

ADMINISTRATIVE PANEL DECISION

OVS S.p.A. v. 代振生 (Zhen Sheng Dai)
Case No. D2024-1930

1. The Parties

The Complainant is OVS S.p.A., Italy, represented by Rapisardi Intellectual Property, Italy.

The Respondent is 代振生 (Zhen Sheng Dai), China.

2. The Domain Names and Registrar

The disputed domain names <ovs-italy.shop>, <upim-italy.shop>, and <italy-upim.shop> (collectively, the “Disputed Domain Names”) are registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on May 8, 2024. On May 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On May 9, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on May 10, 2024, providing the registrant’s 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 May 10, 2024.

On May 10, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the Disputed Domain Names is Chinese. On May 10, 2024, the Complainant submitted its request that 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 Chinese of the Complaint, and the proceedings commenced on May 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 7, 2024.

The Center appointed Rachel Tan as the sole panelist in this matter on June 17, 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 based in Italy and is recognized as a market leader in the field of fashion retail. The Complainant operates more than 2,000 stores in Italy and overseas under its brands OVS, UPIM, and Stefanel. In 2022, the Complainant's net sales amounted to EUR 1,513 million.

The Complainant is the owner of the OVS mark and the UPIM mark in various jurisdictions. For example, International Registration No. 1158670 for OVS, registered on September 4, 2012, in Classes 3, 14, 18, 20, 21, 24, 25, 26, 28, and 35 designating, inter alia, China; European Union Trade Mark Registration No. 010761609 for OVS, registered on September 3, 2012, in Classes 3, 4, 8, 9, 11, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 34, 35, and 43; International Registration No. 1397183 for UPIM, registered on October 26, 2017, in Classes 18, 25, and 35, designating, inter alia, China; European Union Trade Mark Registration No. 1397183 for UPIM, registered on October 26, 2017, in Classes 18, 25, and 35.

The Complainant owns multiple domain names containing the OVS mark and the UPIM mark, including the domain names <ovs.it>, <upim.com>, and <upim.it>. The Complainant has used its OVS mark and UPIM mark on the websites and conducted sales and marketing thereon.

The disputed domain names <ovs-italy.shop>, <upim-italy.shop>, and <italy-upim.shop> were registered on January 4, 2024, March 11, 2024, and March 12, 2024, respectively. Based on the undisputed evidence provided by the Complainant, each of the Disputed Domain Names previously resolved to a website written in Italian which allegedly imitated the Complainant's official websites. In particular, the webpages prominently displayed the Complainant's OVS or UPIM marks respectively and were alleged to offer clothing products for sale. At the time of this Decision, all the Disputed Domain Names do not resolve to any active website.

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 identical or confusingly similar to the Complainant's OVS or UPIM marks. The Complainant's OVS or UPIM marks are incorporated in the Disputed Domain Names in entirety. The additional descriptive term "italy" does not prevent a finding of confusing similarity as Italy is the country where the Complaint is based in and has the principal place of business.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has never provided a third party any authorization to register and/or use the Disputed Domain Names or any domain name comprising the Complainant's OVS or UPIM marks alone or in combination with the word "italy". The Respondent is not commonly known by the Disputed Domain Names nor owns any trade mark rights to any of them.

Finally, the Complainant argues that the Disputed Domain Names were registered and are being used in bad faith. It is alleged that the Disputed Domain Names previously resolved to websites that imitated the Complainant's official websites. The Complainant contends that the websites noticeably displayed the Complainant's OVS or UPIM marks and likewise offered clothing products for sale. The registration and use of the Disputed Domain Names are used for sole aim of attracting for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's OVS or UPIM marks as to the source, affiliation, and endorsement of the Respondent's websites. The registration and use of the Disputed Domain Names also amounted to an infringement of the Complainant's name and trade mark rights.

B. Respondent

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

6. Discussion and Findings

6.1 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 (i) the Dispute Domain Names are registered in English characters including the English words "Italy" and "Shop"; and (ii) English is the most common language. Therefore, it should be inferred that the Respondent is familiar with English.

The Respondent did not make any 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.

6.2 Substantive Issues

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 trade mark and the Disputed Domain Names. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of trade marks or service marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainant's OVS or UPIM mark are reproduced within each of the Disputed Domain Names respectively. Accordingly, the Disputed Domain Names are confusingly similar to the Complainant's marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of another term here, i.e., “italy”, may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

Further, it is permissible for the Panel to disregard the applicable Top-Level Domains (“TLDs”) in the Disputed Domain Names, i.e., “.shop”. It is accepted by UDRP panels that the practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to “new gTLDs”) and the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment to the first element. [WIPO Overview 3.0](#), sections 1.11.1 and 1.11.2. See also *Wig Studio 1, LLC v. Jamar Harry*, WIPO Case No. [D2023-2550](#).

Based on the available records, 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 Respondent has not provided evidence of a legitimate or noncommercial use of the Disputed Domain Names or reasons to justify the choice of the Disputed Domain Names that are confusingly similar to the Complainant’s OVS or UPIM mark. There is also no indication to show that the Respondent is commonly known by the Disputed Domain Names or otherwise has rights or legitimate interests in them. Moreover, the Complainant has not granted the Respondent any license or authorization to use the Complainant’s OVS and UPIM marks or register the Disputed Domain Names.

The Panel notes that each of the Disputed Domain Names previously resolved to a website which allegedly imitated the Complainant’s official websites. The websites noticeably displayed the Complainant’s OVS or UPIM mark respectively and likewise offered clothing products for sale. The websites did not accurately and prominently disclose the lack of a relationship between the Complainant and the Respondent. Therefore, the facts do not support a claim of fair use under the “Oki Data test”. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Furthermore, the nature of each of the Disputed Domain Names carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Names.

Based on the available records, 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 Complainant's OVS and UPIM marks were registered well before the registration of the Disputed Domain Names. Through use and advertising, the Complainant's marks are known throughout the world. Search results using the key words "ovs italy" and "upim italy" on Internet search engines refers almost exclusively to the Complainant. The Panel notes that each of the Disputed Domain Names previously resolved to a website allegedly displaying the Complainant's OVS or UPIM marks. As such, the Respondent clearly knew of the Complainant's marks when registering the Disputed Domain Names. [WIPO Overview 3.0](#), section 3.2.2.

The Panel is of the view that by using the Disputed Domain Names the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's websites, by creating a likelihood of confusion with the Complainant's OVS or UPIM mark as to the source, sponsorship, affiliation, or endorsement of each of the Respondent's websites. This demonstrates bad faith registration and use of the Disputed Domain Names, as provided in paragraph 4(b)(iv) of the Policy.

The Panel notes that the Disputed Domain Names currently all resolve to inactive websites. The current inactive use of the Disputed Domain Names in this case would not prevent a finding of bad faith under the doctrine of passive holding. In its determination, the Panel considers the degree of reputation of the Complainant's OVS and UPIM marks, the Respondent's failure to respond in the face of the Complainant's bad faith allegations, as well as the implausibility of any good faith use that the Disputed Domain Names may be put especially considering the Disputed Domain Names are inherently misleading. [WIPO Overview 3.0](#), section 3.3.

Given all the circumstances of the case, the Panel finds that the Respondent must have known of the Complainant before registering the Disputed Domain Names, and considering the Respondent's lack of rights or legitimate interests, and by registering and using the Disputed Domain Names as discussed above as well as continuing to hold the Disputed Domain Names, the Panel is led to conclude that the Disputed Domain Names were registered and are being used in bad faith.

Based on the available records, 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 <ovs-italy.shop>, <upim-italy.shop>, and <italy-upim.shop> be transferred to the Complainant.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: June 30, 2024