

ADMINISTRATIVE PANEL DECISION

Valentino, S.p.A. v. bixiang lin, donger chen, paul cai, mady james, rosykey tang, qi li, and luse lee
Case No. D2023-2189

1. The Parties

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

The Respondents are bixiang lin, donger chen, paul cai, mady james, rosykey tang, qi li, and luse lee, all located in China. They are collectively referred to below as “the Respondent”, unless otherwise stated.

2. The Domain Names and Registrar

The disputed domain names <bolsavalentinofalsa.com>, <cheapvalentinobagscanada.com>, <cheapvalentinobags.org>, <cheapvalentinobagsuk.com>, <cheapvalentinooutlet.org>, <cheapvalentinosale.com>, <fakevalentinobags.com>, <fakevalentinoshoescanada.org>, <fakevalentinoshoes.com>, <fakevalentinoshoesuk.org>, <falskvalentinotasker.org>, <falsovalentinouomo.org>, <intovalentino.com>, <replicasapatovalentino.org>, <valentinoaustralia.org>, <valentinobagsusa.com>, <valentinohandbagaaustralia.org>, <valentinomujerbarato.org>, <valentinooutletcanada.com>, <valentinooutletdenmark.com>, <valentinooutlethomme.com>, <valentinooutlet.online>, <valentinooutletportugal.com>, <valentinooutletsale.org>, <valentinooutletuk.com>, <valentinooutletusa.com>, <valentinopascherfrance.com>, <valentinosaleaustralia.com>, <valentinoshoescanadasale.org>, <valentinoshoessaleuk.com>, <valentinosoldesfemme.com>, <valentinosoldesfrance.org>, <valentinosydneystore.com>, <valentinotaschedamen.com>, and <valentinousasale.org> are registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 18, 2023. On May 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 23, 2023, and May 25, 2023, the Registrar transmitted by email to the Center its verification responses confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on May 25, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On May 25, 2023, the Complainant confirmed that the Respondent details disclosed by the Registrar had already been included in the Complaint, and that the Complainant had nothing to add to its consolidation request.

The Center verified that 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 of the Complaint, and the proceedings commenced on June 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2023. The Respondent did not submit any response. On June 2, 2023, and July 13, 2023, a third party sent email communications to the Center indicating that it was not the registrar or the host of the disputed domain names. Accordingly, the Center notified the Commencement of Panel Appointment Process on July 5, 2023.

The Center appointed Adam Taylor as the sole panelist in this matter on July 13, 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 well-known fashion brand that has traded under the mark VALENTINO for over 50 years. Its products are available in some 90 countries, including via many directly-operated retail stores.

The Complainant owns numerous trade marks for VALENTINO including International Registration No. 570593, registered on April 24, 1991, in classes 3, 14, 18 and 25, designating, among others, China.

The Complainant operates a website at “www.valentino.com”.

The disputed domain names were registered between June 9, 2022, and April 6, 2023.

The disputed domain name <valentinooutletsale.org> has been used for a website branded with the Complainant’s “V” logo and including the title: “Welcome to Valentino Outlet Sale Online”. The site purports to offer the Complainant’s products, such as “VALENTINO GARAVANI”, for sale at heavily discounted prices. All of the other disputed domain names are being used to redirect to this website.

The Complainant sent cease and desist letters to the Respondent on March 9, 2023, and April 18, 2023. There was no response.

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 names.

B. Respondents

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- the disputed domain names have been registered and are being used in bad faith.

A. Procedural Issue – Consolidation of Multiple Respondents

The principles governing the question of whether a complaint may be brought against multiple respondents are set out in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel notes the following:

- 1) All of the disputed domain names have been registered through the same Registrar.
- 2) There is a substantial overlap between the contact details for the various disputed domain names, including use of contact email addresses based on "[...][@126.com](#)" for all of the disputed domain names except for the disputed domain name <cheapvalentinooutlet.org>.
- 3) All of the disputed domain names were registered between June 2022 and April 2023, with 31 of the 35 disputed domain names having been registered in a 10-day period between March 27, 2023, and April 6, 2023. Many of the disputed domain names share the same registration date despite being registered under different registrant names.
- 4) The disputed domain names are in a similar format in that they all consist of the term "valentino" together with additional dictionary or geographical terms.
- 5) All of the disputed domain names have been used to resolve/redirect to the same website.
- 6) None of the Respondents have come forward to object to consolidation.

In these circumstances, the Panel is satisfied that the disputed domain names are subject to common control and that, in the circumstances, consolidation is fair and equitable to all Parties, and also procedurally efficient.

B. 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 3.0](#), section 1.7.

Based on the available record, the Panel finds 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 Panel finds the entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms as set out below may bear on 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 names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The additional terms comprise dictionary words such as “outlet”, “sale”, “cheap”, “fake”, “soldes” (“sales” in French), “pascher” (“cheap” in French), “barato” (“cheap” in Spanish), “falso” (“fake” in Italian), “replica”, “falsa” (“fake” in Italian), “store”, “falsk” (“fake” in Danish), “shoes”, “handbag”, “bags”, “homme” (“man” in French), “femme” (“woman” in French), “tasche” (“bag” in German), “damen” (“women” in German), “sapato” (“shoe” in Portuguese), “mujer” (“woman” in Spanish), “uomo” (“man” in Italian), “tasker” (“bags” in Danish), and “bolsa” (“bag” in Spanish); and geographic terms such as “Canada”, “Australia”, “France”, “Denmark”, “Portugal”, “Sydney”, “UK” and “USA”.

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

C. 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.

While 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 often-impossible 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. 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 record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 names.

Furthermore, panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or impersonation/passing off) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. See further under section 6D below.

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

D. 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.

The Panel considers that the record of this case reflects that:

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites or other on-line locations, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s websites or locations or of a product or service on the Respondent’s websites or locations. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Furthermore, panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or impersonation/passing off) constitutes bad faith. [WIPO Overview 3.0](#), section 3.1.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

In the present case, the Panel considers that the Respondent's use of the terms such as "fake" and "replica" in certain of the disputed domain names, and the fact that products are sold at heavily discounted prices, are indicators that the Respondent is offering counterfeit goods for sale; in any case, and notwithstanding the Respondent's use of such terms, the website to which all of the disputed domain names resolve/redirect seeks to impersonate the Complainant, including by prominent use of the Complainant's logo.

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

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 <bolsavalentinofalsa.com>, <cheapvalentinobagscanada.com>, <cheapvalentinobags.org>, <cheapvalentinobagsuk.com>, <cheapvalentinooutlet.org>, <cheapvalentinosale.com>, <fakevalentinobags.com>, <fakevalentinoshoescanada.org>, <fakevalentinoshoes.com>, <fakevalentinoshoesuk.org>, <falskvalentinotasker.org>, <falsovalentinouomo.org>, <intovalentino.com>, <replicasapatovalentino.org>, <valentinoaustralia.org>, <valentinobagsusa.com>, <valentinohandbagaaustralia.org>, <valentinomujerbarato.org>, <valentinooutletcanada.com>, <valentinooutletdenmark.com>, <valentinooutlethomme.com>, <valentinooutlet.online>, <valentinooutletportugal.com>, <valentinooutletsale.org>, <valentinooutletuk.com>, <valentinooutletusa.com>, <valentinopascherfrance.com>, <valentinosaleaustralia.com>, <valentinoshoescanadasale.org>, <valentinoshoessaleuk.com>, <valentinosoldesfemme.com>, <valentinosoldesfrance.org>, <valentinosydneystore.com>, <valentinotaschedamen.com>, and <valentinousasale.org> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: July 28, 2023