

ADMINISTRATIVE PANEL DECISION

Prada S.A. v. joseney TANG, anqf kiuo, paul tang, qingtian company,
hemera zhang, alisi xi, anqf kiuo
Case No. D2024-0601

1. The Parties

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

The Respondent is joseney TANG, China, anqf kiuo, United States of America (the “United States”), paul tang, qingtian company, China, hemera zhang, China, alisi xi, China, and anqf kiuo, United States.

2. The Disputed Domain Names and Registrar

The disputed domain names, <cheappradabagsaustralia.org>, <fakepradaaustralia.com>, <pradaoutletaustralia.org>, <pradaoutletspain.org>, <fakepradabagsuk.org>, <pradasaleuk.org>, and <replicapradasaleaustralia.org>, are registered with NameCheap, Inc.; the disputed domain names, <bolsapradafalsa.com>, <cheappradabags.com>, <cheappradabagsusa.com>, <cheappradasale.com>, <fakepradasalesusa.com>, <falsopradasaldi.org>, <fauxpradapascher.com>, <fauxpradatasker.org>, <pradabaratooutlet.org>, <pradadonnaeconomico.org>, <pradafemmesoldes.com>, <pradaoutletdenmark.com>, <pradaoutletfrance.com>, <pradaoutletitaly.com>, <pradaoutletonline.com>, <pradaoutletportugal.com>, <pradaoutletsusa.com>, <replicapradabags.com>, <replicapradafeminino.org>, <replicapradauomo.com>, <replicapradausa.com>, <udsalgpradabillig.org> and <billigepradasko.com>, are registered with GoDaddy.com, LLC; the disputed domain names, <pradaoutletgermany.com>, <pradaherrensale.com>, <taschepradareplik.com>, are registered with Name.com, Inc. (Collectively the “Registrars”.)

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2024. On February 9, 2024, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On February 9, 2024, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on February 13, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaints 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 amendment to the Complaint on February 14, 2024.

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 February 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2024. The Respondent did not submit any formal response. The Center notified the Commencement of Panel Appointment Process on March 8, 2024. The Respondent sent automatic confirmation of receipts email communications to the Center on February 13, 16, and 20, 2024, and March 8, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on March 13, 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 manufacturer of luxury accessories and clothing, with a history dating back in 1913 when Mario Prada opened a luxury store in the Galleria Vittorio Emanuele II in Milan, selling leather handbags, travelling trunks, leather accessories and beauty cases. In 1919, the Complainant became an official supplier of the Italian Royal family.

Through associations and acquisitions, the Complainant currently operates in 70 countries with approximately 13,700 employees and the Complainant's Group has developed a strong network of directly operated stores encompassing Europe (209), America (104), Japan (86), Middle East and Africa (23) and Asia Pacific (190), accompanied by franchise stores and a significant presence in selected high-end multi-brand stores and luxury department stores.

The Complainant owns numerous worldwide trademark registrations for the mark PRADA, such as the following:

- the Italian trademark registration number 362017000069322 for the word PRADA, filed on July 27, 1977, and registered on July 8, 1978, covering goods in International classes 14, 16, 18 and 25; and
- the International trademark registration number 650695 for the word PRADA (stylized), registered on December 15, 1995, covering goods in International classes 3, 5, 9, 14, 18, 24, 25 and covering numerous jurisdictions including, inter alia, China.

The Complainant owns over 260 domain names consisting of or comprising PRADA, including the domain name <prada.com> registered on June 9, 1997.

The disputed domain names were registered as follows:

- on April 7, 2023, were registered <bolsapradafalsa.com>, <pradabaratooutlet.org>, <pradaoutletportugal.com>, and <replicapradafeminino.org>;

- on April 8, 2023, were registered <billigpradasko.com>, <fauxpradatasker.org>, <pradaoutletdenmark.com>, and <udsalgpradabillig.org>;
- on April 9, 2023, were registered <cheappradabags.com>, and <cheappradasale.com>;
- on April 10, 2023, were registered <fauxpradapascher.com>, <pradafemmesoldes.com>, <pradaoutletfrance.com>, <pradaoutletonline.com>, <replicapradabags.com>;
- on April 11, 2023, were registered <pradaherrensale.com>, <pradaoutletgermany.com>, and <taschepradareplik.com>;
- on April 12, 2023, were registered <falsopradasaldi.org>, <pradadonnaeconomico.org>, <pradaoutletitaly.com>, and <replicapradauomo.com>;
- on April 13, 2023, was registered <fakepradasalesusa.com>;
- on April 14, 2023, were registered <cheappradabagsusa.com>, <pradaoutletsusa.com>, and <replicapradausa.com>;
- on April 18, 2023, were registered <cheappradabagsaustralia.org>, <fakepradaaustralia.com>, <pradaoutletaustalia.org>, and <replicapradasaleaustralia.org>;
- on January 20, 2024, was registered <pradaoutletspain.org>; and
- on January 23, 2024, were registered <fakepradabagsuk.org>, and <pradasaleuk.org>.

At the time of filing the Complaint all the disputed domain names were redirected to a commercial website, "www.daviwholesale.ru" dedicated to the sale of various luxury products at discounted prices, goods bearing the Complainant's PRADA trademark as well as third parties' trademarks. Also, the website under the disputed domain names was displaying the Complainant's trademark and product images, and no accurate information regarding the Respondent's lack of relationship with the Complainant was provided.

The Complainant sent a Cease-and-Desist letter to the Respondent on January 30, 2024, but no reaction was received.

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 its PRADA trademark is well-known worldwide being used since early 1913 in connection with the Complainant's advertising and sales of PRADA products and has been widely publicized globally and constantly featured through the Internet; the well-known character of PRADA trademark has been recognized in numerous UDRP decisions; the disputed domain names are confusingly similar to its trademark as they incorporate the trademark PRADA with additional geographical or generic/descriptive terms; that the Respondent has no rights or legitimate interests in the disputed domain names; and that the Respondent registered and is using the disputed domain names in bad faith to redirect Internet users to a commercial website, offering for sale prima facie counterfeit PRADA and third parties' branded products, clearly indicating that the Respondent's purpose in registering the disputed domain names was to capitalize on the reputation of the Complainant's trademark; the Respondent registered 33 disputed domain names, all containing the Complainant's trademark, therefore the Respondent registered

the disputed domain names in order to prevent the Complainant from reflecting its trademark in corresponding domain names and has engaged in a pattern of bad faith conduct.

B. Respondent

The Respondent did not reply to the Complainant's contentions, except for the automatic confirmation of receipt emails communications to the Center notifications regarding the proceedings.

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

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 disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain names 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 disputed 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 that the disputed domain names (i) are all used in the same manner, being redirected to the same website; (ii) have registrants with similar email address ending in "@126.com", have numerous similarities in their Registrars, names, addresses, phone numbers; (iii) were created in a similar manner, incorporating the Complainant's trademark PRADA together with additional generic, descriptive or geographical terms; and (iv) were registered within a short timeframe, between April 7, 2023 and January 23, 2024.

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 disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

B. 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. See section 1.7 of the [WIPO Overview 3.0](#).

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 the mark is recognizable within the disputed domain names. Accordingly, each of the disputed domain names is confusingly similar to the mark for the purposes of the Policy.

[WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, -such as "outlet", "outlets", "sale", "replik" ("replica" in Norwegian), "billige" ("cheap" in Danish), "falsa" ("fake" in Spanish), "cheap", "fake", "falso" ("fake" in Italian), saldi ("sales" in Italian), "faux", "pascher" ("cheap" in French), "barato" ("cheap" in Spanish), "economico" ("cheap" in Italian), soldes ("sales" in French), "barato" ("cheap" in Spanish), "replica", "falsa" ("fake" in Spanish), "udsalg" ("sale" in Danish), "billig" ("cheap" in Norwegian), "online"; "germany", "france", "denmark", "portugal", "spain", "italy", "australia"; combination of letters which may be interpreted as a country code, such as "uk" and "usa"; "herren" ("men" in German), "tasche" ("bag" in German), "bolsa" ("bag" in Spanish), "sko" ("shoes" in Danish), "bags", "tasker" ("bags" in Danish), "donna" ("woman" in Italian), "femme" ("women" in French), "feminino" ("women" in Portuguese) and "uomo" ("man" in Italian),- 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.

The Panel finds the first element of the Policy has been established.

C. 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 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.

According to the evidence provided in the Complaint, the Respondent has used the disputed domain names in connection with a website promoting and offering for sale, most likely counterfeit goods of the Complainant, and third parties. The use of the words "fake", "replica" or other similar terms in some of the disputed domain names shows further evidence that the disputed domain names resolve to website advertising and offering for sale counterfeit PRADA goods. Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Further, the composition of the disputed domain names which combine the Complainant's trademark with geographical terms and/or dictionary terms referring to the Complainant's products or otherwise, suggests an affiliation with the trademark owner. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

D. 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 disputed domain names were registered in bad faith, with knowledge of the Complainant and its trademark particularly because of their significant number, short timeframe of registration, and their composition. Furthermore, the use of the disputed domain names enforces such finding.

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.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain names incorporate the Complainant's trademark with additional geographical, or terms related to the Complainant's industry, and the website operated under the disputed domain names display the Complainant's trademark and product images, and the lack of complete and reliable information about the entity operating the website under the disputed domain names, indeed in this Panel's view, the Respondent has intended to attract Internet users accessing the website corresponding to the disputed domain names who may be confused and believe that the website is held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain.

Paragraph 4(b)(ii) of the Policy provides another circumstance of bad faith registration and use when the respondent registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. The Panel finds that registering for 33 disputed domain names incorporating the Complainant's trademark, definitely constitutes a pattern of abusive conduct and registration of the disputed domain names in bad faith.

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 disputed domain names, <billigepradasko.com>, <bolsapradafalsa.com>, <cheappradabagsaustralia.org>, <cheappradabags.com>, <cheappradabagsusa.com>, <cheappradasale.com>, <fakepradaaustralia.com>, <fakepradabagsuk.org>, <fakepradasalesusa.com>, <falsopradasaldi.org>, <fauxpradapascher.com>, <fauxpradatasker.org>, <pradabaratooutlet.org>, <pradadonnaeconomico.org>, <pradafemmesoldes.com>, <pradaherrensale.com>, <pradaoutletaustralia.org>, <pradaoutletdenmark.com>, <pradaoutletfrance.com>, <pradaoutletgermany.com>, <pradaoutletitaly.com>, <pradaoutletonline.com>, <pradaoutletportugal.com>, <pradaoutletspain.org>, <pradaoutletsusa.com>, <pradasaleuk.org>, <replicapradabags.com>, <replicapradafeminino.org>, <replicapradasaleaustralia.org>, <replicapradauomo.com>, <replicapradausa.com>, <taschepradareplik.com>, and <udsalgpradabillig.org>, be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: March 27, 2024