

ADMINISTRATIVE PANEL DECISION

Mario Valentino S.p.A. v. Jiaqin Huang
Case No. D2023-3916

1. The Parties

Complainant is Mario Valentino S.p.A., Italy, represented by Società Italiana Brevetti S.p.A., Italy.

Respondent is Jiaqin Huang, China.

2. The Domain Name and Registrar

The <valentinobag.com> (the “Domain Name”) is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on September 19, 2023. On September 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 22, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Unknown) and contact information in the Complaint. The Center sent an email communication to Complainant on September 22, 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 in English on September 26, 2023.

On September 22, 2023, the Center sent another email communication to the Parties in Chinese and English regarding the language of the proceeding. On September 26, 2023, Complainant confirmed its request that English be the language of the proceeding. Respondent did not submit any comment on the language of the proceeding.

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 Respondent in Chinese and English of the Complaint, and the proceedings commenced on September 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 18, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 23, 2023.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on October 31, 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

Complainant is an Italian company founded around 1952, known internationally for its production of footwear, leatherware and clothing accessories. Complainant owns numerous registered trademarks in several jurisdictions for the VALENTINO mark, including:

- Italian registered trademark number 211185 for the VALENTINO word mark, registered on June 22, 1967;
- Italian registered trademark number 475334 for the VALENTINO word mark, registered on March 30, 1987;
- European Union registered trademark number 000096669 for the VALENTINO word mark, registered on August 11, 1999;
- Chinese registered trademark number 326434 for the VALENTINO word mark, registered on October 10, 1988; and
- Chinese registered trademark number 327668 for the VALENTINO word mark, registered on October 20, 1988.

Complainant also owns and operates numerous domain names, including <valentinoshoes.com> registered in 2004 and <valentinobags.com>, which is almost identical to the Domain Name.

The Domain Name was registered on November 30, 2022 and at the time of filing of the Complaint, it resolved to a website with a main page which prominently displayed a “V” sign in an ellipse (which is a trademark of the company Valentino S.p.A., a direct competitor of Complainant) above Complainant’s mark VALENTINO, along with the pictures of one of Valentino S.p.A.’s bags, its wallets and eyeglasses, while the majority of the other pictures of bags, belts and accessories shown on the website related to Complainant’s products. At the time of the Decision, the Domain Name reverted to an error or inactive page.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

Notably, Complainant contends that: (i) the Domain Name is identical or confusingly similar to Complainant’s trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has trademark registrations for VALENTINO and that Respondent registered and is using the Domain Name with the intention to confuse Internet users looking for *bona fide* and well-known VALENTINO products and services.

Complainant notes that it has no affiliation with Respondent, and contends that Respondent has used Complainant’s reputation to sell VALENTINO products on the website associated with the Domain Name. Complainant further contends that Respondent is using the Domain Name as a tool to exploit Complainant’s reputation for its own commercial gain, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name other than trademark infringement. Further, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Name, when Respondent clearly knew of Complainant’s rights.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the Domain Name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Domain Name is formed with Latin characters, that the Domain Name includes the English word "bag", the content of the related website is entirely in English, all of which points to Respondent's familiarity with the English language.

Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

The Panel accepts Complainant's submissions regarding the language of the proceeding. The Panel also notes that the Domain Name contains Complainant's VALENTINO trademark in its entirety, and the addition of the English word "bag" to Complainant's trademark in the Domain Name, and the content of the website at the Domain Name is in English, all of which indicates that Respondent understands English. The Panel further notes that the Center notified the Parties in Chinese and English of the language of the proceeding as well as notified Respondent in Chinese and English of the Complaint. Respondent chose not to comment on the language of the proceeding, nor did Respondent choose to file a response in Chinese or English.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner. Complainant may be unduly disadvantaged by having to translate the Complaint into Chinese and to conduct the proceeding in Chinese.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the Domain Name. [WIPO Overview 3.0](#), section 1.7.

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence of its rights in the VALENTINO trademarks, as noted above under section 4. Complainant has also submitted evidence, which supports that the VALENTINO trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the VALENTINO trademarks.

With Complainant's rights in the VALENTINO trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case is, ".com"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant's VALENTINO trademarks. These VALENTINO trademarks are recognizable in the Domain Name. In particular, the Domain Name's inclusion of Complainant's trademark VALENTINO in its entirety, with an addition of the term "bag", does not prevent a finding of confusing similarity between the Domain Name and the VALENTINO trademarks. See [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name 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. As such, 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 domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its VALENTINO trademarks, and does not have any rights or legitimate interests in the Domain Name. In addition, Complainant asserts that Respondent is not an authorized reseller and is not related to Complainant. Respondent is also not known to be associated with the VALENTINO trademarks and there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, at the time of filing of the Complaint, the Domain Name reverted to a website with a main page which prominently displayed a "V" sign in an ellipse (which is a trademark of the company Valentino S.p.A., a direct competitor of Complainant) above Complainant's mark VALENTINO, along with the pictures of one of Valentino S.p.A.'s bags, its wallets and eyeglasses, while the majority of the other pictures of bags, belts and accessories shown on the website related to Complainant's products, which could mislead Internet users into thinking that the website has been authorized or operated by or affiliated with Complainant. At the time of the Decision, the Domain Name reverts to an error or inactive page. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Moreover, the nature of the Domain Name is inherently misleading, and carries a risk of implied affiliation (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel finds that Complainant has provided ample evidence to show that registration and use of the VALENTINO trademarks long predate the registration of the Domain Name. Complainant is also well established and known. Indeed, the record shows that Complainant's VALENTINO trademarks and related products and services are widely known and recognized. Moreover, the website at the Domain Name purportedly offered for sale Complainant's products, and the Domain Name is almost identical to Complainant's domain name <valentinobags.com>. Therefore, Respondent knew of the VALENTINO trademarks when it registered the Domain Name. See [WIPO Overview 3.0](#), section 3.2.2; and see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Moreover, the use of the VALENTINO mark as the dominant part of the Domain Name is intended to capture Internet traffic from Internet users who are looking for Complainant's products and services. In addition, the use of the additional term "bag" in the Domain Name only serves to invoke Complainant's business and the industry Complainant operates in. Therefore, by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's webpage by creating a likelihood of confusion with Complainant's VALENTINO marks as to the source, sponsorship, affiliation, or endorsement of Respondent's website.

In addition, the evidence provided by Complainant indicated that at the time of filing of the Complaint, the Domain Name reverted to a website that also promoted and offered products that appeared to belong to the competitor of Complainant. The evidence also shows that the physical address provided on the website at the Domain Name does not exist and that the Domain Name appears to be set up to receive payments for orders of products which are not effectively sold and delivered.

Further, the Panel also notes the failure of Respondent to submit a Response.

Although the Domain Name currently does not resolve to an active website, it does not change the Panel's finding on Respondent's bad faith.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 Domain Name, <valentinobags.com>, be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: November 14, 2023