

ADMINISTRATIVE PANEL DECISION

Fiorucci Holdings Limited v. Gottlieb Nahormek
Case No. D2024-4207

1. The Parties

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

The Respondent is Gottlieb Nahormek, United States of America.

2. The Domain Name and Registrar

The disputed domain name <fiorucciuruguay.com> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2024. On October 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 14, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 15, 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 on October 18, 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 October 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 11, 2024.

The Center appointed Halvor Manshaus as the sole panelist in this matter on November 14, 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 established in 1967. The Complainant sells products such as clothing, footwear and accessories sold under the FIORUCCI brand through various retailers in the UK, France, United States (“US”), Japan, Taiwan Province of China, Kuwait, and Bahrain. Additionally, the Complainant’s products are sold through its online store hosted at “www.fiorucci.com”, as well as other major online retailers.

The Complainant is the owner of several trademark registrations of the FIORUCCI trademark, such as:

- The European Union (“EU”) registration number 14755573, registered on March 31, 2020, comprising of the word FIORUCCI for various goods and services in classes 9, 16, 18, 25, 35 and 41;
- The EU registration number 367250, registered on February 20, 2001, comprising of the word FIORUCCI for various goods and services in classes 3, 9, 14, 16, 18, 24, 25, 26 and 42;
- The UK registration number UK00914755573, registered on March 31, 2020, comprising of the word FIORUCCI for various goods and services in classes 9, 16, 18, 25, 35 and 41;
- The UK registration number UK00003620419, registered on August 6, 2021, comprising of the word FIORUCCI for various goods and services in classes 3, 4, 14, 21, 24, 26, 40 and 43;
- The US registration number 7324349, registered on March 12, 2024, comprising of the word FIORUCCI for various goods and services in classes 3, 9, 14, 16, 18, 25, 26 and 35; and
- The Uruguayan registration number 500110, registered on December 10, 2021, comprising of the word FIORUCCI for various goods and services in classes 3, 16, 18, 20, 21, 23, 24, 25 and 26.

The Complainant has also registered several domain names incorporating the FIORUCCI trademark, including <fiorucci.com>.

The disputed domain name was registered on June 17, 2024. The disputed domain name hosts a website displaying the Complainant’s trademarks and copyrighted photographs, with clothing and accessories being offered for sale under the Complainant’s trademarks. On August 16, 2024, the Complainant received a customer inquiry asking whether the disputed domain name was a real website selling the Complainant’s products.

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 confusingly similar to the Complainant’s trademark as it reproduces the Complainant’s trademark in its entirety. The addition of the geographical term “uruguay” deceives consumers into believing that the disputed domain name is a genuine outlet site for the Complainant’s goods, operated by the Complainant. Further, the disputed domain name resolves to websites displaying the Complainant’s trademarks, and where clothing and accessories branded with the Complainant’s trademark are offered. The Complainant has received a customer inquiry asking whether the disputed domain name was a real website selling the Complainant’s products, constituting clear evidence of actual confusion between the disputed domain name and the Complainant’s trademark.

Further, the Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name. To the best of the Complainant's knowledge, the Respondent is not known by the disputed domain name, nor does it hold any rights. Moreover, the Complainant has not authorised, licensed, approved or otherwise permitted the Respondent to use the disputed domain name, and the Respondent does not make legitimate or fair use of the disputed domain name. The disputed domain name is used to host a website offering items under the Complainant's trademark, and representatives of the Complainant who placed an order on the website did not receive an order confirmation or delivery of the purchased items, suggesting that the Respondent is using the disputed domain name for fraudulent or illegal purposes. Furthermore, the disputed domain name displays copyrighted photographs and additional trademarks owned by the Complainant, further indicating that the Respondent is not making legitimate, noncommercial or fair use of the disputed domain name.

Moreover, the Complainant argues that the disputed domain name was registered and is being used in bad faith. According to the Complainant, the Respondent must have been aware of the Complainant's rights in the Complainant's trademark as it is well-known worldwide. Further, the Respondent has used a privacy/proxy registration service in order to register the disputed domain name which further indicated bad faith. The Complainant has also intentionally attempted to attract Internet users for commercial gain and used the disputed domain name to host a website offering items branded under the Complainant's trademark.

B. Respondent

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

6. Discussion and Findings

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 entirety of the FIORUCCI mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "uruguay", 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 name 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 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.

The Panel finds that the composition of the disputed domain name, including the geographic term "uruguay" enhances the likelihood of confusion by suggesting that the disputed domain is the official website or localized presence of the Complainant. This is further supported by a customer inquiry received by the Complainant, asking whether the disputed domain name was a legitimate website selling the Complainant's products. This inquiry constitutes evidence of actual confusion between the disputed domain name and the Complainant's trademark.

The Respondent has used the disputed domain name to host a website displaying copyrighted photographs and additional trademarks owned by the Complainant, where similar goods as the Complainant are offered under the Complainant's trademark. Moreover, the Complainant has provided evidence showing that the Respondent has failed to confirm orders or deliver the goods purchased through the website hosted on the disputed domain name. This suggests that the Respondent is using the disputed domain name for illegal purposes.

Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods, impersonation/passing off can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 disputed domain name incorporates the Complainant's trademark in its entirety, combined with the geographical term "uruguay". The Panel finds it unlikely that the Respondent was unaware of the Complainant's trademark registration, given that the Complainant's trademark is well-known and predates the registration of the disputed domain name.

Furthermore, the Panel finds it probable that the Respondent registered and is using the disputed domain name with the intent to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademark. Specifically, the combination of the Complainant's trademark and the geographic term "uruguay" suggests that the disputed domain name represents either an official website or a localized presence of the Complainant.

Further, 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.

Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods, impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The disputed domain name hosts a website that displays copyrighted photographs and additional trademarks owned by the Complainant, offering goods related to the Complainant's business under the Complainant's trademark. Moreover, representatives of the Complainant who placed orders through the website received neither order confirmations nor delivery of the goods, which further supports the finding that the disputed domain name was registered and is being used in connection with illegal or fraudulent activities.

Consequently, 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 <fiorucciuruguay.com> be transferred to the Complainant.

/Halvor Manshaus/

Halvor Manshaus

Sole Panelist

Date: November 28, 2024