

## ADMINISTRATIVE PANEL DECISION

Fendi S.r.l. v. hemera zhang  
Case No. D2024-4225

### 1. The Parties

The Complainant is Fendi S.r.l., Italy, represented by Dreyfus & Associés, France.

The Respondent is Hemera Zhang, China.

### 2. The Domain Name and Registrar

The disputed domain name <fendistore.com> is registered with NameCheap, Inc. (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 14, 2024. On October 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 15, 2024, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain name which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 16, 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 17, 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 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 8, 2024.

The Center appointed Zeynep Yasaman 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 luxury fashion house specialized, inter alia, in high fashion clothing, accessories, and furniture. The Complainant, established in 1925 as a fur and leather shop in Rome, had been bought in 2000 by the LVMH Group, the owner of numerous well-known marks such as Louis Vuitton, Bulgari, Kenzo, Céline, Marc Jacobs, Christian Dior, Acqua di Parma, Moët, & Chandon.

The Complainant is the owner of numerous FENDI trademarks registered throughout the world. Those mentioned in the Complaint are International Trademark No. 906325 registered on September 18, 2006, in classes 3, 9, 14, 18, 20, 21, 24, 25, 27, and 35, as well as International Trademark No. 561438 registered on November 19, 1990, in classes 14, 18, and 25. These International Trademarks designate, inter alia, China, where the Respondent resides.

The Complainant operates, among others, domain names <fendi.com> registered on December 26, 1995, and <fendi.cn> registered on April 20, 2005, to promote its services.

The disputed domain name <fendistore.com> was registered on August 1, 2024. When the disputed domain name <fendistore.com> is written on the address tab of the browser, it directs to <fendioutlet.com>, but the website cannot be reached by the Panel as it does not resolve to an active website. From the evidence submitted by the Complainant, such as the screenshots of the website to which the disputed domain name resolved, the Panel notes that products such as bags, shoes, and accessories bearing the trademark FENDI are sold with up to 85 percent discount on the said 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 name.

The Complainant contends that the disputed domain name is virtually identical, or at least confusingly similar to the Complainant's prior trademarks FENDI, which have been considered to be "well-known" or "famous" by previous Panels. The Complainant argues that the disputed domain name reproduces the Complainant's trademark FENDI in its entirety, and the mere adjunction of the generic term "store" is likely to confuse Internet users as it gives the false impression that this domain name is somehow officially related to/associated with the Complainant.

Regarding the rights or legitimate interests of the Respondent in respect of the disputed domain name, the Complainant contends that the Respondent is neither known by the name FENDI nor in any way affiliated with the Complainant nor authorized or licensed to use the FENDI trademark or to seek registration of any domain name incorporating the aforementioned trademark. Furthermore, the Complainant argues that with the presence of FENDI products on the website, an indication of the Complainant's line of products, FENDI ads of the Complainant, the copyright notice, the disputed domain name resolved to a website that creates a false affiliation with the Complainant and such circumstances do not represent a use in connection with a bona fide offering of goods and services. The Complainant claims that the Respondent is not accurately disclosing its relationship with the trademark by falsely suggesting it is the trademark owner and that its website is the official website of the Complainant. Thus, the Respondent is making an obvious non-legitimate use of the domain name with the intent for commercial gain to misleadingly divert consumers from

the Complainant's official website. Furthermore, the Complainant argues that since the Mail Exchange servers have been configured on the disputed domain name, there might be a risk that the Respondent is engaged in a phishing scheme, and the disputed domain name is not used in any type of legitimate business or services. For all of these reasons, the Complainant claims that the Respondent has no rights or legitimate interests with respect to the domain name in dispute.

Lastly, the Complainant asserts that the disputed domain name was registered and is being used in bad faith.

The Complainant states that it is implausible that the Respondent was unaware of the Complainant when he registered the disputed domain name since the Complainant is well-known throughout the world, including in China, where the Respondent is based. Moreover, the composition of the domain name reproducing the Complainant's highly distinctive trademark FENDI, with the mere addition of the generic term "store" and directly targeting the Complainant's field of activity, clearly demonstrates that the Respondent registered the disputed domain name based on the attractiveness of the Complainant's trademarks to divert Internet traffic to its website. Furthermore, the Complainant's trademark registrations significantly predate the registration date of the disputed domain name, and it was the Respondent's duty to verify that the registration of the disputed domain name would not infringe the rights of any third party before registering said domain name. According to the Complainant, taking into account the worldwide reputation of the Complainant and its trademarks, as well as the high level of its notoriety, it is hard to believe that the Respondent was unaware of the existence of the Complainant and its trademarks at the time of registration of the disputed domain name and thus it registered the disputed domain name in bad faith.

With regard to use in bad faith, the Complainant argues that the website contains an online store replicating Fendi's logo and visuals, offering alleged Fendi products for sale and presenting official photos of the Complainant's products. According to the Complainant, the Respondent did everything to make his website look official and therefore created a strong likelihood of confusion for FENDI consumers who could believe that the disputed domain name <fendistore.com> is the official website offering authentic services online. The Complainant indicates that such use of the disputed domain name was not authorized and demonstrates the Respondent's intention to abusively benefit from the Complainant's reputation and particularly from the Complainant's trademarks FENDI to obtain commercial gains from the proposed goods, which cannot be considered as use in good faith. Moreover, the Complainant maintains that the Respondent is engaged in a phishing scheme and aims at stealing valuable information such as credit cards from the Complainant's clients.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, "[WIPO Overview 3.0](#)", section 1.2.1). In the case at hand, since the Complainant owns registered FENDI trademarks, the Panel finds that the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy.

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 3.0](#), section 1.7). Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on the assessment of the second and third elements ([WIPO Overview 3.0](#), section 1.8).

The disputed domain name <fendistore.com> reproduces entirely the Complainant's FENDI trademark with the addition of the word "store" and the addition of the generic Top-Level Domain ("gTLD") ".com".

The applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test ([WIPO Overview 3.0](#), section 1.11.1). In this regard, the existence of ".com" in the disputed domain name is disregarded with regard to the similarity evaluation.

Consequently, although the addition of terms such as "store" and ".com" may bear on the 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 name and the Complainant's trademarks for the purposes of the Policy.

The Panel finds the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

In accordance with paragraph 4(a)(ii) of the Policy, the Complainant must be able to prove that the Respondent has no rights or legitimate interests in the 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).

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. These are the followings:

(i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

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, and the burden of rebuttal is correspondingly shifted to the Respondent. On the other side, 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.

Since the Respondent has not submitted any response to the case, the Panel finds that there is no evidence that the Respondent is commonly known by the disputed domain name.

From the evidence provided by the Complainant, such as the screenshots of the website to which the disputed domain name resolved, the Panel notes that the Respondent was selling FENDI trademarked products. It is written on the website "Fendi Outlet Store Online" and various FENDI products are offered for sale "up to 85% discount".

In cases where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner ([WIPO Overview 3.0](#) section 2.5.1). Moreover, to establish a bona fide offering of goods and services, a reseller or distributor of trademarked goods should comply with certain requirements, including accurate disclosure of its relationship with the trademark holder (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)).

In the present case, the Respondent has not been licensed or authorized by the Complainant to use the FENDI mark or to register and use the disputed domain name. The use of the FENDI trademark alongside a generic word such as "store" gives the impression that it is an online "store" for "FENDI" products, thus suggesting an affiliation with the Complainant. Moreover, while the disputed domain name consists of the FENDI trademark on which the Complainant has rights and the generic word "store" and various FENDI products are offered for sale on the website, together with the commercial ads of the Complainant, the Panel notes that there is no disclosure about the Respondent's (lacking) relationship with the trademark owner. In this regard, the Panel finds that the Respondent has not used the disputed domain name in connection with a bona fide offering of goods and services.

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 the following 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:

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the domain name; or

(ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel is of the opinion that the Complainant's trademark FENDI is a well-known mark, especially in the fashion industry, throughout the world, including in China where the Respondent apparently is located. The disputed domain name contains the Complainant's FENDI trademark and the additional word "store" referring to the point/place of sale, thus referring to the place of sale of FENDI trademarked products. In this context, the Panel finds that the Respondent cannot deny knowledge of the famous FENDI trademark at the time of the registration of the disputed domain name. The Respondent's awareness of the Complainant and its well-known FENDI trademark may be inferred by the use of the disputed domain name which resolves to a website displaying FENDI trademark and products bearing this trademark. In fact, the Panel considers that it is because of the well-known status of the Complainant's trademark that the Respondent has set up a website where discounted products of this trademark are sold. It has been established in previous UDRP decisions that the registration of a domain name incorporating a widely-recognized or well-known trademark by someone who has no connection whatsoever with the trademark is a clear indication of bad faith (see *Pepsico, Inc. v. Domain Admin*, WIPO Case No. [D2006-0435](#); *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#)). In this regard, the Panel concludes that the Respondent was aware of the Complainant's well-known trademark when it registered the disputed domain name and that the domain name in dispute has been registered in bad faith by the Respondent.

The UDRP establishes that, for purposes of paragraph 4(a)(iii), "bad faith" registration and use of a domain name can be established by a showing of circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to source, sponsorship, affiliation or endorsement of the respondent's website or location, or of a product or service on the respondent's website or location (Policy, paragraph 4(b)(iv)).

As the disputed domain name is confusingly similar to the Complainant's FENDI trademark and directs users to a website that makes unauthorized use of the Complainant's FENDI trademarks while purporting to sell products bearing the Complainant's FENDI trademark, the Panel considers that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's FENDI trademark regarding the source, sponsorship, affiliation, or endorsement of the Respondent's website. In this regard, the Panel concludes that the disputed domain name was also used in bad faith.

Lastly, the Panel also notes that the Respondent provided incorrect or incomplete contact information in the Whois register for the disputed domain name since, according to the email correspondence between the Center and the postal courier DHL, the Written Notice on the Notification of Complaint could not be delivered. This supports the Panel's bad faith finding.

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 <fendistore.com> be transferred to the Complainant.

*/Dr. Zeynep Yasaman/*

**Dr. Zeynep Yasaman**

Sole Panelist

Date: November 28, 2024