

## ADMINISTRATIVE PANEL DECISION

Premiata S.r.l v. 魏半梦 (Kyle Reyes), 曹夏岚 (Kyle Reyes), 王丹雪 (Menghua Xia), 华凡波 (Kyle Reyes), LiuYueQiang, Client Care, Web Commerce Communications Limited, Mildred Williamson, saf, Kyle Reyes, Apogee Tech, Collins Donna, xx  
Case No. D2023-4353

### 1. The Parties

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

The Respondents are 魏半梦 (Kyle Reyes) ("Alias 1A"), United States of America ("United States"), 曹夏岚 (Kyle Reyes) ("Alias 1B"), United States, 王丹雪 (Menghua Xia) ("Alias 2"), China, 华凡波 (Kyle Reyes) ("Alias 1C"), United States, LiuYueQiang ("Alias 3"), China, Client Care, Web Commerce Communications Limited ("Alias 4"), Malaysia, Mildred Williamson, saf ("Alias 5"), China, Kyle Reyes, Apogee Tech ("Alias 1D"), China, and Collins Donna, xx ("Alias 6"), Hong Kong, China.

### 2. The Domain Names and Registrars

The disputed domain names <premiata.online>, <premiatavips.com>, <premiatasport.com>, and <premiatasvip.com> are registered with West263 International Limited ("Registrar A"). The disputed domain names <premiatavip.com>, <premiatastyle.com>, and <premiataonlinevip.com> are registered with 1API GmbH ("Registrar B"). The disputed domain name <premiataoutlet.com> is registered with 22net, Inc. ("Registrar C"). The disputed domain name <scarpepremiataoutlet.com> is registered with Alibaba.com Singapore E-Commerce Private Limited ("Registrar D").

(Registrars A, B, C & D are hereinafter referred to individually and collectively as the "Registrar").

### 3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 20, 2023. On October 20, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On October 23, 2023, the Registrars transmitted by email to the Center the verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for privacy/ not available) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 24, 2023 with the registrant and contact information of nominally multiple underlying registrants

revealed by the Registrars, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed an amended Complaint in English on October 27, 2023.

On October 24, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain names <premiata.online>, <premiatavips.com>, <premiatasport.com>, <premiatasvip.com>, and <premiataoutlet.com> is Chinese. On October 27, 2023, the Complainant requested English to be the language of the proceeding. The Respondents did not submit any comment on the Complainant's submission.

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 the Respondents in English and Chinese of the Complaint, and the proceedings commenced on October 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 19, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on November 20, 2023.

The Center appointed Karen Fong as the sole panelist in this matter on November 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, a company incorporated under Italian law, was founded in 1885 in Montegranaro which is in the region of Marche, in Italy famed as the historical center of Italian shoe manufacturing. The PREMIATA brand was registered in 1991 by Graziano Mazza who licensed the brand to the Complainant. In 2009, Mr. Mazza created a style of urban sneakers under the PREMIATA brand. PREMIATA sneakers are high end luxury shoes which are distributed in the Complainant stores and internationally in multi-brand outlets. PREMIATA is registered as a trade mark in many jurisdictions throughout the world. The following were submitted in evidence:

- European Union ("EU") Trade Mark Registration No. 000418236, PREMIATA, registered on May 2, 2001;
- International Trade Mark Registration No. 1002682, PREMIATA, registered on December 19, 2008;
- International Trade Mark Registration No. 1294336, PREMIATA, registered on December 9, 2015;

(individually and collectively, the "Trade Mark").

The Complainant's official websites are at "www.premiata.it" and "www.premiata.us". It also has a portfolio of domain names with a variety of country and generic Top-Level Domain ("TLD") names comprising the Trade Mark.

The details of the disputed domain names (the "Domain Names") and the websites they are/were connected to (the "Websites") are set out below:

| No | Domain Name              | Creation Date | Registrant Alias No. | Registrar No. | Websites and Comments  |
|----|--------------------------|---------------|----------------------|---------------|--|
| 1  | premiata.online          | 2023/09/19    | Alias 1A             | A             | Inactive.<br><br>Connected to Name Servers tennis.dnspod.net and seven.dnspod.net ("X")                                |
| 2  | premiatavips.com         | 2023/09/20    | Alias 1B             | A             | Redirects to page on "www.amazon.com".<br><br>Connected to Name Servers X.   |
| 3  | premiatasvip.com         | 2023/10/06    | Alias 1C             | A             | Content same as Domain Name 2.<br><br>Connected to Name Servers X.   |
| 4  | premiastyle.com          | 2023/09/22    | Alias 1D             | B             | Inactive.  |
| 5  | premiatasport.com        | 2023/09/26    | Alias 2              | A             | Selling PREMIATA branded goods at discounted prices and using unauthorized images.<br><br>Connected to Name Servers X. |
| 6  | premiataoutlet.com       | 2023/09/11    | Alias 3              | C             | Content same as Domain Name 5.   |
| 7  | scarpepremiataoutlet.com | 2023/05/11    | Alias 4              | D             | Selling PREMIATA branded goods at discounted prices using unauthorized images (Italian).                               |
| 8  | premiatavip.com          | 2023/09/19    | Alias 5              | B             | Content same as Domain Name 2.<br><br>Connected to Name Servers X.   |
| 9  | premiataonlinevip.com    | 2023/09/12    | Alias 6              | B             | Content same as Domain Name 2.<br><br>Connected to Name Servers X.   |

## 5. Parties' Contentions

### A. Complainant

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

Notably, the Complainant contends that the Domain Names are identical and/or confusingly similar to the Trade Mark in which it has rights, that the Respondents have no rights or legitimate interests with respect to the Domain Names, and that the Domain Names were registered and are being used in bad faith. The Complainant requests transfer of the Domain Names.

## **B. Respondents**

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

## **6. Discussion and Findings**

### **6.1. Preliminary Issues**

#### **A. Consolidation: Multiple Respondents**

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple Domain Name registrants pursuant to paragraph 10(e) of the Rules.

The Domain Name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider 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. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes the following:

- (1) All the Domain Names include the Trade Mark as part of the Domain Names;
- (2) Domain Names 1, 2, 3 and 4 all have as part of the registrant details, the name Kyle Reyes even though each of the Domain Names include either different Chinese names or slightly different address and email details, which indicates that Alias 1A, 1B, 1C and 1D are one and the same;
- (3) Domain Names 2, 3, 8 and 9 all redirect to the same page on "www.amazon.com";
- (4) Domain Names 1, 2, 3, 5, 8 and 9 are all connected to Name Servers X;
- (5) Domain Names 1,2,3 and 5 are registered with Registrar A whilst Domain Names 4, 8 and 9 are registered to Registrar B;
- (6) Domain Names 5 and 7 have websites that purport to sell PREMIATA trade marked goods at discounted prices and using unauthorized images belonging to the Complainant;
- (7) Domain Name 7 is connected to an Italian website purporting to sell PREMIATA trade marked goods at reduced prices and also appears to be using unauthorized images from the Complainant;
- (8) The Complainant has alleged that Domain Names 2, 3, 5, 6, 7, 8 and 9 all have the same ADMIN-C IP address at Cloudflare, Inc. but have provided no evidence of this; and
- (9) The Respondents failed to file responses.

The evidence submitted points to the fact that the Domain Names are subject of common control by the Respondents. The above pattern evidences common conduct based on the registration and use of the Domain Names and that such conduct interferes with the Trade Mark. The Respondents had the opportunity but did not respond substantively to the Complaint. As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different Domain Name registrants (referred to below as “the Respondent”) in a single proceeding.

## **B. Language of the Proceeding**

The language of the Registration Agreement for Domain Names 1, 2, 3, 5, and 6 registered with Registrars A and C 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. The Complainant requested that the language of the proceeding be English for the following main reasons:

- The Respondent’s address for Domain Names 1, 2 and 3 is listed as the United States which gives rise to the presumption that the Respondent understands English;
- The Domain Names are in Latin characters rather than Chinese;
- The language of the registration agreement for the other Domain Names is English;
- The Websites connected to Domain Names 5 and 6 are in English which shows it has the facility to communicate in English;
- English is the international language of business, negotiations, and administrative matters as well as for Internet and computer related matters; and
- The Complainant having to translate the Complaint into Chinese would unfairly disadvantage and burden the Complainant in terms of costs and delay the proceeding and adjudication of this matter.

The Respondent has not challenged the Complainant’s language request and in fact has failed to file a response in either English or Chinese.

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 3.0](#), section 4.5.1).

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 the Complainant’s trade mark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.4.

The Panel finds the entirety of the Trade Mark is reproduced within the Domain Names. Accordingly, these Domain Names are identical or confusingly similar to the Trade Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, “vips”, “svip”, “style”, “sport”, “outlet”, “scarpe”, “vip”, and “online”, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the Domain Names and the Trade Mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 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 the 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.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Names. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Names such as those enumerated in the Policy or otherwise.

Moreover, the nature of some Domain Names (e.g. Domain Names <premiata.online> and <premiataoutlet.com>) is inherently misleading as they effectively impersonate or suggest sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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.

In the present case, the Panel notes that the Respondent must have been aware of the Trade Mark when it registered the Domain Names given the fame of the Trade Mark. It is therefore implausible that the Respondent was unaware of the Complainant when it registered the Domain Names.

In the [WIPO Overview 3.0](#), section 3.2.2 states as follows:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

The fact that there is a clear absence of rights or legitimate interests coupled with the Respondent’s choice of the nine Domain Names without any explanation is also a significant factor to consider (as stated in [WIPO Overview 3.0](#), section 3.2.1). The Domain Names fall into the category stated above and the Panel finds that registration is in bad faith.

The Domain Names are also being used in bad faith. The use of unauthorised images from the Complainant's website and the purported offer for sale of products bearing the Trade Mark at discounted prices at some of the Websites is clear indication of use for illegal activity. Either the products sold are counterfeit or no products are being delivered after payment. Further, the large number of Domain Names involved is an indication of a serial cybersquatting ring involved in illegal activity.

The content of some of the Websites is calculated to give the impression they have been authorized by or connected to the Complainant when this is not the case. These Websites were set up to deliberately mislead Internet users that they are connected to, authorised by, or affiliated with the Complainant. From the above, the Panel concludes that the Respondent has intentionally attempted to attract, for commercial gain, by misleading Internet users into believing that the Respondent's Websites and the products purportedly offered for sale and sold on them are those of or authorised or endorsed by the Complainant.

With respect to the Domain Names which redirect to "www.amazon.com", these redirections have been set up for the commercial benefit of the Respondent. It is highly likely that Internet users when typing the Domain Names into their browser or finding them through a search engine would have been looking for a site operated by the Complainant rather than the Respondent. The Domain Names are likely to confuse Internet users trying to find the Complainant's official website. Such confusion will inevitably result due to the fact that all the Domain Names comprise the Trade Mark in its entirety.

The Respondent employs the fame of the Trade Mark to mislead Internet users into visiting the Websites instead of the Complainant's. From the above, the Panel concludes that the Respondent intentionally attempted to attract for commercial gain, by misleading Internet users into believing that the Respondent's Websites is that of or authorised or endorsed by the Complainant.

The Panel therefore also concludes that the Domain Names were registered and are being used in bad faith under paragraph 4(b)(iv) of the Policy.

The fact that some of the Domain Names may have been inactive does not prevent a finding of bad faith given that the distinctiveness and reputation of the Trade Mark, the composition of the Domain Names, the lack of a response from the Respondent, and the Domain Names are all under common control of a single person or entity which are using the other Domain Names for nefarious purposes.

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 Names <premiata.online>, <premiataonlinevip.com>, <premiataoutlet.com>, <premiatasport.com>, <premiastyle.com>, <premiatasvip.com>, <premiatavip.com>, <premiatavips.com> and <scarpepremiataoutlet.com> be transferred to the Complainant.

*/Karen Fong/*

**Karen Fong**

Sole Panelist

Date: January 3, 2024