

ADMINISTRATIVE PANEL DECISION

Valentino S.p.A. v. 洗维法 (Xian Wei Fa)

Case No. DCC2022-0013

1. The Parties

The Complainant is Valentino S.p.A., Italy, represented by Studio Barbero, Italy.

The Respondent is 洗维法 (Xian Wei Fa), China.

2. The Domain Name and Registrar

The disputed domain name <valentinooutletinc.cc> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on December 2, 2022. 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 December 6, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on December 8, 2022, 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 amendment to the Complaint in English on December 9, 2022.

On December 8, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On December 9, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amendment to the 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 December 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 5, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on January 30, 2023. 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 house founded in 1960 by Mr. Valentino Garavani and his business partner Giancarlo Giammetti. Its retail network around the world includes over 30 boutiques in China. The Complainant owns multiple trademark registrations, including the following:

- International trademark registration number 570593 for VALENTINO, registered on April 24, 1991, designating multiple jurisdictions including China, and specifying goods in classes 3, 14, 18, and 25; and
- International trademark registration number 975800 for a semi-figurative mark featuring V VALENTINO GARAVANI, registered on July 22, 2008, and specifying goods in classes 18 and 25.

The above trademark registrations remain current. The Complainant also registered the domain name <valentino.com> on July 21, 1998, which it uses in connection with an online store.

The Respondent is an individual resident in China. According to information provided by the Complainant, the Respondent has been found by panels in prior proceedings under the UDRP to have registered and been using in bad faith other domain names similar to the disputed domain name. See *Valentino S.p.A. v. 洗维法 (Xian Wei Fa)*, WIPO Case No. [DCC2020-0009](#), regarding the domain name <valentinooutletonline.cc>; and *Valentino S.p.A. v. 洗维法 (Xian Wei Fa) and 郑芳芳 (Zheng Fang Fang)*, WIPO Case No. [D2022-1119](#), regarding the domain names <valentinooutletinc.com> and <valentinoinc.cc>.

The disputed domain name was registered on May 23, 2022. It resolves to a website in English titled “Discount 80% OFF Valentino Outlet Store Online” that prominently displays the Complainant’s VALENTINO GARAVANI semi-figurative mark and offers for sale what purport to be the Complainant’s shoes and handbags at discount prices. Prices are displayed in USD. The website also displays news articles about the Complainant’s VALENTINO brand and products.

5. Parties’ Contentions

A. Complainant

The disputed domain name is confusingly similar to the Complainant’s VALENTINO mark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not a licensee or authorized agent of the Complainant or in any other way authorized to use the Complainant’s trademark. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name. The disputed domain name resolves to a website displaying the Complainant’s trademarks and product images taken from the Complainant’s website and offering for sale *prima facie* counterfeit VALENTINO products, without providing any disclaimer as to the Respondent’s lack of relationship with the Complainant.

The disputed domain name was registered and is being used in bad faith. In light of the extensive use of the VALENTINO trademark since the 1960s, the amount of advertising and sales of the Complainant’s products worldwide, including in China, where the Respondent is *prima facie* based, the Respondent could not possibly have ignored the existence of the Complainant’s VALENTINO trademark when he registered the disputed domain name. The disputed domain name is used in connection with a commercial website

displaying the Complainant's trademarks, product images taken from the Complainant's website, and information about the Complainant, and offering for sale *prima facie* counterfeit VALENTINO-branded products.

B. Respondent

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

6. Discussion and Findings

6.1. Language of the Proceeding

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or 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, having regard to the circumstances of the administrative proceeding". The Registrar confirmed that the Registration Agreement for the disputed domain name is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main arguments are that the Complainant cannot communicate in Chinese; translation of the Complaint would cause delay; and while the disputed domain name contains English terms and resolves to a website entirely in English which demonstrates that the Respondent understands English.

Paragraphs 10(b) and (c) of the Rules requires the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that in this proceeding the Complaint and the amendment to the Complaint were filed in English. The website associated with the disputed domain name is entirely in English, from which it is reasonable to infer that the Respondent understands that language. Further, despite the Center having sent an email regarding the language of the proceeding and the notification of the Complaint in both Chinese and English, the Respondent has not commented on the issue of language or expressed any interest in otherwise participating in this proceeding. Therefore, the Panel considers that requiring the Complainant to translate the Complaint, as amended, would create an undue burden and delay, whereas accepting it as filed without translation will not cause unfairness to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English. The Panel would have accepted a Response in Chinese, but none was filed.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove 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

Based on the evidence presented, the Panel finds that the Complainant has rights in the VALENTINO mark.

The disputed domain name wholly incorporates the VALENTINO mark as its initial element. It also includes the word “outlet” and the letters “inc” (which are an abbreviation for “incorporated”). However, these additional elements do not avoid a finding of confusing similarity because the VALENTINO mark remains clearly recognizable in the disputed domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), sections 1.7 and 1.8.

The only other element in the disputed domain name is the country code Top-Level Domain (“ccTLD”) extension of the Cocos (Keeling) Islands, *i.e.*, “.cc”. As a standard requirement of domain name registration, this element may be disregarded in the comparison between the disputed domain name and the VALENTINO mark for the purposes of the first element of paragraph 4(a) of the Policy. See [WIPO Overview 3.0](#), section 1.11.1.

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the respondent] of the dispute, [the respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] 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 [disputed] 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 [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The disputed domain name wholly incorporates the Complainant’s VALENTINO trademark and resolves to a website that prominently displays the V VALENTINO GARAVANI semi-figurative mark. The website offers for sale what purport to be the Complainant’s shoes and handbags and displays news articles about the Complainant’s brand and products, without displaying the name of the website operator. The Complainant submits that the Respondent is not its licensee, authorized agent, or authorized reseller. Regardless of whether the products offered for sale on the Respondent’s website are counterfeit or genuine, the Panel notes that the website displays no disclaimer regarding the lack of a relationship between the Respondent and the Complainant; on the contrary, it gives the false impression that it is operated by, affiliated with, or endorsed by, the Complainant. This does not constitute a *bona fide* offering of goods or services for the purposes of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Given that the website associated with the disputed domain name is an online store, this is not a legitimate noncommercial or fair use of the disputed domain name either.

According to the information in the Registrar’s WhoIs database, the Respondent’s name is “洗维法 (Xian Wei Fa)”. There is no evidence indicating that the Respondent has been commonly known by the disputed domain name.

In summary, the Panel considers that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent did not rebut that case because he did not respond to the Complainant's contentions.

Therefore, based on the record of this proceeding, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

- (iv) by using the [disputed] domain name, [the respondent has] intentionally attempted 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 the 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.

As regards registration, the disputed domain name was registered in 2022, many years after the registration of the Complainant's VALENTINO mark, including in China, where the Respondent is located. The disputed domain name wholly incorporates the VALENTINO mark as its initial element and resolves to a website that offers for sale what purport to be the Complainant's products and displays news articles about the Complainant's brand and products. Further, the Panel notes that the Respondent registered the disputed domain name over a year after the panel in a prior UDRP case between the same Parties found that he had registered and was using the VALENTINO mark in bad faith in another domain name. See *Valentino S.p.A. v. 洗维法 (Xian Wei Fa)* in section 4 above. In view of these circumstances, the Panel finds that the Respondent was aware of the Complainant's VALENTINO mark and targeted it when he registered the disputed domain name.

As regards use, the disputed domain name resolves to a website that prominently displays the V VALENTINO GARAVANI semi-figurative mark, offers for sale what purport to be the Complainant's products, and displays news articles about the Complainant's brand and products. Given the Panel's findings in section 6.2B above, the Panel finds that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's VALENTINO mark as to the source, sponsorship, affiliation, or endorsement of his website or of the products on his website within the terms of paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) 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 <valentinooutletinc.cc> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: February 2, 2023