

ADMINISTRATIVE PANEL DECISION

Valentino S.p.A. v. 洗维法 (Xian Wei Fa) and 郑芳芳 (Zheng Fang Fang)
Case No. D2022-1119

1. The Parties

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

The Respondents are 洗维法 (Xian Wei Fa) and 郑芳芳 (Zheng Fang Fang), China.

2. The Domain Names and Registrars

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

The disputed domain name <valentinooutletinc.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 March 31, 2022. On April 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <valentinooutletinc.com>. On April 2, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <valentinooutletinc.com> which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 4, 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 April 4, 2022. On April 8, 2022, the Complainant submitted the first amended Complaint in English, requesting that the disputed domain name <valentinoinc.cc> be added to the Complaint. On April 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <valentinoinc.cc>. On April 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <valentinoinc.cc> which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 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 the second amended Complaint in English on April 12, 2022.

On April 4, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On April 4, 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, the first amended Complaint, and the second 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 in English and Chinese of the Complaint, and the proceedings commenced on April 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on May 5, 2022.

The Center appointed Rachel Tan as the sole panelist in this matter on May 18, 2022. 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 the fashion designer, Valentino Garavani and his business partner Giancarlo Giammetti. The Complainant offers a wide range of luxury products, from Haute Couture and Prêt-à-Porter to an extensive accessories collection that includes bags, shoes, small leather goods, belts, eyewear, silks, and perfumes. The Complainant’s products are available in over 90 countries through a retail network of 160 Valentino directly-operated stores as well as in over 1,300 points of sale. Several of the Complainant’s stores are located in China, where the Respondents are *prima facie* based.

The Complainant is the owner of a range of trade mark registrations that comprise or contain the term “valentino”. For example, International Trade Mark Registration No. 570593 for VALENTINO, registered on April 24, 1991, designating, *inter alia*, China in classes 3, 14, 18, and 25; International Trade Mark Registration No. 969844 for VALENTINO GARAVANI, registered on July 2, 2008, designating, *inter alia*, China in classes 8, 11, 19, 20, 21, 27, 36, 42, and 43; and International Trade Mark Registration No. 975800 for  VALENTINO, registered on July 22, 2008, designating, *inter alia*, China in classes 18 and 25.

The Complainant also owns over 1,000 domain names comprising of or containing the VALENTINO mark. The website “www.valentino.com” (“the Complainant’s Official Website”) is owned and operated by the Complainant since 1998, which provides information about the Complainant’s activity and products and an online store where the Complainant’s branded goods are advertised and offered for sale. In addition, the Complainant maintains presence online through social media such as Facebook, Twitter, Instagram, Pinterest, and YouTube.

The Respondents are 洗维法 (Xian Wei Fa) and 郑芳芳 (Zheng Fang Fang), China.

The disputed domain names <valentinooutletinc.com> and <valentinoinc.cc> were registered on April 29, 2021 and April 2, 2022, respectively. At the date of this Decision, the disputed domain names do not resolve to any active websites. At the time of filing of the Complaint, both disputed domain names resolved to websites in English, which appeared to offer the Complainant’s products for sale at a discounted price. The resolved websites displayed the Complainant’s trade marks including VALENTINO, VALENTINO GARAVANI and , as well as the Complainant’s product images taken from the Complainant’s Official Website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to the registered mark VALENTINO. The disputed domain names incorporate the whole of the Complainant's VALENTINO mark. The inclusion of the non-distinctive elements, "outlet" and "inc", in the disputed domain names does not affect the confusing similarity between the disputed domain names and the Complainant's VALENTINO mark. On the contrary, it is apt to reinforce the likelihood of confusion, as the term "outlet" is descriptive of a location where consumers can shop for brand name items at a discount and "inc" is commonly used in English as an abbreviation for the descriptive word "incorporated". The general Top-Level Domains ("gTLDs") ".com" and ".cc" are standard registration requirements which can be disregarded under the first element confusing similarity test.

The Complainant further alleges that the Respondents are not a licensee or authorized agent of the Complainant or in any other way authorized to use the Complainant's trade mark. Specifically, the Respondents are not an authorized reseller of the Complainant and have not been authorized to register and use the disputed domain names. Further, the Respondents are not commonly known by the disputed domain names. The disputed domain names have been redirected by the Respondents to websites displaying the Complainant's trade marks and product images taken from the Complainant's Official website and offering for sale *prima facie* counterfeit VALENTINO products without providing any disclaimer as to the lack of relationship between the Respondents and the Complainant. The statements on the home page of the resolved websites are apt to induce Internet users to believe that the websites are owned or controlled by the Complainant or its affiliated companies. The Respondents' use of the disputed domain names cannot be considered a legitimate noncommercial or fair use without intent for commercial gain.

The Complainant finally asserts that the Respondents knew or should have known the existence of the Complainant given the well known character of the VALENTINO mark. The fact that the purported VALENTINO products were offered for sale and the Complainant's trade marks and images have been published on the resolved websites indicates that the Respondents were fully aware of the Complainant and its mark. The Respondents' purpose in registering the disputed domain names was to capitalize on the reputation of the Complainant's mark, by attracting Internet users seeking the Complainant's branded products to their own websites for commercial gain and intentionally creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of their websites and the goods offered and promoted through the resolved websites. Further, the Respondent 洗维法 (Xian Wei Fa) was involved as a respondent in seven prior UDRP decisions, showing a pattern of abuse.

B. Respondent

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

6. Discussion and Findings

6.1 Language of the Proceeding

Initially, the Panel must address the language of the proceeding. Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The panel may choose to write a decision in either language, or request translation of either party's submissions.

In this case, the Registrars have confirmed to the Center that the language of the Registration Agreements as used by the registrants for the disputed domain names is Chinese. However, the Complainant has requested that English be adopted as the language of the proceeding for the reasons summarised below:

(a) the Complainant communicates in English and would be prejudiced should it be required to translate the Complaint and participate in the proceeding in Chinese;

(b) requiring the Complainant to translate the Complaint into Chinese would cause delay in contravention to paragraph 10(c) of the Rules;

(c) the disputed domain names include Latin characters and consist of a combination of the VALENTINO mark with the English terms “outlet” and “inc” (abbreviation of the English word “incorporation”);

(d) the disputed domain names have been pointed to websites drafted entirely in English, where the prices are indicated in the currency of the United States of America (“United States”), and displaying an address located in the United States;

(e) the Respondents demonstrated that they understand English; and

(f) the prior UDRP panel accepted the Complainant’s request for English to be the language of the proceedings in similar cases *e.g.*, *Valentino S.p.A. v. 洗维法 (Xian Wei Fa)*, WIPO Case No. [DCC2020-0009](#).

It is established practice to take paragraphs 10(b) and 10(c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

The Panel having considered the circumstances finds that English shall be the language of this proceeding. The reasons are set out below:

(a) the Complainant is a company based in Italy. Requiring the Complainant to translate the Complaint in Chinese would lead to delay and cause the Complainant to incur translation expenses;

(b) both disputed domain names previously resolved to websites in English;

(c) even if the Respondents do not possess a sufficient command of English to understand the Complaint, there were ample opportunities for the Respondents to raise an objection. The Center notified the Parties in English and Chinese of the language of the proceeding, the Complainant’s request for English to be the language of the proceeding, but the Respondents did not protest against this request;

(d) the Respondents have failed to participate in the proceeding even though the Center sent the notification of the Complaint in English and Chinese, and have been notified of their default; and

(e) the Complaint has been submitted in English. No foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

Accordingly, the Panel will proceed with issuing this Decision in English.

6.2 Consolidation

The Complainant requests that the disputed domain names be consolidated under a single UDRP complaint.

The key considerations in determining whether cases should be consolidated where they involve multiple respondents are identified in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), as being whether: (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency is also noted as being a relevant consideration.

In this case, there are numerous similarities between the disputed domain names themselves and the websites to which they resolved. To begin with, the disputed domain names are confusingly similar to the Complainant's VALENTINO mark as each of them consists of the Complainant's VALENTINO mark together with the terms "outlet" and "inc". In addition, the disputed domain names are using the same name server "Cloudflare DNS", and the Complainant has submitted that the disputed domain name <valentinoinc.cc> has been pointed to a website identical to the one previously displayed at the disputed domain name <valentinooutletinc.com>.

Overall, the Panel finds that it is most likely that the disputed domain names are under common control. Neither of the Respondents have challenged the Complainant's request for consolidation, and it is clearly most procedurally efficient, and, in all the circumstances, fair and equitable for the disputed domain names to be included together in this one case. Accordingly, the Panel grants the Complainant's request for consolidation.

6.3 Substantive Issues

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has adduced evidence to demonstrate its established rights in the VALENTINO mark.

The Panel notes that the VALENTINO mark is wholly encompassed within the disputed domain names. The VALENTINO mark is instantly recognizable as the most distinctive element of these disputed domain names. In cases where a domain name incorporates the entirety of a trade mark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. See section 1.7 of the [WIPO Overview 3.0](#).

Further, it is accepted by previous UDRP panels that the addition to the complainant's trade mark of other words or terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity between the domain name and the complainant's trade mark under the first element of the Policy. See section 1.8 of the [WIPO Overview 3.0](#). As such, the Panel finds the additional elements "outlet" and/or "inc" which are related to the Complainant's business in the disputed domain names do not preclude a finding of confusing similarity between the VALENTINO mark and the disputed domain names.

Lastly, it is permissible for the Panel to disregard the TLD in the disputed domain names, *i.e.*, ".com" and ".cc" in the disputed domain names. It is accepted by UDRP panels that the practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD and the ccTLD. See sections 1.11.1 and 1.11.2 of the [WIPO Overview 3.0](#).

Accordingly, the Complainant has satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

In circumstances where the Complainant possesses exclusive rights to the VALENTINO mark, whereas the Respondents seems to have no trade mark rights, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names, and the burden of production shifts to the Respondents to show that they have rights or legitimate interests in the disputed domain names. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondents have not provided evidence of a legitimate noncommercial or fair use of the disputed domain names or reasons to justify their choice of the term "valentino" in the disputed domain names. There is no indication to show that the Respondents are commonly known by the disputed domain names or otherwise have rights or legitimate interests in any of them. In addition, the Complainant has not granted the

Respondents any license or authorization to use the Complainant's VALENTINO mark or register the disputed domain names.

The Panel notes that the disputed domain names previously resolved to websites in English which allegedly offered the counterfeit VALENTINO products for sale. The websites noticeably displayed the Complainant's trade marks including VALENTINO, VALENTINO GARAVANI, and  together with images of the Complainant's products at a discounted price. The websites did not accurately and prominently disclose a lack of a relationship between the Complainant and the Respondents. Therefore, the facts do not support a claim of a *bona fide* offering of goods or services under the "Oki Data test". See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondents have no rights or legitimate interests in the disputed domain names.

Accordingly, the Complainant has satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant's VALENTINO mark was registered well before the registration of the disputed domain names. Through use and advertising, the Complainant's VALENTINO mark is known throughout the world, including in China. Search results using the term "valentino" on the Internet search engines direct Internet users to the Complainant and its products, which indicates that an exclusive connection between the VALENTINO mark and the Complainant has been established. As such, the Respondents either knew or should have known of the Complainant's VALENTINO mark when registering the disputed domain names.

The Panel notes that the disputed domain names previously resolved to websites allegedly offering for sale the Complainant's VALENTINO products, and on which the Complainant's VALENTINO, VALENTINO GARAVANI, and  marks prominently appeared. Further, the resolved websites allegedly used the Complainant's product images without authorization. The lack of a disclaimer that the Respondents are not affiliated with the Complainant is noticeably absent. Conversely, the content on the websites would lead Internet users to think that the online stores were authorized by the Complainant.

The Panel is satisfied that the Respondents intend to take advantage of the reputation of the Complainant's trade mark to attract, for commercial gain, Internet users to the Respondents' websites by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation, or endorsement of their websites. This demonstrates bad faith registration and use of the disputed domain names, as provided in paragraph 4(b)(iv) of the Policy.

The Panel also notes that the Respondent 洗维法 (Xian Wei Fa) appears to be engaged in a pattern of abusive registration having registered multiple domain names comprising third-party trade marks. The Panel finds this case is a continuation of that bad faith pattern. See *Sidley Austin LLP v. 石磊 (Shi Lei)*, WIPO Case No. [D2020-3004](#). Such use constitutes evidence of bad faith registration and use as contemplated under paragraph 4(b)(ii) of the Policy.

Given all the circumstances of the case, the Panel finds that the Respondents must have known of the Complainant before registering the disputed domain names, and considering the Respondents' lack of rights or legitimate interests, and by registering and using the disputed domain names as discussed above, the Panel is led to conclude that the disputed domain names were registered and are being used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied the third element under 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 names, <valentinoinc.cc> and <valentinooutletinc.com>, be transferred to the Complainant.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: May 31, 2022