

ADMINISTRATIVE PANEL DECISION

Gianni Versace S.r.l. v. Name Redacted
Case No. D2022-2799

1. The Parties

The Complainant is Gianni Versace S.r.l., Italy, represented by Studio Barbero, Italy.

The Respondent's identity is discussed below.

2. The Domain Name and Registrar

The disputed domain name <versace.club> (the "Disputed Domain Name") is registered with OVH (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 29, 2022. On July 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 29, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 9, 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 on August 10, 2022.

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 of the Complaint, and the proceedings commenced on August 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 1, 2022. The Respondent did not submit a response before the due date. Accordingly, the Center notified the Respondent's default on September 5, 2022. The individual registrant as disclosed by the Registrar sent an email to the Center on September 6, 2022 (see below).

The Center appointed Nick J. Gardner as the sole panelist in this matter on September 15, 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 an Italian fashion and luxury goods company founded in 1978 by the stylist Gianni Versace, specializing in fashion, accessories, jewelry, watches, eyewear, fragrances and home furnishings. Since 2000, its VERSACE brand has also been used for hospitality services. The Complainant operates numerous websites under the VERSACE brand including its primary portal at “www.versace.com”. The filed evidence establishes the Complainant is a famous and well-known business.

The Complainant is the owner of numerous trademarks in various jurisdictions consisting of the word “Versace” – see for example European Union Trademark Registration No. 001665439 (word mark), filed on May 18, 2000, registered on September 10, 2001. These trademarks are referred to in this decision as the “VERSACE Trademark”.

The Disputed Domain Name was registered on November 2, 2021. Filed evidence establishes that the Disputed Domain Name at one stage resolved to a website promoting some form of on-line game which appeared to be available by subscription. It now does not resolve to an active website.

On July 28, 2022, in response to cease and desist letters from the Complainant’s representatives an email was received from a Gmail address stating “I’ve already cancelled the domain, it’s inactive as far as I know”. The name of the sender was not the same as the name of the registrant as disclosed by the Registrar.

5. Parties’ Contentions

A. Complainant

The Complainant’s case is set out in considerable detail and cites numerous previous UDRP decisions. It can be summarised as follows.

(i) the Disputed Domain Name is identical to the VERSACE Trademark. The generic Top-Level Domain (“gTLD”) “.club” is to be ignored in making the relevant comparison.

(ii) the Respondent has no rights nor any legitimate interests in respect of the Disputed Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the VERSACE Trademark nor is the Respondent commonly known by the Disputed Domain Name. The Respondent does not use the Disputed Domain Name for a *bona fide* purpose or legitimate noncommercial purpose; and

(iii) the Disputed Domain Name has been registered and is being used in bad faith. It is inconceivable that the Respondent was unaware of the existence of the Complainant’s VERSACE Trademark and its worldwide reputation at the time of registration of the Disputed Domain Name. VERSACE is a trademark with such widespread notoriety that it would be nearly impossible for the Respondent not to have known this. There is no plausible circumstance under which the Respondent could legitimately use the Disputed Domain Name, other than in bad faith. Given the distinctiveness and reputation of the Complainant’s trademark, the Respondent clearly acted in opportunistic bad faith, by registering the Disputed Domain Name with full knowledge of the Complainant’s trademark for the purpose of taking commercial advantage of the Complainant’s trademark. The linking of the Disputed Domain Name to some form of subscription-based gaming service was intended to take unfair advantage of the Complainant’s trademark. As to the current resolution of the Disputed Domain Name to an inactive website, as established in a number of prior cases, the concept of “bad faith use” includes not only positive action but also passive holding. See the well-known

case *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The Complainant also says that mail exchanger records (MX records) for use in connection with email communication are currently displayed in the DNS configuration of the Disputed Domain Name and that the presence of MX records in the zone files suggests the possible use of the Disputed Domain Name in connection with the receipt as well as the sending of emails from email addresses based on the Disputed Domain Name which suggests a likelihood of fraudulent activity which again amounts to bad faith registration and use.

B. Respondent

No Response has been filed (see further below).

6. Discussion and Findings

Preliminary Matters – Respondent Identity

It appears from the record that the individual identified by the Registrar as the registrant of the Disputed Domain Name may have nothing to do with this matter, his name having been recorded in relation to the Disputed Domain Name without his knowledge. The Panel proposes to follow the course of action adopted by the panel in *Elkjøp Nordic A/S v. Name Redacted*, WIPO Case No. [D2013-1285](#) and set out as follows:

“As in *Moncler S.r.l. v. Name Redacted*, WIPO Case No. [D2010-1677](#), *Boehringer Ingelheim Pharma GmbH & Co. KG v. Name Redacted*, WIPO Case No. [D2012-0890](#) and *Saudi Arabian Oil Company v. Name Redacted*, WIPO Case No. [D2013-0105](#), this is a case in which the Panel finds that the Domain Name was registered by a third-party without the involvement of the person identified in the Whois as the registrant of the Domain Name, against whom the Complaint was filed. The Panel has accordingly redacted the name of that person from the caption and body of this Decision. The Panel has attached as an Annexure to this Decision an instruction to the Registrar regarding transfer of the Disputed Domain Name that includes the name of that person so as to enable effect to be given to the Panel’s order. To this end, the Panel authorises the Center to transmit the Annexure to the Registrar and the parties but further directs the Center and Registrar, pursuant to paragraph 4(j) of the Policy and paragraph 16(b) of the Rules, that the Annex to this Decision shall not be published in this exceptional case.”

Accordingly, in this decision references to the Respondent are to the unknown person who registered the Disputed Domain Name.

Preliminary Matters – no Response

The Panel notes that no Response has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

(i) the Disputed Domain Name is identical with 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;

(iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the VERSACE Trademark. The Disputed Domain Name is identical to this trademark. It is well established that the gTLD, in this case “.club”, is not generally taken into account for the purpose of determining whether a domain name is identical or confusingly similar – see for example *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Name is identical to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

(i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the VERSACE Trademark. The Complainant has prior rights in the VERSACE Trademark which precede the registration of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish his rights or legitimate interests in the Disputed Domain Name. Accordingly the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

The Panel agrees with the Complainant that there are multiple indications of bad faith registration and use of the Disputed Domain Name. Absent any credible explanation from the Respondent the Panel considers it inconceivable the Respondent was not aware of the VERSACE Trademark when the Disputed Domain Name was registered, and that the Respondent chose it because it corresponds to that trademark.

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

(i) circumstances indicating that the respondent has registered or has 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 the respondent’s documented out-of-pocket costs directly related to the domain

name; or

(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; or

(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 the respondent's web site 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 the web site or location or of a product or service on the web site or location.

In the present circumstances where the Disputed Domain Name is identical to the well-known VERSACE Trademark, it seems more likely than not that factor (iv) applies as the Respondent was seeking to achieve some form of commercial gain by linking the Disputed Domain Name to an online site providing some form of subscription based gaming.

In any event the present factual situation – *i.e.* that the Disputed Domain Name does not resolve to an active website – can itself support a finding of bad faith, especially in relation to a manifestly well-known trademark. See in this regard [WIPO Overview 3.0](#) at section 3.3 as follows:

“Can the ‘passive holding’ or non-use of a domain name support a finding of bad faith?”

From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put”.

In the present case the Panel adopts this approach and notes in particular the Respondent's failure to provide any evidence of actual or contemplated good-faith use and the Respondent's use of false contact details. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#); *Westdev Limited v. Private Data*, WIPO Case No. [D2007-1903](#); *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#); *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#); *Advance Magazine Publishers Inc. and Les Publications Condé Nast S.A. v. ChinaVogue.com*, WIPO Case No. [D2005-0615](#).

The Panel also accepts the Complainant's evidence that the Disputed Domain Name has active MX (mail exchange) records. Those active MX records indicate a possible use for email, which evidences a likelihood of additional bad-faith use of the Disputed Domain Name to engage in fraudulent email or phishing communications. See, *e.g.*, *Tetra Laval Holdings & Finance S.A. v. Himali Hewage*, WIPO Case No. [D2020-0472](#) (concluding that evidence of active MX records indicated that the disputed domain name may be used for fraudulent email communications); *Ares Management LLC v. juandaohanjing (上海□□□□□有限公司)*, WIPO Case No. [D2020-3254](#) (finding the respondent used the disputed domain name in bad faith based on evidence of active “MX records for the disputed domain name” which “indicate that the Respondent has connected the disputed domain name to email servers, which creates a grave risk that the Respondent may be using the disputed domain name for misrepresentations and/or phishing and spamming activities”).)

The Panel also notes that the Respondent has not filed a Response and hence has not availed himself of the opportunity to present any case of good faith that he might have. The Panel infers that none exists.

Accordingly, and applying the principles in the above noted UDRP decisions the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith. Accordingly the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <versace.club> be transferred to the Complainant.

Nick J. Gardner

Nick J. Gardner

Sole Panelist

Date: September 29, 2022