2023. The Respondent did not submit any response. However, an email communication was received by third party on July 20, 2023, claiming no relation with the Domain Names. Accordingly, the Center notified the Commencement of Panel Appointment Process on August 15, 2023.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on August 28, 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 fashion house that was founded in 1960 by fashion designer Valentino Garavani and his business partner Giancarlo Giammetti. The Complainant offers a wide range of luxury products from Haute Couture and Prêt-à-Porter to an extensive accessories collection that includes bags, shoes, small leather goods, belts, eyewear, silks and perfumes.

The Complainant's products are available in over 90 countries consisting of 160 directly-operated stores and 1,300 points of sale, including a shop in Kuala Lumpur, Malaysia, where the Respondent is based.

The Complainant holds *inter alia* the following trade mark registrations (the "Trade Marks"):

- International Trade Mark Registration VALENTINO No. 570593, registered on April 24, 1991;
- International Trade Mark Registration VALENTINO No. 764790, registered on November 20, 2000;
- European Union Trade Mark Registration VALENTINO No. 001990407, registered on September 18, 2008;
- Malaysian Trademark Registration VALENTINO No. M/075735, registered on July 25, 1977.

In addition, the Complainant has rights in the Malaysian Trademark Registration of the word device mark VALENTINO No. 89006610 registered on October 25, 1989.

The Domain Names were registered by the Respondent between August 2022 and March 2023 and have been pointed to websites featuring the word device mark VALENTINO as well as other trade marks of the Complainant, publishing images taken from the Complainant's advertising campaigns and offering for sale the Complainant's products at discounted prices.

On various dates in March, April, and May 2023, the Complainant sent cease-and-desist letters to the Respondent and to its hosting provider, to which no response was received.

5. Parties' Contentions

A. Complainant

According to the Complainant, the Domain Names are confusingly similar to the Trade Marks in which the Complainant has rights, since they reproduce the word mark VALENTINO, with the mere addition of non-distinctive elements, mostly referring to countries and/or a combination of letters which may be interpreted as a country code, such as "nz", "us", "uk", "uae" and "sk"; and/or generic/descriptive terms mainly related to online sale, such as "outlet", "factory", "saldi" ("sale" in Italian) and "sale"; and/or to the Complainant's products and core businesses, such as "pantofi" ("shoes" in Romanian), "scarpe" ("shoes" in Italian) and "taske" ("bag" in Danish); or a combination thereof. The Complainant submits that the addition to the VALENTINO mark of a geographical term and/or of a descriptive term related to online sale and/or to the Complainant's core businesses is, per se, not a distinguishing feature, and that it may to the contrary be

apt to increase confusion since users could believe that the Domain Names are used by the Complainant or, at least, by an entity affiliated with the Complainant, in connection with official web portals of the Complainant. The Complainant further contends that the addition of a generic Top-Level Domain ("gTLD"), such as ".com", is merely instrumental to the use of Internet and should be disregarded in the assessment of confusing similarity.

The Complainant submits that the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name and states that the Respondent is not a licensee or authorized agent of the Complainant or in any other way authorized to use the Trade Marks. The Complainant adds that the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the Domain Names. Furthermore, the Complainant states that it is not in possession of, nor aware of the existence of any evidence demonstrating that the Respondent might be commonly known by a name corresponding to the Domain Names as an individual, business, or other organization.

According to the Complainant, the Respondent has used the Domain Names to redirect users to websites featuring the Trade Marks and other trademarks of the Complainant, publishing images of the Complainant's advertising campaigns and offering for sale purported VALENTINO products at discounted prices, without providing any disclaimer as to the Respondent's lack of a relationship with the Complainant. Therefore, the Complainant submits, the Respondent's use of the Domain Names is apt to confuse and mislead Internet users into believing that the websites are operated by the Complainant or by an affiliated entity with the Complainant's consent. According to the Complainant, the Respondent in this case is using the Domain Names to advertise and offer for sale *prima facie* counterfeit VALENTINO products, in view of the very low prices at which the purported VALENTINO goods are offered. The Complainant submits that the lack of complete and reliable information about the entity operating the Respondent's websites supports the conclusion that the Respondent might have indeed engaged in the sale of counterfeit goods and willfully indicated inaccurate and/or incomplete contact details to avoid being identified and prosecuted for their illegal conduct.

In the view of the Complainant the Respondent's use of the Domain Names cannot be considered a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain, because the Respondent has been attempting to gain from the offer for sale of the products advertised on the websites to which the Domain Names resolve, by free-riding the well-known character of the Trade Marks and causing confusion amongst users as to the source or affiliation of their websites and the products offered for sale therein.

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the Domain Names pursuant to paragraph 4(a)(ii) of the Policy.

The Complainant submits that, in light of the extensive use of the word mark VALENTINO since the 1960s, the amount of advertising and sales of the Complainant's products worldwide, including in Malaysia, where the Respondent is based, the Respondent could not have possibly ignored the existence of the Trade Marks when it registered the Domain Names. Furthermore, the fact that purported VALENTINO products are offered for sale and the Trade Marks and other trade marks of the Complainant have been published on the websites to which the Domain Names resolve, indicates that the Respondent was aware of the Complainant and the Trade Marks. In addition, the Complainant submits that the use of the Domain Names in connection with the commercial websites described above, displaying the Trade Marks and other trademarks of the Complainant and the Complainant's official images and offering for sale counterfeit VALENTINO branded products, clearly indicates that the Respondent's purpose in registering the Domain Names was to capitalize on the reputation of the Trade Marks, by attracting Internet users seeking the Complainant's branded products to its own website for commercial gain and intentionally creating a likelihood of confusion with the Trade Marks as to the source, sponsorship, affiliation, or endorsement of its website and the goods offered and promoted through said website, according to paragraph 4(b)(iv) of the Policy. Moreover, the Complainant contends that the Respondent registered the Domain Names in order to prevent the Complainant from reflecting its trade marks in corresponding domain names and has clearly engaged in a pattern of such conduct, since the Respondent registered 32 Domain Names encompassing the

Complainant's word mark VALENTINO. The Complainant points out as a further circumstance evidencing the Respondent's bad faith, that the Respondent did not reply to the Complainant's cease-and-desist letters sent to its attention by email.

The Complainant concludes that in light of the above, it is clear that the Domain Names were registered and are being used in bad faith, according to paragraph 4(a)(iii) of the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Names are confusingly similar to the Trade Marks as they incorporate "VALENTINO", of which the Trade Marks consist, in its entirety. The addition of other terms does not avoid a finding of confusing similarity between the Domain Names and the Trade Marks (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8; See also, *inter alia*, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. [D2009-0361](#), and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. [D2018-0980](#)). The gTLD ".com" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11). Therefore, the Panel finds that the Domain Names are confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, the second element a complainant has to prove is that a respondent lacks rights or legitimate interests in a domain name. This may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. In order to satisfy the second element, the Complainant has to make out a *prima facie* case that the Respondent does not have rights or legitimate interests in the Domain Names. If the Complainant succeeds in doing so, the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Domain Names. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element (See [WIPO Overview 3.0](#), section 2.1).

Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent has not received the Complainant's consent to use the Trade Marks as part of the Domain Names, is not commonly known by the Domain Names and has not acquired trade mark rights in the Domain Names and is not an authorized reseller of the Complainant. The Respondent uses the Domain Names for websites on which the Complainant's word device mark is used prominently, as well as images from a publicity campaign of the Complainant and photos of products purporting to be genuine products of the Complainant. The Respondent thereby suggests a relationship with the Complainant which does not exist, while the website lacks a disclaimer to that effect. In addition, the products are offered for sale with very steep discounts, on average 85 to 95% over the crossed out "official" price, which may indicate that they are in fact counterfeit products. Given these facts and circumstances it is clear that there is no case of a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the Domain Names by the Respondent.

In view of the above, the Panel concludes that the Complainant has established that the Respondent has no rights or legitimate interests in the Domain Names.

C. Registered and Used in Bad Faith

Based on the information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the Domain Names the Respondent was or should have been aware of the Trade Marks, since:

- the Trade Mark VALENTINO has since 1977 been registered in Malaysia, where the Respondent is located;
- the Respondent's registration of the Domain Names occurred at least 45 years after the registration of the earliest of the Trade Marks;
- the Respondent uses the word device mark VALENTINO prominently on the website, in addition to images from a publicity campaign of the Complainant;
- the Respondent has registered 32 Domain Names containing the Trade Marks;
- a simple trade mark register search, or even an Internet search, prior to registration of the Domain Names in its name would have informed the Respondent of the existence of the Trade Marks.

Furthermore, the Panel finds that the following circumstances taken together warrant a finding of bad faith use of the Domain Names:

- the probability that the Respondent was aware or should have been aware of the Complainant's rights in the Trade Marks;
- the use of the Domain Names for websites prominently using the word device mark VALENTINO and images from a publicity campaign of the Complainant, while offering products for sale purported to be from the Complainant, but at such steep discounts from the crossed out "official" price that is it likely that they are counterfeit products;
- the Respondent registered 32 Domain Names encompassing the Complainant's word Trade Mark VALENTINO which indicates that the Respondent registered the Domain Names in order to prevent the Complainant from reflecting its Trade Marks in corresponding domain names and that it has engaged in a pattern of such conduct;
- the lack of a response to the cease-and-desist letters;
- the lack of a formal Response of the Respondent.

Therefore, the Panel concludes that the Domain Names have been registered and are being used in bad faith.

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 names, <pantofivalentinoromania.com>, <scarpevalentinosaldi.com>, <valentinoargentina.com>, <valentinoaustraliasale.com>, <valentinobelgie.com>, <valentinocanada.com>, <valentinochile.com>, <valentinocolombia.com>, <valentinodeutschland.com>, <valentinofrance.com>, <valentinogreece.com>, <valentinohungary.com>, <valentinoindonesia.com>, <valentinoireland.com>, <valentinomalaysia.com>, <valentinomexico.com>, <valentinonorge.com>, <valentinonz.com>, <valentinooutletfactory.com>, <valentinophilippines.com>, <valentinoportugal.com>, <valentinosaleaustria.com>, <valentinosk.com>, <valentinosouthafrica.com>, <valentinospain.com>, <valentinosuomi.com>, <valentinosverige.com>, <valentinotaskedanmark.com>, <valentino-turkey.com>, <valentinouae.com>, <valentinoukoutlet.com>, and <valentinoussale.com> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: September 17, 2023