

## ADMINISTRATIVE PANEL DECISION

Fiorucci Holdings Limited v. Aaref Gharib, Fiorucci Moda, Fiorucci Apparel,  
Fiorucci USA, Fiorucci Moda, Fiorucci US, Fiorucci US, Fiorucci USA,  
Fiorucci Moda, Fiorucci Moda  
Case No. D2024-3352

### 1. The Parties

The Complainant is Fiorucci Holdings Limited, United Kingdom (“UK”), represented by Bird & Bird LLP, UK..

The Respondents are Aaref Gharib, Fiorucci Moda; Fiorucci Apparel, Fiorucci USA; Fiorucci Moda, Fiorucci US; Fiorucci US, Fiorucci USA; and, Fiorucci Moda, Fiorucci Moda; all of Hong Kong, China

### 2. The Domain Names and Registrars

The disputed domain names <fiorucciapparel.com>, <fioruccifashion.com>, <fioruccimoda.com>, <fiorucciusa.com>, and <modafiorucci.com> are registered with Tucows Inc. (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 15, 2024. On August 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 16, 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 (*Contact Privacy Inc.*) and contact information in the Complaint.

The Center sent an email communication to the Complainant on August 21, 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 and/or that all domain names are under common control. The Complainant filed an amended Complaint on August 23, 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 Respondents of the Complaint, and the proceedings commenced on August 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 16, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on August 19, 2024. In response, a Respondent sent an email communication on September 22, 2024.<sup>1</sup> On September 23, 2024, the Center, referring to this communication, informed the Parties that a UDRP proceeding, if requested, can be suspended to allow the Parties to explore and possibly implement a settlement agreement. On September 27, 2024, the Complainant sent an email to the Center asking to resume the proceedings and pointing out that the Respondent's late filing should not be taken into account.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on September 30, 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 fashion brand based in London, UK. The Complainant was first established in 1967 and newly revived in 2017. The Complainant offers a product range including clothing, footwear, and accessories sold under the FIORUCCI brand, through a store in London and through various retailers worldwide and online.

The Complainant has numerous registrations for the FIORUCCI trademark around the world. The Complainant is, inter alia, the owner of the following:

European Union Trademark registration No. 000367250 for FIORUCCI registered on February 20, 2001;

European Union Trademark registration No. 014755573 for FIORUCCI registered on March 31, 2020;

United States trademark registration No. 1264655 for FIORUCCI registered on January 24, 1984.

The Complainant enjoys significant goodwill and reputation in the FIORUCCI trademarks.

The Complainant also owns a number of domain names, including <fiorucci.com>, which resolves to the Complainant's website, through which the Complainant operates an online store that sells and offers its FIORUCCI branded products.

The disputed domain names were registered between December 19, 2023, and July 15, 2024. Currently the disputed domain names, <fioruccimoda.com>, <fioruccifashion.com>, <fiorucciusa.com>, and <fiorucciapparell.com> are not linked to active websites. However, from the submissions provided by the Complainant, it appears that previously (at least, respectively, on February 14, 2024 and March 19, 2024), <fioruccimoda.com> and <fiorucciusa.com> both resolved to active websites which purported to offer for sale clothing and accessories. The disputed domain name <modafiorucci.com> resolved to a website which purports to offer for sale clothing, footwear, and accessories under several renowned brands, namely ROLEX, BURBERRY, NIKE, etc., at discounted prices. Currently the disputed domain name <modafiorucci.com> redirects to the website "www.revengemoda.com".

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<sup>1</sup>The email associated with this informal communication was associated with the registration of three of the disputed domain names under three of the disclosed Respondents but, as assessed below, the informal communication confirms control over all of the disputed domain names.

## 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 the FIORUCCI trademark, that the Respondents have no rights or legitimate interests in respect of the disputed domain names, and particularly that it is implausible that the Respondents were unaware of the Complainant's renowned trademark when they registered the disputed domain names.

Regarding the Respondents' identity, the Complainant has requested a consolidation of multiple disputed domain names and the Respondents. In support of the above request, the Complainant's main claims are that:

1. the Respondents are related to the extent that a sufficient unity of interest exists such that they may essentially be treated as a single domain name holder for the purposes of Policy paragraph 3(c) of the Rules;
2. the Registrants' listed addresses are identical for all of the disputed domain names;
3. the composition of the disputed domain names is almost identical;
4. consolidation of proceedings would be fair and equitable to all parties.

### B. Respondent

The Respondent has made no formal reply to the Complainant's contentions. However, the Respondent, following the Center notification to the Parties of the Respondent's default, sent the following informal email communication to the Center:

"....I hope this message finds you well.

I wanted to clarify that the name of our store is Fiorucci Moda, not Fiorucci. We have no connection to the brand you mentioned, nor do we agree with their claims. The fact that our store name contains "Fiorucci" in different domains does not imply any association, as it is a common Italian surname.

To address specific points:

- Our store does not claim to be associated with Fiorucci.com or sell on their behalf.
- We have not used any images from their website.
- The layout and design of our store are entirely different from theirs.
- We were not aware of this brand prior to their claims.
- The allegation that we failed to ship an order is baseless, as it was a fake order. We operate on a cash-on-delivery (COD) basis, and at the time, we were temporarily inactive. It clearly means that no one's pocket was hurt.

That said, we are currently in the process of rebranding our shop and have no obligation to retain the current store name. However, this does not mean we should surrender the modafiorucci.com domain (and others) for free. We purchased this domain independently, with no connection to their store.

If they are interested in acquiring the domain, we would be happy to entertain a reasonable offer.

Thank you for your understanding.

Best regards"

## 6. Discussion and Findings

### 6.1 Late Filing of the Response

Paragraph 14(a) of the Rules provides that, in the event of a late response, absent exceptional circumstances, panels shall proceed to a decision based solely on the complaint.

Paragraph 14(a) of the Rules is counterbalanced by paragraph 10(b) of the Rules, which requires panels to ensure that parties are treated with equality and that each party is given a fair opportunity to present its case. The late Response was filed with the Center six days after the deadline for filing the Response had expired. The Panel notes that, in the event of a late Response, the default course of action pursuant to paragraph 14(a) of the Rules, is to proceed to decision based only on the Complaint. However, the Panel may, in its discretion, consider the response if “exceptional circumstances” exist. As highlighted in *AIB- Vincotte Belgium ASBL, AIB-Vincotte USA Inc./Corporation Texas v. Guillermo Lozada, Jr.*, WIPO Case No. [D2005-0485](#), late responses were taken into account by the UDRP panels in cases where:

- “- the response was filed before commencement of the decision-making process by the panel (see *J.P. Morgan & Co., Incorporated and Morgan Guaranty Trust Company of New York v. Resource Marketing*, WIPO Case No. [D2000-0035](#));
- the lateness did not delay the decision (see *Young Genius Software AB v. MWD, James Vargas*, WIPO Case No. [D2000-0591](#));
- response was late only by one day (see *Kate Spade, LLC v. Darmstadter Designs*, WIPO Case No. [D2001-1384](#) and *Arthur Guinness Son & Co. (Dublin) Limited v. Feeney O'Donnell and John O'Donnell*, WIPO Case No. [D2000-1710](#));
- although there were no exceptional circumstances, a late response was taken into account on the basis of the panel's ‘general powers’ pursuant to paragraph 10(b) of the Rules (‘equality and that each party is given a fair opportunity’) on the grounds that failure to take the response into account ‘would be a rather drastic step and should be undertaken with great care (see *AT&T Corp. v. Randy Thompson*, WIPO Case No. [D2001-0830](#)).”

In the case at hand, notwithstanding the absence of exceptional circumstances, taking into account the period of the delay, and the lack of prejudice to the Complainant in light of the Panel's findings in this Decision, the Panel determines, exceptionally, that it will allow the late filing of the Response in this proceeding.

In view of the above and exercising its powers according to paragraph 10(b) of the Rules, the Panel deems appropriate to admit the Respondent's late Response and will thus consider it in rendering the Decision.

### 6.2 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 name registrants did not comment on the Complainant's request. Indeed the Respondent, in its email communication, appears to implicitly confirm that it is the holder of the disputed domain names: “The fact that our store name contains ‘Fiorucci’ in different domains... (omissis) and “However, this does not mean we should surrender the modafiorucci.com domain (and others) for free”.

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, owing to the fact that the Registrants of the disputed domain names are located at the same address, the fact that the email servers configured on the domain names are hosted by the same company, and the fact that the composition of the disputed domain names is almost identical, finds that the disputed domain names identified in the Complaint, on the balance of probability, are registered by the same domain name holder or are at least under common control.

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.

### **6.3 Substantive Issues**

In order for the Complainant to obtain a transfer of the disputed domain names, paragraph 4(a) of the Policy requires that the Complainant must demonstrate to the Panel that:

- (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 incorporated entirely and 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.

Although the addition of the other terms here, "apparel", "usa", "fashion" and "moda" (i.e., "fashion" 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.

#### **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.

Based on the available record, 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 Respondent was aware of the Complainant’s trademark registrations and rights to the FIORUCCI trademark when it registered the disputed domain names.

FIORUCCI is a renowned trademark. The disputed domain names contain in its entirety, without any authorization or approval, the Complainant’s registered FIORUCCI trademarks, and this is the only distinctive component of the disputed domain names. Moreover, the Respondent has combined said distinctive trademark with the words “apparel”, “fashion”, and “moda” (fashion in Italian) which are directly associated with the Complainant’s products.

The disputed domain names were registered many years after the Complainant’s renowned trademark was registered. In addition, owing to the substantial presence established worldwide and on the Internet by the Complainant, it is at the least very unlikely that the Respondent, purportedly operating in the same field as the Complainant, was not aware of the existence of the Complainant’s trademarks when registering the disputed domain names.

Therefore, it is more likely than not that the Respondent, when registering the disputed domain names, had knowledge of the Complainant’s earlier rights to the FIORUCCI trademark and trade name and targeted those.

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.

The bad faith registration of the disputed domain names is also affirmed by the fact that the Respondent has clearly given false first and last names as registrant details for the disputed domain names <fiorucciapparel.com> (First Name: Fiorucci, Last Name: Apparel), <modafiorucci.com> (First Name: Fiorucci, Last Name: Moda), <fioruccifashion.com> (First Name: Fiorucci, Last Name: Moda) and <fiorucciusa.com> (First Name: Fiorucci, Last Name: US).

Then, the bad faith use of the disputed domain is affirmed by the fact that the Respondent appears to have intentionally attempted to attract, for commercial gain, Internet users to the disputed domain names by creating a likelihood of confusion with the FIORUCCI trademarks.

This is further evidence of bad faith in accordance with paragraph 4(b)(i) of the Policy.

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 some of the disputed domain names 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, the composition of the disputed domain names, the Respondent’s concealing its identity when registering 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 <fiorucciapparel.com>, <fioruccifashion.com>, <fioruccimoda.com>, <fiorucciusa.com>, and <modafiorucci.com> be transferred to the Complainant.

*/Fabrizio Bedarida/*

**Fabrizio Bedarida**

Sole Panelist

Date: October 11, 2024