

ADMINISTRATIVE PANEL DECISION

Valentino S.p.A. v. Registration Private, Domains By Proxy, LLC / Green Jim,
Jimgreen

Case No. D2022-2547

1. The Parties

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

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America (“United States”) / Green Jim, Jimgreen, United States.

2. The Domain Name and Registrar

The disputed domain name <itvalentino.shop> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 13, 2022. On July 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 14, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 July 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 18, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on September 2, 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 the owner of numerous trademark registrations for VALENTINO, including the following:

- International Trademark Registration No. 570593 for VALENTINO (word mark), registered on April 24, 1991, and duly renewed, in classes 3, 14, 18 and 25;
- International Trademark Registration No. 764790 for VALENTINO (word mark), registered on November 20, 2000, and duly renewed, in classes 3, 9, 14, 16, 18, 19, 20, 21, 24, 25, 27, 34 and 35;
- International Trademark Registration No. 0400501 for VALENTINO (word mark), registered on August 9, 1973, and duly renewed, in classes 3, 8, 14, 16, 18, 20, 21, 23, 24, 25, 26, 27 and 34, designating, amongst others, United States;
- European Union Trade Mark Registration No. 001990407 for VALENTINO (word mark), filed on December 7, 2000, registered on September 18, 2008, and duly renewed, in classes 3, 9, 14, 16, 18, 19, 20, 21, 24, 25, 27, 34, and 35;
- United States Trademark Registration No. 0910955 for VALENTINO (word mark), filed on February 10, 1970, registered on April 6, 1971, and duly renewed, in International class 25.

The Complainant is the owner of over 900 domain names identical to, or comprising the trademark VALENTINO.

The website “www.valentino.com” has been owned and operated by the Complainant since 1998. It 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.

The Complainant sent several cease and desist letters to the Respondent, which were not answered.

The disputed domain name was registered on March 23, 2022. The disputed domain name resolves to a website featuring Complainant’s trademarks and offering for sale purported Valentino products at discounted prices.

5. Parties’ Contentions

A. Complainant

The Complainant was founded in 1960 by the legendary fashion designer Valentino Garavani and his business partner Giancarlo Giammetti. The Complainant is a major player on the fashion scene and offers a wide range of luxury products from haute couture and prêt-à-porter.

Valentino is one of the most recognized brands in the world. It is available in over 90 countries due to a retail network of 160 Valentino directly-operated stores located in shopping streets globally as well as in over 1,300 points of sale.

Valentino has been popular with famous, well-dressed women for more than four decades, including Jackie Onassis, Elizabeth Taylor, Halle Berry, Jennifer Lopez, Cate Blanchett, and Gwyneth Paltrow.

The Complainant is the owner of a broad array of trademark registrations for VALENTINO. The trademark has been regularly used by the Complainant for more than 50 years in connection with products in the high-fashion and leather industry, including ready-to-wear clothes, handbags, small leather goods, luggage, shoes, jewelry, gifts, eyewear, and fragrances.

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The disputed domain name is confusingly similar to the Complainant's registered VALENTINO trademark, in light of the fact that it wholly incorporates the Complainant's mark.

The Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant states that the Respondent should be considered as having no rights or legitimate interests in the disputed domain name. The Complainant has never licensed or otherwise permitted the Respondent to use its trademarks or to register any domain name that included its trademarks.

The disputed domain name has been registered and is being used in bad faith.

The Complainant asserts that the disputed domain name was registered and is being used in bad faith. The mere fact of registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use. Furthermore, the Respondent's impersonating and/or competing uses of the disputed domain name is clear evidence of bad faith.

The Complainant requests the Panel to issue a decision finding that the disputed domain name be transferred to the Complainant, in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in previous UDRP decisions that a Respondent's default (*i.e.*, failure to submit a response) 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 (See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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

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.

The Complainant has provided evidence of its rights in the trademark VALENTINO on the basis of its multiple trademark registrations in several countries. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see [WIPO Overview 3.0](#), section 1.2.1). It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark. Such findings were confirmed, for example, within section 1.7 of [WIPO Overview 3.0](#).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's VALENTINO mark. The Respondent's incorporation of the Complainant's mark in full in the disputed domain name is sufficient to establish that the disputed domain name is confusingly similar to the Complainant's marks. The mere addition of the term "it" to the Complainant's trademark VALENTINO does not prevent a finding of confusing similarity with the Complainant's mark. Furthermore, the addition of the Top-Level Domain ("TLD") "shop" does not prevent a finding of confusing similarity either.

The Panel is satisfied that the disputed domain name is confusingly similar to the Complainant's mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by the Respondent, will lead to this ground being set forth. Refraining from submitting any Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests in the disputed domain name.

The Panel will now examine the Complainant's arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain name. The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner. Furthermore, the disputed domain name directs to a commercial website that includes the trademark VALENTINO and logos of the Complainant, and offers the likely counterfeit goods, based on the low prices, exacerbating the user confusion as to the website's affiliation to the Complainant. Such use for deliberately attracting Internet users to its website in the mistaken belief that it is a website of the Complainant, or otherwise linked to or authorized by the Complainant supports a finding that the Respondent lacks rights to or legitimate interests in the disputed domain name.

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith:

(i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the

owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;

(ii) the 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 the respondent has engaged in a pattern of such conduct;

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location.

In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. In this case, the widespread commercial recognition of the trademark VALENTINO is such that the Respondent must have had knowledge of the trademark before registering the disputed domain name. Moreover, the disputed domain name is inherently misleading as it reproduces the Complainant's VALENTINO trademark together with geographic acronym "it", which corresponds to Italy.

The Respondent's registration and use of the disputed domain name constitutes bad faith under paragraph 4(b)(iv) of the Policy, because the Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's widely recognized VALENTINO trademark as to the source, sponsorship, affiliation, and/or endorsement of the disputed domain name, the Respondent's website, and the unauthorized, allegedly counterfeit products advertised/offered therein. It is well established, that the mere registration of a domain name that is identical or confusingly similar, particularly domain names incorporating the mark plus a geographic term to widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Taken into account the Respondent's use of the disputed domain name for *per se* illegitimate activity, such as the sale of allegedly counterfeit goods, such behavior is manifestly considered evidence of bad faith

In addition, the Panel concludes that the Respondent's registration and use of the disputed domain name constitute bad faith under paragraph 4(b)(iii) of the Policy, because the Respondent disrupts the Complainant's business and unfairly competes with the Complainant by using the disputed domain name to advertise/offer unauthorized, allegedly counterfeit, products that compete with the Complainant's genuine products.

The Panel finds the disputed domain name has been registered and is being used in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

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, <itvalentino.shop>, be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: September 16, 2022