

ADMINISTRATIVE PANEL DECISION

Stefano Pilati v. 罗运钦 (Yunqin Luo)

Case No. D2024-3578

1. The Parties

The Complainant is Stefano Pilati, Germany, represented by MITTLER & C. s.r.l., Italy.

The Respondent is 罗运钦 (Yunqin Luo), China.

2. The Domain Name and Registrar

The disputed domain name <stefanopilati.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on September 4, 2024. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 5, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name that differed from the named Respondent (Non-disclosed registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 9, 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 September 11, 2024.

On September 9, 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 September 11, 2024, the Complainant confirmed its request for English to be the language of the proceeding. The Respondent did not submit any comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on September 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 4, 2024.

The Center appointed Matthew Kennedy as the sole panelist in this matter on October 7, 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 fashion designer. He worked for the fashion houses of Giorgio Armani, Prada, Yves Saint Laurent, and Ermenegildo Zegna before founding his own ready-to-wear brand "Random Identities" in 2017, which collaborated on a shoe line with Li Ning, a Chinese sportswear brand, from 2019. The Complainant holds European Union trademark registration number 018987541 for STEFANO PILATI, registered on June 28, 2024, specifying goods and services in multiple classes. That trademark registration remains current. He also operates an Instagram account under his personal name.

The Respondent is an individual based in China.

The disputed domain name was registered on September 1, 2020. It does not resolve to any active website; rather, it is passively held.

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.

Notably, the Complainant contends that the disputed domain name is identical or at least confusingly similar to his STEFANO PILATI mark, in which he claims both registered and unregistered rights. The Complainant has made longstanding use of his personal name in connection with fashion design services since the early 1990s. His name was already well known in the fashion field and was used as distinctive identifier in relation to his activity well before the registration of the disputed domain name, thanks to his collaborations with very famous luxury brands, the creation of innovative products and the establishment of his own label. These circumstances give rise to common law trademark rights.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The disputed domain name was registered and is being used in bad faith. It is an exact reproduction of the Complainant's mark and well-known name. By typing the disputed domain name, Internet users may well erroneously believe to access the Complainant's website or a website authorized by or related to the Complainant. The disputed domain name was also registered to prevent the owner of the trademark from reflecting the mark in a corresponding domain name.

B. Respondent

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

6. Discussion and Findings

6.1 Language of the Proceeding

The language of the Registration Agreement for the disputed domain name 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 and amended Complaint were filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the disputed domain name identical to the Complainant's trademark contains English letters only rather than Chinese characters, and that in order to proceed in Chinese, the Complainant would have to retain specialized translation services at a cost very likely to be higher than the overall cost of this proceeding; and translating the Complaint would cause unnecessary delay in the proceeding.

The Respondent did not make any submission 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

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is 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. See [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a registered trademark for STEFANO PILATI for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. The Complainant held those trademark rights at the time when the Complaint was filed. The timing of this registration is considered further in relation to bad faith in Section 6.2C below.

The Complainant also claims unregistered or common law trademark rights in his personal name "Stefano Pilati". He provides evidence showing widespread press coverage of his name to identify the source of his fashion design services from 2010 up to the present time, firstly for various fashion houses and later in connection with his own brand. Based on the inherently distinctive nature of the Complainant's name and the evidence provided of its use in commerce as a designation of source, the Panel finds the Complainant has established unregistered trademark rights in "Stefano Pilati" for the purposes of the Policy.

See [WIPO Overview 3.0](#), sections 1.3 and 1.5.2.

The entirety of the STEFANO PILATI mark is reproduced within the disputed domain name. The only additional element in the disputed domain name is a generic Top-Level Domain (“gTLD”) extension (“.com”) which, as a standard requirement of domain name registration, may be disregarded in the assessment of identity for the purposes of the first element of the Policy. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7 and 1.11.1.

Therefore, 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. See [WIPO Overview 3.0](#), section 2.1.

In the present case, the disputed domain name is passively held. There is no evidence that it has ever resolved to an active website. This circumstance indicates that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services; nor is it making a legitimate noncommercial or fair use of the disputed domain name for the purposes of the Policy. Further, the Registrar has verified that the Respondent’s name is “罗运钦 (Yunqin Luo)”, which does not resemble the disputed domain name. Nothing indicates that the Respondent has been commonly known by the disputed domain name.

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 name. 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 name such as those enumerated in the Policy or otherwise.

Based on the record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

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. See [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the disputed domain name was registered in 2020, four years before the registration of the Complainant’s STEFANO PILATI mark but after the Complainant’s unregistered trademark rights in “Stefano Pilati” accrued. The disputed domain name is identical to this mark, which has no other meaning besides as a reference to the Complainant and his fashion design services. The Respondent provides no explanation of his choice to register the disputed domain name. Accordingly, the Panel finds that the Respondent registered the disputed domain name with the Complainant and his mark in mind.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. See [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark and the fact that the disputed domain name is identical to it. The Panel also notes that the Respondent has not provided any explanation of an intended good faith use of the disputed domain name. Accordingly, the Panel finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Therefore, 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 name <stefanopilati.com> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: October 17, 2024