

ADMINISTRATIVE PANEL DECISION

Valentino S.p.A. v. Josie Kendall
Case No. D2023-4979

1. The Parties

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

The Respondent is Josie Kendall, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <valentinosoutlets.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 29, 2023. On November 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 30, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 1, 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 amended Complaint on December 4, 2023.

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 Respondent of the Complaint, and the proceedings commenced on December 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 5, 2024.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on January 16, 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 an Italian luxury fashion house founded in 1960, with stores located in over 90 countries. The Complainant is the owner of registered trademarks in the mark VALENTINO, amongst which:

European Union Trademark No. 001990407 for VALENTINO, registered on September 18, 2008, in International Classes 3, 9, 14, 16, 18, 19, 20, 21, 24, 25, 27, 34, and 35; and

United States Trademark No. 910955 for VALENTINO, registered on April 6, 1971, in International Class 25.

The Complainant also owns domain names incorporating the mark VALENTINO, such as <valentino.com>, <valentino-outlet.com> and <valentinooutlet.com>. The first domain name is used for its official website “www.valentino.com”. The website “www.valentino.com” provides information about the Complainant’s brand and products and an online store where the Complainant’s branded goods are advertised and offered for sale.

The disputed domain name was registered on December 15, 2022, well after the Complainant secured rights in the mark VALENTINO. According to evidence submitted by the Complainant, the disputed domain name first resolved to a website featuring the Complainant’s trademarks V logo, VALENTINO, ROCKSTUD and VALENTINO GARAVANI, publishing images taken from the Complainant’s official advertising campaigns and offering for sale purported VALENTINO products at discounted prices, in absence of any information about the actual person or entity operating the website.

Subsequently, the disputed domain name redirected to the website “www.tfsbags.com”, a website offering for sale purported VALENTINO products along with goods of the Complainant’s competitors (such as Alexander McQueen, Balenciaga, Bottega Veneta, Burberry, Celine, Dior, Fendi, Hermes Loewe, Moncler, Off White, Prada and YSL) at discounted prices that are significantly lower than on the official “www.valentino.com” website, as demonstrated by evidence submitted by the Complainant. Finally, the Complainant shows that at the time of drafting the Complaint, the disputed domain name resolved to an error page.

Moreover, the evidence submitted by the Complainant suggests that the disputed domain name may also be used in connection with the sending and receipt of potentially fraudulent email communications from email addresses based on the disputed domain name, *i.e.*, “[...]@valentinosoutlets.com”.

The Complainant issued a cease-and-desist letter to the Respondent on December 23, 2022, in which it requested the Respondent to cease use of the disputed domain name for a website featuring the Complainant’s trademarks and offering purported VALENTINO goods for sale and transfer the disputed domain name to the Complainant. While the Respondent did not respond to this letter, the redirection of the disputed domain name did change to the website “www.tfsbags.com”, seemingly as a result of this letter. The Complainant issued another cease and desist letter on January 19, 2023, which the Respondent, again, failed to respond to.

On the same day that the Complainant issued its first cease and desist letter to the Respondent, December 23, 2022, it also issued a cease-and-desist letter to the hosting provider of the website to which the disputed domain name resolved, requesting the deactivation of such website. The Complainant’s letter remained unanswered and the same applied to the reminders issued on January 19, 2023, and January 24, 2023. However, as detailed above, the redirection of the disputed domain name to the website “www.tfsbags.com” was deactivated, seemingly as a result of the Complainant’s letters.

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 name.

Notably, the Complainant claims that it has rights in the mark VALENTINO and that the disputed domain name is confusingly similar to this mark. They point out that the disputed domain name incorporates the VALENTINO mark in its entirety and argue that the disputed domain name differs from the Complainant's trademark by the mere addition of the letter "s" and the non-distinctive element "outlets", which does not affect the confusing similarity. In fact, the addition of the term "outlets" reinforces the likelihood of confusion as the term "outlets" is descriptive of locations where consumers can shop for brand-name items at a discount. As for the addition of the suffix ".com", the Complainant points out that many prior Panels found that the addition of a top-level domain is merely instrumental to the use of the Internet and shall thus be disregarded in the assessment of confusing similarity.

Furthermore, the Complainant claims that the Respondent lacks a right or legitimate interest in the disputed domain name. The Complainant contends that the Respondent does not have any trademark rights to the term "valentino" and is not commonly known by "valentino" or any similar term. In addition, the Complainant points out that there is also no evidence that the Respondent retains any unregistered trademarks to the term "valentino", nor any similar term. Moreover, the Complainant confirms that the Respondent is not an employee, licensee, affiliate or authorized agent of the Complainant or in any other way authorized to use the VALENTINO trademark. Finally, the Complainant asserts that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a bona fide offering of goods or services. The Complainant points to the fact that the disputed domain name previously redirected to a website featuring the Complainant's trademarks and official advertising images and offering for sale purported VALENTINO products at discounted prices without providing any disclaimer as to the Respondent's lack of relationship with the Complainant. Following receipt of the Complainant's cease and desist letters, the Respondent redirected the disputed domain name to the website "www.tfsbags.com", a website offering for sale counterfeit VALENTINO products and competitors' products (explicitly defined as "AAA+ High Quality 1:1 Goods").

According to the Complainant, such conduct demonstrates that the Respondent did not intend to use the disputed domain name in connection with any legitimate purpose; indeed, the Complainant concludes, the Respondent's use 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 undoubtedly attempting to gain from the offer for sale of the products advertised on the websites to which the disputed domain name resolved, by free-riding the well-known character of the Complainant's trademark and causing confusion amongst users as to the source or affiliation of the websites and the products offered for sale therein. The Complainant adds that, irrespectively of the nature of the products offered for sale on the Respondent's websites, no fair use could be possibly invoked in the present case by the Respondent, since it has failed to accurately disclose their (lack of) relationship with the VALENTINO trademark, thus generating a clear likelihood of confusion amongst Internet users, and has also used the disputed domain name to advertise and offer for sale products not originating only from the Complainant. Finally, the Complainant argues that even the current redirection of the disputed domain name to an error page, i.e., passive use, cannot be considered a bona fide offering of goods or services nor legitimate noncommercial or fair use of the disputed domain name.

As to the assessment of the Respondent's bad faith at the time of registrations, the Complainant contends that in light of the extensive use of the trademark VALENTINO since as early as 1960, and the amount of advertising and sales of the Complainant's products worldwide, including online via the Complainant's website "www.valentino.com", the Respondent could not have possibly ignored the existence of the Complainant's trademark VALENTINO when it registered the disputed domain name, with which it is confusingly similar. The Complainant also points out that the well-known character of the trademark

VALENTINO has been recognized in prior UDRP decisions. Indeed, the Complainant adds, the fact that purported VALENTINO products were offered for sale on the websites to which the disputed domain name resolved, indicates that the Respondent was fully aware of the Complainant and its trademarks. According to the Complainant, this conduct also clearly indicates that the Respondent's purpose in registering the disputed domain name was to capitalize on the reputation of the Complainant's VALENTINO trademark, by attracting Internet users seeking the Complainant's branded products to its websites for commercial gain and intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its websites and the goods offered and promoted through said websites, in accordance with paragraph 4(b)(iv) of the Policy.

As to bad faith use, relying on the passive use doctrine set down in the *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), the Complainant points out that the current direction of the disputed domain name to an error page does not prevent a finding of bad faith use. The Complainant contends that many Panels have held that the non-use of the disputed domain name while the corresponding trademark is wellknown, is evidence of bad faith. In addition, the Complainant claims that, considering (i) the degree of distinctiveness and reputation of the Complainant's trademark VALENTINO, (ii) the absence of any evidence of actual or contemplated good-faith use of the disputed domain name, which was anyway previously redirected to infringing websites, (iii) the Respondent's concealing its identity, and (iv) the implausibility of any good faith use to which the disputed domain name may be put in the future, the Respondent's current passive holding of the disputed domain name shall not prevent a finding of bad faith use.

Moreover, the Complainant points out that, as mentioned above, the Respondent has set up Mail exchanges ("MX records") for the disputed domain name, meaning that currently it might be being used for, or in the future may be used for, email communication. In view of the confusing similarity of the disputed domain name with the Complainant's trademark VALENTINO, the Complainant claims that also the configuration of the disputed domain name for use in connection with email communication amounts to bad faith use. Finally, the Complainant notes that the Respondent did not reply to the Complainant's cease-and-desist letter and that prior panels have held this as another indicator of bad faith.

B. Respondent

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

6. Discussion and Findings

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 name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here the letter "s" and the term "outlets", 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 name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Finally, as for the applicable generic Top-Level domain (“gTLD”) “.com”, the Panel holds that this can be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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.

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 a domain name 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 name. 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 name such as those enumerated in the Policy or otherwise.

The Panel finds that the Respondent has not made a legitimate noncommercial or fair use of the disputed domain name. The Complainant has shown that the disputed domain name previously resolved to websites using, without the Complainant’s permission, the Complainant’s branding and trademarks and offering what appear to be counterfeit VALENTINO products. The disputed domain name currently resolves to an error page. This kind of use of the disputed domain name does not represent a bona fide offering and does not support rights or legitimate interests in the disputed domain name. [WIPO Overview 3.0](#), section 2.9.

Panels have held that the use of a domain name for illegal activity, here, claimed sale of counterfeit VALENTINO goods, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

In addition, the Complainant confirmed that the Respondent is not affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant’s trademarks. The Panel has taken note of the Complainant’s confirmation in this regard and has not seen any evidence that would suggest the contrary. In the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

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 intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's marks (Paragraph 4(b)(iv) of the Policy). The disputed domain name previously resolved to websites using the Complainant's branding and trademarks and offering what appear to be counterfeit VALENTINO products. These circumstances, in combination with the Respondent's clear absence of rights or legitimate interests in the disputed domain name, are strong indicators of bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the Complainant's VALENTINO trademark. As demonstrated by the Complainant, such trademarks were registered many years before the registration of the disputed domain name in several countries including the United States, the country of residence of the Respondent according to the Whois records. Furthermore, the disputed domain name incorporates the VALENTINO trademark in its entirety and includes the letter "s" and the descriptive term "outlets", which refers to locations where consumers can shop for brand name items at a discount. Moreover, the disputed domain name previously resolved to websites using, without the Complainant's permission, the Complainant's branding and trademarks and offering what appear to be counterfeit VALENTINO products. This indicates that the Respondent had the Complainant and its trademarks in mind when registering the disputed domain name. The Respondent's knowledge of the Complainant and its trademarks and therefore its registration in bad faith of the disputed domain name may accordingly be inferred from these circumstances. [WIPO Overview 3.0](#), section 3.2.2.

Furthermore, panels have found that the non-use of a domain name (including an error 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 name 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](#), sections 3.3 and 3.6. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's VALENTINO trademark, the composition of the disputed domain name (discussed above), the failure of the respondent to respond to cease-and-desist letters and submit a response to the Complaint, as well as the use by the Respondent of a privacy service to conceal its identity. Accordingly, the Panel finds that in the circumstances of this case, the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Moreover, the Complainant has shown that the Respondent has set up MX records for the disputed domain name, meaning that currently it might be being used for, or in the future may be used for, email communication. In view of the confusing similarity of the disputed domain name with the Complainant's trademark VALENTINO, the Respondent's retention of control of the disputed domain name represents an implied and ongoing threat to the Complainant, which further supports a finding of bad faith. Finally, panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit VALENTINO goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes 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 name <valentinosoutlets.com> be transferred to the Complainant.

/Benoit Van Asbroeck/

Benoit Van Asbroeck

Sole Panelist

Date: January 30, 2024