

## **ADMINISTRATIVE PANEL DECISION**

Richard Ginori S.r.l. v. zhu yong hua  
Case No. D2023-4725

### **1. The Parties**

The Complainant is Richard Ginori S.r.l., Italy, represented by Studio Barbero, Italy.

The Respondent is zhu yong hua, China.

### **2. The Domain Names and Registrar**

The disputed domain names <ginori1735sale-it.shop>, <ginori1735saleit.shop>, <ginori1735sale.top>, and <ginori1735sale.vip> are 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 November 14, 2023. On November 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 15, 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 in English on November 17, 2023.

On November 15, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain names is Chinese. On November 17, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in English and in Chinese of the Complaint, and the proceedings commenced on November 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 15, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on January 10, 2024. 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 company headquartered in Italy with origins dating back to 1735 and has grown into a well-known producer and seller of porcelain and ceramic products, such as tableware and decorative artistic products. In 2013, Società Ceramica Richard Ginori was acquired by Gucci, joining the Kering Group, and Alessandro Michele became its artistic director. The Complainant's trademarks and products have received wide press coverage and various awards and can be considered well-known.

The Complainant owns an international portfolio of registered trademarks with the main element GINORI, e.g., International Trademark Registration No. 1570910 for GINORI 1735 ITALIA (figurative mark) of September 18, 2020, in classes 3, 4, 8, 11, 20, 21, 24, 27, 35, and 43, designating also China; European Union Trade Mark Registration No. 013153333 for RICHARD GINORI of December 29, 2014; and Chinese Trademark Registration No. 12463789 for RICHARD GINORI 1735 (figurative mark), registered on December 28, 2014, in class 24. The Complainant also has a strong online presence and owns and uses a portfolio of domain names including <ginori1735.com>.

The disputed domain names were registered by the Respondent on November 4 and November 5, 2023, and pointed to websites in Italian, featuring the Complainant's trademarks (also as favicon) and images and text content taken from the Complainant's website "www.ginori1735.com", and offering for sale purported Complainant's products at discounted prices. However, on the date of this Decision, the disputed domain names direct to inactive websites.

The Complainant also provides evidence that it attempted to settle this matter amicably through a number of cease-and-desist letters, to which it received no answer.

#### **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 disputed domain names.

Notably, the Complainant contends that it is the owner of a number of registered trademarks consisting of GINORI (in various combinations) and that it has a strong reputation for the products under this trademark. The Complainant asserts that the disputed domain names are confusingly similar to the abovementioned trademarks since they each contain the dominant elements of such trademarks and that the Respondent offered counterfeit products under a number of lookalike websites, which were impersonating the Complainant for undue commercial gain. The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain names, which were registered and are used in bad faith.

##### **B. Respondent**

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

## 6. Discussion and Findings

### Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain names 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 several reasons, including the fact that the Complainant communicates in English and would be prejudiced, should it be required to translate the Complaint and participate in this proceeding in Chinese and the fact that the disputed domain names are registered in Latin characters and include the English term “sale” which suggests that the Respondent, despite being apparently based in China, may be familiar with English.

The Respondent did not make any specific 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).

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.

### 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 trademark and the disputed domain names. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the Complainant's marks GINORI 1735 ITALIA, RICHARD GINORI, and RICHARD GINORI 1735 are all clearly recognizable within each of the disputed domain names, since each of the disputed domain names contains the dominant part of these marks. Accordingly, the disputed domain names are confusingly similar to these marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, respectively “sale”, “sale-it” and “saleit”, 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 disputed domain names and the mark for the purposes of the Policy. [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 the Respondent may demonstrate rights or legitimate interests in disputed domain names.

Although 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 domain names may result in the difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed 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 disputed domain names such as those enumerated in the Policy or otherwise.

Moreover, upon review of the facts and evidence, the Panel notes that the Respondent has not provided any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services. Instead, upon review of the facts and the evidence submitted in this proceeding, the Panel notes that the disputed domain names directed to active websites which showed a clear intent on the part of the Respondent to misleadingly pass them off as the Complainant’s websites for commercial gain. In fact, said websites prominently displayed the Complainant’s trademarks and used some of the Complainant’s own product images and text content likely protected by copyright, thereby misleading consumers into believing that the Respondent is at least licensed by, or affiliated with the Complainant and/or its trademarks. Moreover, the Panel also accepts that, given the unclear origin, the lack of any accurately and prominently disclaimer and false suggestions of affiliation on the Respondent’s websites and given the heavily discounted product prices, it is very likely that the products offered by the Respondent on such websites were counterfeit products. Moreover, even if the products were legitimate products, it is clear to the Panel from the foregoing elements that the Respondent is not a good faith provider of goods or services under the disputed domain names, see also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Given the abovementioned elements, the Panel concludes that the Respondent’s use does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain names.

However, the Panel notes that on the date of this Decision, the disputed domain names direct to inactive or blank webpages. In this regard, the Panel finds that holding domain names passively, without making any use of them, also does not confer any rights or legitimate interests in the disputed domain names on the Respondent (see in this regard earlier UDRP decisions such as *Bollere SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#); and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

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.

Given the intensive use, fame and distinctiveness of the Complainant’s prior registered trademarks, the Panel finds that the subsequent registration of the disputed domain names, which are confusingly similar to such marks, clearly and consciously targeted the Complainant’s prior registered trademarks (which have been held by prior panels applying the UDRP to be famous, see for instance *Richard Ginori S.r.l. v. Hongxia Zheng*, WIPO Case No. [D2023-2094](#)). The Panel therefore deducts from the Respondent’s efforts to consciously target the Complainant’s well-known prior trademarks that the Respondent knew of the

existence of the Complainant's trademarks at the time of registering the disputed domain names. This finding is confirmed by the fact that the websites linked to the disputed domain names were used to offer for sale presumably counterfeit products imitating the Complainant's products, since this proves that the Respondent was fully aware of the Complainant's business and its prior well-known trademarks. In the Panel's view, the foregoing elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain names in bad faith.

As to use of the disputed domain names in bad faith, the Complainant provides evidence that the disputed domain names directed to active websites which showed a clear intent on the part of the Respondent to misleadingly pass them off as the Complainant's websites, displaying the Complainant's trademarks, some of its official product images and text content (thereby likely violating the Complainant's copyrights), and offering products for sale that are likely counterfeit products due to their heavily discounted prices and unclear origin. The Panel concludes from these facts that the Respondent is intentionally attracting Internet users for commercial gain to such websites, by creating consumer confusion between the websites associated with the disputed domain names and the Complainant's trademarks. This constitutes direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. The Panel therefore finds that it has been demonstrated that the Respondent has used and is using the disputed domain names in bad faith.

However, the Panel notes that on the date of this Decision, the disputed domain names direct to inactive or blank webpages. Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and well-known nature of the Complainant's trademarks and the composition of the disputed domain names and the unlikelihood of any good faith use of the disputed domain names by the Respondent and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third 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 names <ginori1735sale-it.shop>, <ginori1735saleit.shop>, <ginori1735sale.top>, and <ginori1735sale.vip> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: January 19, 2024