

ADMINISTRATIVE PANEL DECISION

GGZ S.r.l. v. 黄海玲 (Hai Ling Huang)

Case No. D2024-2029

1. The Parties

The Complainant is GGZ S.r.l., Italy, represented by Bugnion S.p.A., Italy.

The Respondent is 黄海玲 (Hai Ling Huang), China.

2. The Domain Name and Registrar

The disputed domain name <vicolooutlet.shop> is 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 15, 2024. On May 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed name. On May 17, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the name which differed from the named Respondent (Name Redacted) and contact information in the Complaint. The Center sent an email to the Complainant on May 23, 2024, 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 in English on May 28, 2024.

On May 23, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On May 28, 2024, the Complainant requested English to be the language of the proceeding. The Respondent thereafter did not submit any comment on the Complainant's submission.

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 in English and Chinese, and the proceedings commenced on June 3, 2024. In accordance with

the Rules, paragraph 5, the due date for Response was June 23, 2024. The Respondent did not submit a response. Accordingly, the Center notified of the Respondent's default on June 24, 2024.

The Center appointed Joseph Simone as the sole panelist in this matter on July 2, 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, GGZ S.r.l., is an Italian company based in Pozzonovo, which is known as an Italian leader in the field of design, production and marketing of clothing products, under the name of "Vicolo".

The Complainant is a producer of clothing, and more recently, also accessories, shoes, bags, and swimwear. The Complainant asserts that Vicolo has become a symbol of "Made in Italy" and that it distributes worldwide via e-commerce while also operating flagship stores in the following Italian cities: Padua, Forte dei Marmi, Treviso, Florence, Bologna, Rome, Pietrasanta, Milan and Turin.

The Complainant has an extensive global portfolio of trade marks incorporating the Vicolo name, which includes the following:

- China Trade Mark Registration No. 17069779 for VICOLO in Class 18, registered on October 28, 2016;
- International Trade Mark Registration No.1253537 for VICOLO in Classes 18 and 25, designating inter alia Australia, Switzerland, Japan, Republic of Korea, Mexico, United States of America, registered on May 20, 2015;
- European Union Trade Mark Registration No. 004916912 for VICOLO in Classes 18 and 25, registered on March 15, 2007; and
- European Union Trade Mark Registration No. 014066658 for VICOLO in Classes 18 and 25, registered on August 31, 2015.

The disputed domain name was registered on September 25, 2023.

According to evidence provided by the Complainant, the disputed domain name previously resolved to a website featuring an online store advertising and selling apparel products at discounted prices suspected to be counterfeits of VICOLO apparel, and then it was shut down by the Registrar as a result of the Complainant's Trademark Infringement Notice sent to the Service Provider before submitting the Complaint. At the time of issuance of this Decision, the disputed domain name resolves to an inactive page.

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.

The Complainant contends that the disputed domain name registered by the Respondent is identical or confusingly similar to the Complainant's VICOLO trademarks, and that the addition of the generic Top-Level Domain ("gTLD") ".shop" does not affect the analysis as to whether the disputed domain name is identical or confusingly similar to the Complainant's trademarks.

Furthermore, the Complainant argues that the addition of the term “outlet” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s VICOLO mark. The Complainant asserts that it has not authorized the Respondent to use the VICOLO mark, and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services.

The Complainant also claims there is no evidence indicating that the Respondent has any connection to the VICOLO mark in any way, and that there is no plausible good-faith reason for the Respondent to have registered the disputed domain name. The Complainant therefore concludes that the registration and any use of the disputed domain name whatsoever must be in bad faith.

B. Respondent

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

6. Discussion and Findings

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, subject to the authority of the Panel to determine otherwise based on the circumstances.

The language of the Registration Agreement for the disputed domain name is Chinese. The default language of the proceeding should therefore be Chinese.

However, the Complaint was filed in English and the Complainant requested that the language of the proceeding be English for the following reasons:

- The disputed domain name is registered in Latin script including the English dictionary word “outlet”;
- The Respondent is the owner of several trademarks (some also registered in the USA) with an English verbal component such as performing center, auction, art center, decoration, design, children first;
- It is also important to ensure fairness to the Parties and maintain an inexpensive and expeditious avenue for resolving domain name disputes, and deciding Chinese as the language of the proceeding would impose an undue burden on the Complainant.

The Respondent was notified in both Chinese and English of the language of the proceeding and the commencement of the proceeding and did not comment on the language of the proceeding or submit any response in either Chinese or English.

In exercising its discretion to use a language other than that of the registration agreement, the Panel must judiciously and in the spirit of fairness take into account all relevant circumstances of the case, including 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).

Considering the circumstances of this case, the Panel determines that the language of the proceeding shall be English, and as such, the Panel has issued this decision in English. The Panel further finds that such determination should not create any prejudice to either Party and should ensure that the proceeding takes place with due expedition.

A. Identical or Confusingly Similar

The Panel acknowledges that the Complainant has established rights in the VICOLO trademarks in many jurisdictions around the world.

Disregarding the gTLD “.shop”, the disputed domain name incorporates the Complainant’s trademark VICOLO in its entirety. Thus, the disputed domain name should be regarded as confusingly similar to the Complainant’s VICOLO trademark. The inclusion of the additional term “outlet” does not prevent a finding of confusing similarity. [WIPO Overview 3.0](#), section 1.7 and 1.8.

The Panel therefore finds that the Complainant satisfies the requirements of paragraph 4(a)(i) of the Policy in establishing its rights in the VICOLO trademark and in showing that the disputed domain name is confusingly similar to its mark.

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 challenging 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 evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Complainant asserts that it has not authorized the Respondent to use its trademarks and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Having reviewed the available record, the Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent did not file a response and has therefore failed to assert factors or put forth evidence to establish that he enjoys rights or legitimate interests in the disputed domain name. Meanwhile, no evidence has been adduced to demonstrate that the Respondent, prior to the notice of the dispute, had used or demonstrated its preparation to use the disputed domain name in connection with a bona fide offering of goods or services. At the time the Complaint was filed, the disputed domain name resolved to a website allegedly offering various retail items for sale at a discount, some of which bore the Complainant’s trademark. However, the website failed to disclose any relationship with the Complainant. Given the composition of the disputed domain name and its previous use, it is clear the Respondent sought to create a misleading inference of association or ownership by the Complainant for its commercial advantage.

There is also no evidence adduced to show that the Respondent has been commonly known by the disputed domain name or the Respondent is making a legitimate noncommercial or fair use of the disputed domain name. As such, the Panel concludes that the Respondent has failed to rebut the Complainant’s prima facie showing of the Respondent’s lack of rights or legitimate interests in the disputed domain name, and that none of the circumstances of paragraph 4(c) of the Policy is applicable in this case.

Accordingly, and based on the Panel’s findings below, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

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.

Paragraph 4(b) of the Policy states that any of the following circumstances in particular but without limitation, shall be considered as evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances in which bad faith may be found. Other circumstances may also 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.

For reasons discussed under this and the preceding heading, the Panel believes that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name.

When the Respondent registered the disputed domain name, the VICOLO trademarks were already widely known and directly associated with the Complainant's activities. UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Given the extensive prior use and fame of the Complainant's marks, in the Panel's view, the Respondent should have been aware of the Complainant's marks when registering the disputed domain name.

The Respondent has provided no evidence to justify his choice of the term "vicolo" in the disputed domain name.

The Complainant's registered trademark rights in VICOLO for its products and services predate the registration date of the disputed domain name. A simple online search (via services such as Google or Baidu) for the term "vicolo" would have revealed that it is an established brand. [WIPO Overview 3.0](#), section 4.8.

The Panel takes particular note of the fact that Respondent used the disputed domain name for a website promoting apparel suspected to be counterfeits of the Complainant's apparel products.

The Panel is therefore of the view that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark rights.

In light of the foregoing facts, there are no plausible good faith reasons for the Respondent to have registered and used the disputed domain name. The Panel finds in the circumstances that, by registering and using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

While the disputed domain name does not currently resolve to an active website, having reviewed the available record, the Panel finds the current non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. See [WIPO Overview 3.0](#), section 3.3.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.

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 <vicolooutlet.shop> be transferred to the Complainant.

/Joseph Simone/

Joseph Simone

Sole Panelist

Date: July 15, 2024