

ADMINISTRATIVE PANEL DECISION

Fendi S.r.l. v. Client Care, Web Commerce Communications Limited
Case No. D2024-1251

1. The Parties

The Complainant is Fendi S.r.l., Italy, represented by Dreyfus & associés, France.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <fendi-argentina.com>, <fendi-australia.com>, <fendibelgie.com>, <fendi-brasil.com>, <fendi-canada.com>, <fendi-chile.com>, <fendi-colombia.com>, <fendi-danmark.com>, <fendi-deutschland.com>, <fendiespana.com>, <fendifactoryoutlet.com>, <fendi-france.com>, <fendi-greece.com>, <fendi-hrvatska.com>, <fendi-india.com>, <fendi-ireland.com>, <fendi-israel.com>, <fendi-italia.com>, <fendimagyarorszag.com>, <fendi-malaysia.com>, <fendi-mexico.com>, <fendi-nederland.com>, <fendi-norge.com>, <fendinz.com>, <fendiosterreich.com>, <fendioutlet-japan.com>, <fendi-peru.com>, <fendiphilippines.com>, <fendipolska.com>, <fendi-portugal.com>, <fendisaleuk.com>, <fendisaudi Arabia.com>, <fendi-singapore.com>, <fendi-srbija.com>, <fendi-suomi.com>, <fendi-turkiye.com>, <fendi-uae.com>, and <fendizurich.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 22, 2024. On March 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 27, 2024, 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 (Data not disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same day, 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 March 29, 2024.

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 April 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 26, 2024.

The Center appointed Olga Zalomyi as the sole panelist in this matter on May 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 an Italian luxury fashion house, specializing in fashion clothing, accessories, and furniture. The Complainant owns numerous FENDI trademark registrations around the world, such as:

- International registration No. 1567986 for the trademark FENDI, registered on July 28, 2020, designating inter alia Australia, the United States of America, Malaysia and Singapore;
- Malaysian registration No. 03002113 for the trademark FENDI, registered on February 24, 2003 and duly renewed.

To promote its goods, the Complainant operates, among others, the domain name <fendi.com>, that was registered on December 26, 1995.

Prior UDRP panels recognized the FENDI trademark as well-known.

The Respondent registered the disputed domain names on September 12, 2023. 36 out of 28 disputed domain names direct to pages with the message "Sorry, you have been blocked". The disputed domain names <fendi-chile.com> and <fendi-srbija.com> direct to identical websites that display the Complainant's trademark and logo, and offer for sale purported Complainant's goods.

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 the disputed domain names are confusingly similar to its well-known FENDI trademarks because the disputed domain names reproduce the Complainant's mark in its entirety. The Complainant argues that the inclusion of the generic terms such as "outlet" or "sale", as well as inclusion or geographical terms and ISO codes "UK", "NZ" and "UAE" fail to alleviate the confusion between the disputed domain names and is insufficient to distinguish the disputed domain names and the Complainant's trademark. The Complainant argues that the addition of the generic Top-Level Domain ("gTLD") ".com" is insufficient to avoid confusing similarity.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain names because (i) the Respondent's is neither affiliated or has been authorized by the Complainant to use its FENDI trademark in the disputed domain names or in any other form; (ii) the Respondent cannot claim prior rights or legitimate interests in the disputed domain names because the FENDI trademark precedes registration of the disputed domain names; (iii) there is no evidence that the Respondent is commonly known by the disputed domain names or the name "FENDI"; (iv) the Respondent has not used or made preparations to use the disputed domain names for bona fide offering of goods or services; (v) the disputed domain names <fendi-chile.com> and <fendi-srbija.com> direct to identical websites that display the Complainant's trademark and goods without a proper disclosure of the Respondent's relationship with the

Complainant; (vi) it is likely that the Respondent is using the disputed domain names to sell counterfeit items that could be hazardous to people's health.

The Complainant asserts that the Respondent registered the disputed domain names in bad faith, as evidenced by the fact that the Respondent registered them with the Complainant's name and trademark in mind. The Complainant argues that its trademark is well-known throughout the world, including Malaysia, whether the Respondent is purportedly located, so it is unlikely that the Respondent did not know about the Complainant's mark at the time of the disputed domain names' registration. The composition of the disputed domain names supports this conclusion because the disputed domain names consist of the Complainant's mark and geographical terms or generic terms targeting the Complainant's business. Additionally, the Complainant highlights that its trademark registrations significantly precede the registration of the disputed domain names, indicating the Respondent's knowledge of the Complainant's name and mark. The Complainant contends that the Respondent's use of the disputed domain names constitutes bad faith, as the composition of the disputed domain names will result in the diversion of Internet traffic from the Complainant's site to the Respondent's site. Furthermore, the Complainant argues that the websites associated with the disputed domain names <fendi-chile.com> and <fendi-srbija.com> create an impression of affiliation with the Complainant by displaying the Complainant's trademark, logo and purported FENDI clothing and accessories, intending to mislead Internet users and create confusion regarding the source, sponsorship, or endorsement of these sites and lead to commercial gain for the Respondent. The Complainant claims that while the rest of the disputed domain names that direct to inactive pages displaying the statement: "Sorry, you have been blocked", such use does not preclude finding of bad faith use because of the strong worldwide reputation of the Complainant's mark and lack of any actual or contemplated good faith use by the Respondent of the disputed domain names. The Complainant submits that it is likely that the Respondent registered the disputed domain names to prevent the Complainant from registering domain names reflecting its name and trademarks. Finally, the Complainant asserts that any claim of good faith use of the disputed domain names is not viable.

B. Respondent

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

6. Discussion and Findings

General discussion

Pursuant to paragraph 4(a) of the Policy, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the disputed domain names:

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

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 Panel finds the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The inclusion of the gTLD “.com” is typically disregarded in the context of the confusing similarity assessment, being a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11.1.

Although the addition of other terms here, “australia”, “belgie”, “brasil”, “canada”, “chile”, “colombia”, “denmark”, “deutschland”, “espana”, “factoryoutlet”, “france”, “greece”, “hvartska”, “india”, “ireland”, “israel”, “italia”, “magyarorzag”, “malasia”, “mexico”, “nederland”, “norge”, “nz”, “osterriech”, “outlet-japan”, “peru”, “phillippines”, “polska”, “portugal”, “saleuk”, “saudiarabia”, “signapore”, “srbija”, “suomi”, “turkiye”, “uae” or, “zurich” 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.

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 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.

The evidence on record shows that the Respondent is not commonly known by the disputed domain names. The Respondent is not making legitimate noncommercial or fair use of the disputed domain names or uses it for bona fide offering of goods or services, because 36 out of 38 disputed domain names do not direct to an active website. The Respondent has not been authorized by the Complainant to use the Complainant’s distinctive trademark in a domain name.

The Respondent’s use of the disputed domain names does not satisfy requirements of bona fide offering of goods and services. Previous UDRP panels have recognized that resellers or distributors using domain names containing the complainant’s trademark to undertake sales of the complainant’s goods may be making a bona fide offering of goods and thus have rights or legitimate interests in such domain names in some situations.

Nor does the use of the remaining two disputed domain name establish any rights or legitimate interests of the Respondent. Outlined in the *Oki Data* case¹, the following cumulative requirements must be satisfied for the respondent to make a bona fide offering of goods and services:

¹ See [WIPO Overview 3.0](#), section 2.8.1; and *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

- “(i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder;
- and
- (iv) the respondent must not try to corner the market in domain names that reflect the trademark.”

Here, the websites at the disputed domain names <fendi-chile.com> and <fendi-srbija.com> create an impression of an affiliation between the Complainant and the Respondent by displaying the Complainant’s trademark, logos and copyright symbols. These websites provide no information about the Respondent or its lack of affiliation with the Complainant.

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 registered 38 disputed domain names that incorporate the Complainant’s and descriptive terms “factory”, “outlet”, or geographical terms or country codes many years after the Complainant’s registration of its trademark. The Respondent’s lack of rights or legitimate interests in the disputed domain names, coupled with the absence of a credible explanation for the Respondent’s choice of the disputed domain names, the well-known status of the Complainant’s trademark and the Respondent’s use of the two disputed domain names that directed to websites that display the Complainant’s trademark and replicate look and feel of the Complainant’s website indicate that the disputed domain names were registered in bad faith.

The UDRP establishes that, for purposes of paragraph 4(a)(iii), “bad faith” registration and use of a domain name can be established by a showing of circumstances indicating that the respondent is using the 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 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. See Policy, paragraph 4(b)(iv).

Prior UDRP panels have found “the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent’s commercial benefit, even if unsuccessful, (iii) the lack of a respondent’s own rights to or legitimate interests in a domain name, (vi) absence of any conceivable good faith use.” WIPO Overview, section 3.1.4.

Here, the websites at the disputed domain names <fendi-chile.com> and <fendi-srbija.com> are designed to look like websites of an official or authorized reseller of the Complainant’s products. The Respondent’s websites prominently display the Complainant’s FENDI trademark, logos and offer for sale products that look like the Complainant’s products. Neither of the websites refer to the Respondent in this case as the owner of the websites. The Panel concludes that the Respondent registered and is using the disputed domain names to intentionally attempt to attract, for commercial gain, the Internet users to the Respondent’s websites 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.

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 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](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain names, 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 <fendi-argentina.com>, <fendi-australia.com>, <fendibelgie.com>, <fendi-brasil.com>, <fendi-canada.com>, <fendi-chile.com>, <fendi-colombia.com>, <fendi-danmark.com>, <fendi-deutschland.com>, <fendiespana.com>, <fendifactoryoutlet.com>, <fendi-france.com>, <fendi-greece.com>, <fendi-hrvatska.com>, <fendi-india.com>, <fendi-ireland.com>, <fendi-israel.com>, <fendi-italia.com>, <fendimagyarorszag.com>, <fendi-malaysia.com>, <fendi-mexico.com>, <fendi-nederland.com>, <fendi-norge.com>, <fendinz.com>, <fendioesterreich.com>, <fendioutlet-japan.com>, <fendi-peru.com>, <fendiphilippines.com>, <fendipolska.com>, <fendi-portugal.com>, <fendisaleuk.com>, <fendisaudiarabia.com>, <fendi-singapore.com>, <fendi-srbija.com>, <fendi-suomi.com>, <fendi-turkiye.com>, <fendi-uae.com>, and <fendizurich.com> be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: May 24, 2024