

ARBITRATION AND MEDIATION CENTER

ADMINISTRATIVE PANEL DECISION

Prada S.A. v. Client Care, Web Commerce Communications Limited, Yasmin Wall, Harry Baldwin, Isabelle Woodward, Ethan Heath, Oliver Morton, Louie Hargreaves, Toby Hodgson, TobyHodgson, Isabelle Gibbs, IsabelleGibbs, Aiiius Iuisa
Case No. D2024-1208

1. The Parties

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

The Respondents are Client Care, Web Commerce Communications Limited, Malaysia, Yasmin Wall, Germany, Harry Baldwin, Germany, Isabelle Woodward, Germany, Ethan Heath, Germany, Oliver Morton, Germany, Louie Hargreaves, Germany, Toby Hodgson, TobyHodgson, Belgium, Isabelle Gibbs, Isabelle Gibbs, Belgium, and Aiiius Iuisa, United States of America.

2. The Disputed Domain Names and Registrars

The disputed domain names <miumiuargentinashop.com>, <miumiubrasil.com>, <miumiuchilesale.com>, <miumiucolombiastore.com>, <miumiucostarica.com>, <miumiuecuador.com>, <miumiufactoryoutletuk.com>, <miumiu-india.com>, <miumiumexicoshop.com>, <miumiuperuonline.com>, <miumiu-portugal.com>, <miumiuportugalshop.com>, <miu-miuturkey.com>, <miumiuuruguay.com>, <miumiuwellington.com>, <pradaakcija.com>, <pradaargentina.com>, <pradaaroutlet.com>, <pradabagsuae.com>, <pradabelgie.com>, <pradabelgiewinkel.com>, <pradabelgique.com>, <prada-cz.com>, <pradacz.com>, <pradaecuador.com>, <pradaegypt.com>, <pradaespana.com>, <pradajapanretro.com>, <pradajapansale.com>, <pradakuwait.com>, <pradalatvija.com>, <pradaslovenija.com>, <pradaslovensko.com>, <prada-spain.com>, <pradasrbija.com>,

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 19, 2024. On March 21 and 26, 2024, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On March 25 and 28, 2024, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the disputed domain names, which differed from the named Respondents (Not Disclosed and REDACTED FOR PRIVACY) and contact information in the Complaint.

The Center sent an email communication to the Complainant on March 28, 2024, with the registrants 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 and/or that all domain names are under common control. The Complainant filed an amendment to the Complaint on March 29, 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 Respondents of the Complaint, and the proceedings commenced on April 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 23, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on April 24, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on April 26, 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 trucks, leather accessories, and beauty cases. In 1919, the Complainant became an official supplier of the Italian Royal family.

In 1993, Ms. Miuccia Prada established a new brand – MIU MIU - designed for women and offering ready-to-wear, leather goods, and shoes. In 2022, the MIU MIU brand was awarded "Brand of the year" by Lyst.

Through associations and acquisitions, the Complainant currently operates in 70 countries with approximately 13,988 employees and the Complainant's Group has developed a strong network of directly

operated stores encompassing Europe (229), America (107), Japan (85), Middle East and Africa (22), and Asia Pacific (198), 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 marks PRADA and MIU MIU, such as the following:

- the European Union trademark registration number 271163 for PRADA (word), filed on September 3, 1996, and registered on November 8, 2000, covering goods in International classes 9, 16, and 21;
- the Malaysian trademark registration number 97006324 for PRADA (stylized word), registered on August 22, 2007, covering goods in International class 18;
- the European Union trademark registration number 004253191 for MIU MIU (word), filed on January 25, 2005, and registered on February 16, 2006, covering goods in International classes 18 and 25; and
- the Malaysian trademark registration number 93000242 for MIU MIU (word), registered on October 18, 1995, covering goods in International class 18.

The disputed domain names were registered as follows:

- on March 17, 2022, were registered com>, com>, com>, and com>, com>;
- on March 24, 2022, were registered <prada-hungary.com> and <prada-spain.com>;
- on March 6, 2023, was registered <miumiu-india.com>;
- on March 7, 2023, was registered <miumiufactoryoutletuk.com>;
- on March 8, 2023, were registered <miumiu-portugal.com>, <miumiuecuador.com>, and <miumiucostarica.com>;
- on May 25, 2023, were registered <miumiubrasil.com>, <miumiuchilesale.com>, <miumiumexicoshop.com>, <miumiuuruguay.com>, <miumiucolombiastore.com>, <miumiuperuonline.com>, <miumiuargentinashop.com>, and <miumiuportugalshop.com>;
- on June 8, 2023, were registered <pradaargentina.com>, <pradaaustore.com>, <pradabelgiewinkel.com>,</pradabelgique.com>, <pradabrasil.com>, <pradabulgaria.com>, <pradacanadasale.com>,</pradacolombia.com>, <pradacz.com>, <pradairelandshop.com>, <pradairel.com>,</pradairelandshop.com>, <pradaletuva.com>, <pradanlshop.com>,</pradanzoutlet.com>, <pradaonlineuae.com>, <pradaperu.com>, <pradaportugalsale.com>,</pradaromania.com>, <pradaschweiz.com>, <pradaslovenija.com>, <pradasromania.com>,</pradasuomioutlet.com>, <pradauruguay.com>;
- on June 12, 2023, were registered compart of pradaustralia on lie.compart of pradaconal adaptite.compart of pradaconal accompart of pradaconal on lie.compart on lie.compart of pradaconal on lie.compart of lie.compart of lie.compart of lie.compart of lie.compart of lie.c

- on June 15, 2023, were registered compare compare compared compared
- on August 11, 2023, were registered <pradaakcija.com>, <pradaaroutlet.com>, <pradacroutlet.com>, <pradaecuador.com>, <pradaegypt.com>, <pradaieshop.com>, <pradaindiaoutlet.com>, <pradaperuoutlet.com>, <pradaperuoutlet.com>, <pradaphshop.com>, <pradatiendachile.com>, <pradatiendacolombia.com>, <pradauaeshop.com>, <pradauruguayuy.com>, <pradaza.com>, <pradaau.com>, <pradabelgie.com>, <pradachschweiz.com>, <pradaespana.com>, <pradahuoutlet.com>, <pradanonorge.com>, <pradaslovensko.com>, <pradastore-uk.com>, and <pradasverige.com>;
- on September 24, 2023, was registered <miu-miuturkey.com>;
- on November 24, 2023, was registered <miumiuwellington.com>;
- on January 8, 2024, was registered registered pradabagsuae.com; and
- on January 22, 2024, was registered pradalisboa.com>.

According to Annex 10 to the Complaint, the disputed domain names were used in relation to commercial websites, featuring the Complainant's trademarks PRADA or MIU MIU, publishing images taken from the Complainant's official advertising campaigns and offering for sale PRADA or MIU MIU products at highly discounted prices. Moreover, the copyright lines of the websites under these disputed domain names claimed copyright protection and no information about the name and identity of the entity operating the websites was provided.

The Complainant sent Cease-and-Desist letters to the Respondents and to the Registrars on October 19 and December 20, 2023, and January 8, 9, and 31, 2024, in relation to part of the disputed domain names. The Respondents did not respond. The content on part of the disputed domain names has been taken down by the Registrar.

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 and MIU MIU trademarks are well-known worldwide being used since early 1913, respectively since 1993, in connection with the Complainant's advertising and sales of PRADA and MIU MIU products and has been widely publicized globally and constantly featured through the Internet; the well-known character of PRADA and MIU MIU trademarks has been recognized in numerous UDRP decisions; the disputed domain names are confusingly similar to its trademarks as they incorporate the trademarks PRADA or MIU MIU with additional geographical, and/or generic/descriptive terms; the Respondents have no rights or legitimate interests in the disputed domain names; the Respondents registered and is using the disputed domain names in bad faith to redirect Internet users to websites featuring the Complainant's trademarks, publishing images of the Complainant's advertising campaigns and offering for sale purported PRADA or MIU MIU products at discounted prices, without providing any disclaimer as to the Respondents' lack of relationship with the Complainant; the disputed domain names are apt to confuse and mislead Internet users into believing that the websites are operated by the Complainant or by an affiliated entity with the Complainant's consent; the very low prices at which the purported products are offered on the websites under the disputed domain names, supports the conclusion that the Respondents are offering for sale prima facie counterfeit products; the use of the disputed domain

names as above detailed clearly indicates that the Respondents' purpose in registering the disputed domain names was to capitalize on the reputation of the Complainant's trademarks; and the Respondents registered 95 disputed domain names, all containing the Complainant's trademarks, therefore the Respondents registered the disputed domain names in order to prevent the Complainant from reflecting its trademarks in corresponding domain names and has engaged in a pattern of bad faith conduct.

B. Respondent

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

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 lares being used in bad faith.

A. Consolidation: Multiple Respondents

The amendment to 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) were used in the same manner, resolving to very similar commercial websites using the Complainant's figurative marks as favicon, publishing the Complainant's trademarks PRADA or MIU MIU, oficial advertising images and offering for sale purported PRADA or MIU MIU products at discounted prices; (ii) are registered in the same generic top Level Domain (gTLD), namely <.com>; (iii) have used privacy protection services and the underlying registrants have numerous similarities such as names, email or postal addresses, state/province and/or country, a pattern of irregularities; (iv) were created in a similar manner, incorporating the Complainant's trademarks PRADA or MIU MIU together with additional generic, descriptive or geographical terms; (v) were registered within a short timeframe, between March 17, 2022 and January 22, 2024, many being grouped in the same day; (vi) have been registered with the same Registrar, except for the disputed domain name regradausaonlinestore.com>; and, (vii) the Respondents have not objected to the consolidation claims made by the Complainant.

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 trademarks 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. <u>WIPO Overview 3.0</u>, section 1.2.1.

The Panel finds the marks PRADA and MIU MIU are easily recognizable within the disputed domain names. Accordingly, each of the disputed domain names is confusingly similar to on of the marks for the purposes of the Policy. WIPO Overview 3.0, section 1.7.

While the addition of other terms - such as the geographical terms related to countries and/or cities, namely "argentina", "australia", "belgie", "belgique" ("Belgium" in French), "brasil", "bulgaria", "canada", "colombia", "costarica", "ecuador", "egypt", "hrvatska" ("Croatia" in Croatian), "india", "philippines", "ireland", "israel", "japan", "kuwait", "latvija" ("Latvia" in Latvian), "lietuva" ("Lithuania" in Latvian), "slovenija" ("Slovenia" in Slovenian), "peru", "polska" ("Poland" in Polish), "portugal", "romania", "schweiz" ("Switzerland" in German), "singapore", "srbija" ("Serbija" in Serbian), "suisse", "suomi" ("Finland" in Finnish), "chile", "turkiye" ("Türkiye" in Turkish), "uruguay", "lisboa", "wellington", "turkey", "mexico", "espana" ("Spain" in Spanish), "hungary", "newzealand", "norge" ("Norway" in Norwegian), "slovensko" ("Slovenian" in Slovak), "spain" and "sverige" ("Sweden" in Swedish); and/or a combination of letters which may be interpreted as a country code/acronym of a city, such as "uae", "ar", "au", "cr", "cz", "ie", "my", "nl", "nz", "ph", "nyc", "uk", "za", "usa", "au", "hu", "no", "gr", "pt", "ch", "uy" and "nz"; and/or generic/misspelled/dictionary terms such as "in", "akcija" ("sale" in Slovenian), "outlet", "store", "factory", "onlie" (which is a misspelling of "online"), "winkel" ("store" in Dutch), "sale", "shop", "online", "tienda" ("store" in Spanish), "bags" - 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 marks 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 as Annex 10 to the Complaint, the Respondent has used the disputed domain names in connection with websites promoting and purportedly offering for sale, more likely than not counterfeit goods of the Complainant. 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. Even if the goods were not counterfeit, given the overall impersonating nature of the disputed domain names (both in their composition and website content that lacks any disclaimer), such use cannot confer rights or legitimate interests upon the Respondent.

Further, the composition of the disputed domain names which combine the Complainant's trademarks with geographical terms and/or non-distinctive 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 trademarks 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 well-known trademarks with additional geographical, generic or terms related to the Complainant's industry, and the websites operated under the disputed domain names display the Complainant's trademarks, official advertising images, claim copyright protection, and fail to provide accurate information about the entity operating the websites under the disputed domain names, indeed in this Panel's view, the Respondent has intended to attract Internet users accessing the websites corresponding to the disputed domain names who may be confused and believe that such websites are held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademarks.

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 95 disputed domain names incorporating the Complainant's trademarks, 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, <miumiuargentinashop.com>, <miumiubrasil.com>, <miumiuchilesale.com>, <miumiucolombiastore.com>, <miumiucostarica.com>, <miumiuecuador.com>, <miumiufactoryoutletuk.com>, <miumiu-india.com>, <miumiumexicoshop.com>, <miumiuperuonline.com>, <miumiu-portugal.com>, <miumiuportugalshop.com>, <miu-miuturkey.com>, <miumiuuruguay.com>, <miumiuwellington.com>, <pradaakcija.com>, <pradaargentina.com>, <pradaaroutlet.com>, <pradaau.com>, <pradaaustore.com>, <pradaaustraliafactory.com>, <pradaaustraliaonlie.com>, <pradabagsuae.com>, <pradabelgie.com>, <pradabelgiewinkel.com>, <pradabelgique.com>, <pradabrasil.com>, <pradabulgaria.com>, <pradacanadaoutlet.com>, <pradacanadasale.com>, <prada-hrvatska.com>, <prada-hungary.com>, <pradahuoutlet.com>, <pradaieshop.com>, <pradajapanretro.com>, <pradajapansale.com>, <pradakuwait.com>, <pradalatvija.com>, <pradaoutletindia.com>, <pradaoutletnz.com>, <pradaoutletpt.com>, <pradaoutletslovenija.com>, <pradaslovenija.com>, <pradaslovensko.com>, <prada-spain.com>, <pradasrbija.com>, and and complainant.

/Marilena Comanescu/ Marilena Comanescu Sole Panelist Date: May 8, 2024