

ADMINISTRATIVE PANEL DECISION

Mario Valentino S.p.A. v. Yu Guo
Case No. D2022-3160

1. The Parties

The Complainant is Mario Valentino S.p.A., Italy, represented by Società Italiana Brevetti S.p.A., Italy.

The Respondent is Yu Guo, China.

2. The Domain Name and Registrar

The disputed domain name <valentinobags-it.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 26, 2022. On August 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 30, 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 September 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 26, 2022.

The Center appointed Evan D. Brown as the sole panelist in this matter on September 30, 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 identifies itself as “a well-known company which is internationally recognized for its production of footwear, leatherware (luggage, bags, wallets, etc.) and clothing accessories”. It owns the trademark VALENTINO, which it has registered in various jurisdictions including the European Union (Reg. No. 96669, registered on August 11, 1999). According to the Whois records, the disputed domain name was registered on June 16, 2022. The Respondent has used the disputed domain name to resolve to a page on which the trademark of a competitor of the Complainant is displayed along with one of that competitor’s products, along with pictures of the Complainant’s products.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant’s trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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. The Panel finds that all three of these elements have been met in this case.

A. Identical or Confusingly Similar

This first element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the VALENTINO mark by providing evidence of its trademark registrations.

It is standard practice when comparing a disputed domain name to a complainant’s trademarks, to not take the generic Top-Level Domain (“gTLD”) into account. See [WIPO Overview 3.0](#) at section 1.11.1 (“The applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”).

The disputed domain name incorporates the VALENTINO mark in its entirety with the word “bags” and the letters “it”, which do not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s VALENTINO mark. See [WIPO Overview 3.0](#), section 1.8. The VALENTINO mark remains sufficiently recognizable for a showing of confusing similarity under the Policy.

The Complainant has satisfied this first UDRP element.

B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainant asserts, among other things, that: the Complainant has neither authorized, nor somehow given its consent to the Respondent to register and use the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services. Instead, according to the Complainant, the Respondent is employing the disputed domain name to induce Internet users to believe they are connected to the Complainant’s website or to the website of one of the Complainant’s competitors.

The Panel finds that the Complainant has made the required *prima facie* showing. The Respondent has not presented evidence to overcome this *prima facie* showing. And nothing in the record otherwise tilts the balance in the Respondent’s favor. Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

Furthermore, the nature of the disputed domain name, incorporating the Complainant’s widely known trademark and the term “bags” carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. *Columbia Insurance Company v. Name Redacted*, WIPO Case No. [D2022-0528](#); [WIPO Overview 3.0](#), section 2.5.1.

C. Registered and Used in Bad Faith

The Policy requires a complainant to establish that the domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent’s bad faith use and registration. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent “[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent’s] web site or other on-line location, by creating a likelihood of confusion with complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [respondent’s] web site or location or a product or service on [the respondent’s] web site or location”.

Because the Complainant’s marks are well-known, it is implausible to believe that the Respondent was not aware of those marks when it registered the disputed domain name. In the circumstances of this case, such a showing is sufficient to establish bad faith registration of the disputed domain name. Bad faith use is clear from the Respondent’s activities of using the disputed domain name to resolve to a website showing the marks and the product of one of the Complainant’s competitors, along with pictures of the Complainant’s products.

For these reasons, the Panel finds that the Complainant has successfully met this third UDRP element.

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 <valentinobags-it.com> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: October 14, 2022