

## **ADMINISTRATIVE PANEL DECISION**

PRADA S.A. v. 颜文君 (Wen Jun Yan)

Case No. D2022-0516

### **1. The Parties**

Complainant is PRADA S.A., Luxembourg, represented by Studio Barbero, Italy.

Respondent is 颜文君 (Wen Jun Yan), China.

### **2. The Domain Name and Registrar**

The disputed domain name <prada-beauty.com> (the “Domain Name”) is registered with Cloud Yuqu LLC (the “Registrar”).

### **3. Procedural History**

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2022. On February 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 16, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

On February 16, 2022, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. Complainant confirmed its request that English be the language of the proceeding on February 16, 2022. Respondent did not comment on the language of the proceeding.

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 Respondent in English and Chinese of the Complaint, and the proceedings commenced on February 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 14, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 15, 2022.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on March 21, 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**

Complainant PRADA S.A., is headquartered in Luxembourg and sells luxury designer products and accessories. Complainant operates in 70 countries with almost 14,000 employees, including several stores in China where Respondent lives and operates.

Complainant owns numerous trademark registrations for the PRADA mark, including:

- Italian Trademark Registration No. 362017000069322 for PRADA (word mark), registered on July 8, 1978;
- European Union Trademark Registration No. 012443362 for PRADA (word and design mark) registered on May 13, 2014;
- European Union Trademark Registration No. 271163 for PRADA (word mark), registered on November 8, 2000;
- International Trademark Registration No. 650695 for PRADA (word and design mark), registered on December 15, 1995, designating various countries including China;
- Chinese Trademark Registration No. 1263052, registered on April 14, 1999; and
- Chinese Trademark Registration No. 1260952, registered on April 7, 1999.

Complainant and its related companies also own and have registered over 260 domain names consisting of or comprising the words PRADA under several different TLDs (“Top-Level Domains”), including <prada.com>, registered on June 9, 1997, <prada.cn> registered on April 6, 2012, and <pradabeauty.com>, registered on March 21, 2001. Complainant’s main website “www.prada.com” is its brand’s global flagship site, offering its full line of merchandise.

The Domain Name was registered on March 17, 2021, and directs to an undeveloped website.

Complainant attempted to contact Respondent by email through a web agency to enquire about Respondent’s intentions regarding the Domain Name and the possibility of transferring the Domain Name to Complainant. An email was sent on December 16, 2021, with reminders sent on December 29, 2021, and on January 4, 2022. On January 13, 2022, a response was received, indicating that the Domain Name was offered for sale for CNY 4,500. A response to this message was sent to Respondent, requesting confirmation of the amount requested for transferring the Domain Name. Respondent responded that about USD 690 was the amount requested for the Domain Name.

Complainant then instructed its representative to send a cease and desist letter to Respondent, based on its trademark rights in PRADA. On January 25, 2022, the cease and desist letter was sent to Respondent’s email address disclosed by the registrar, requesting Respondent to cease any use of, and to transfer the Domain Name to Complainant, with a reminder sent to Respondent on February 7, 2022. Respondent did not provide any response by the time of the filing of the Complaint.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that (i) the Domain Name is identical and confusingly similar to Complainant’s trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has trademark rights in the registrations for PRADA and owns domain names incorporating the PRADA trademarks. Complainant contends that Respondent registered and is using the Domain Name to confuse Internet users looking for *bona fide* and well-known PRADA products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use domain names, which includes Complainant's trademarks, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in acquiring the Domain Name and setting up the corresponding websites, when Respondent clearly knew of Complainant's rights.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

### **6.1. Preliminary Procedural Issue – Language of the Proceeding**

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement between the respondent and the registrar in relation to the disputed domain name, the language of the 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.

Complainant submitted its original Complaint in English. In its Complaint, and email dated February 16, 2022, Complainant requests that the language of the proceeding should be English. According to the information received from the Registrar, the language of the Registration Agreement for the Domain Name is Chinese.

Complainant contends that: Respondent responded in English to a communication sent by a web agency in response to Complainant's inquiry regarding Respondent's intentions to the Domain Name, indicating Respondent's familiarity with English; that the Domain Name is registered in Latin characters and includes the use of the English word "beauty" and that Respondent secured the Domain Name in the TLD ".com", indicating Respondent's intention to target an English-speaking audience. Complainant also contends that it would be unfairly burdensome for Complainant to translate and conduct the proceeding in Chinese and would also cause unnecessary delay in the proceeding.

In exercising its discretion to use a language other than that of the Registration Agreements for the Domain Name, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time and costs.

The Panel accepts Complainant's submissions regarding the language of the proceeding. The Panel notes that the Center notified the Parties in Chinese and English of the language of the proceeding as well as notified Respondent in Chinese and English of the Complaint. Respondent chose not to comment on the language of the proceeding nor did Respondent choose to file a Response.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner. Complainant may be unduly disadvantaged by having to translate the Complaint into Chinese and to conduct the proceeding in Chinese.

Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

## 6.2. Substantive Issues

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) states that failure to respond to the complainant’s contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent’s default is not necessarily an admission that the complainant’s claims are true.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence.

### A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the trademarks, as noted above. Complainant has also submitted evidence, which supports that the PRADA trademarks are widely known and a distinctive identifier of Complainant’s products and services. Complainant has therefore proven that it has the requisite rights in the PRADA trademarks.

With Complainant’s rights in the PRADA trademark established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the TLD in which it is registered (in this case, “.com”), is identical or confusingly similar to Complainant’s trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. D2010-0842.

Here, the Domain Name is confusingly similar to Complainant’s PRADA trademarks. These trademarks, which are fanciful and inherently distinctive, are recognizable in the Domain Name. In particular, the Domain Name includes Complainant’s trademark PRADA in its entirety, and the addition of the term “beauty” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the PRADA trademark. See [WIPO Overview 3.0](#), section 1.8.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

### B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and the PRADA trademarks, and does not have any rights or legitimate interests in the Domain Name.

Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the PRADA trademark or to seek registration of any domain name incorporating the trademark. Respondent is also not known to be associated with or commonly known by the PRADA trademark.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, the evidence demonstrates that at the time of filing the Complaint, the Domain Name resolved to an undeveloped parked page. From the inception of the UDRP, panels have found that that such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Thus, such use by Respondent does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. Moreover, there is no evidence showing that Respondent has been commonly known by the Domain Name. The Domain Name combines the entirety of Complainant's trademark PRADA with the term "beauty", which is descriptive of Complainant's industry and services and renders the Domain Name nearly identical to the Complainant's domain name <pradabeauty.com>, carrying a risk of implied affiliation to Complainant, contrary to the fact, which cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, Complainant has established its *prima facie* case that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The Panel finds that Complainant provided ample evidence to show that registration and use of the PRADA trademarks predate the registration of the Domain Name. Complainant's reputation is also well established and known. Indeed, the record shows that Complainant's PRADA trademarks and related services are widely known and recognized. Therefore, and also noting the composition of the Domain Name is confusingly similar to Complainant's domain names including <prada.com> and <pradabeauty.com>, Respondent was likely aware of the PRADA trademark when it registered the Domain Name, or knew or should have known that the Domain Name was confusingly similar to Complainant's trademark. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Name incorporating Complainant's PRADA trademark suggests Respondent's actual knowledge of Complainant's rights in the PRADA trademark at the time of registration of the Domain Name and its effort to opportunistically capitalize on the reputation of Complainant's trademark.

In addition, as noted above, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Instead, the Domain Name resolved to an undeveloped parked page. As indicated above, such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#). The non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of the [WIPO Overview 3.0](#). Moreover, there is no evidence showing that Respondent has been commonly known by the Domain Name.

Additionally, the Domain Name was listed for sell on a third-party website for CNY 4,500 and Respondent offered the Domain name for "about [USD]690", which clearly indicates that Respondent registered or acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name to Complainant or to a competitor of Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the Domain Name.

Lastly, in the present circumstances, including the distinctiveness and reputation of the PRADA trademark, the failure of Respondent to submit a Response or to provide any evidence of actual or contemplated good-faith use of the Domain Name, and the implausibility of any good-faith use to which the Domain Name may be put, support a finding of bad faith. Accordingly, the Panel finds that Respondent has registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of 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 Domain Name, <prada-beauty.com>, be transferred to Complainant.

*/Kimberley Chen Nobles/*

**Kimberley Chen Nobles**

Sole Panelist

Date: March 30, 2022