

ADMINISTRATIVE PANEL DECISION

Brioni S.p.A. v. Xiaohong Hu
Case No. D2022-3351

1. The Parties

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

Respondent is Xiaohong Hu, China.

2. The Domain Name and Registrar

The disputed domain name <brionioutlet.com> (the “Domain Name”) 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 September 8, 2022. On September 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 12, 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.

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 of the Complaint, and the proceedings commenced on September 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 9, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 11, 2022.

The Center appointed Dinant T. L. Oosterbaan as the sole panelist in this matter on October 24, 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

According to the information provided Complainant was founded in 1945, and has since become a men's fashion luxury brand selling men's suits, leisure wear, leather goods, shoes, eyewear and fragrances. Complainant's products are sold via 50 boutiques in Europe, United States of America, Asia and the Middle East as well as via its online retail store at "www.brioni.com".

According to the evidence submitted Complainant owns numerous word and figurative trademarks for BRIONI, including International Trademark No. 1009840, registration date June 4, 2009, also applicable in China, and European Union Trademark, No. 000096511, registration date April 2, 1998.

The Domain Name was registered on January 20, 2022.

The Domain Name resolves to a website which operates an online shop that sells counterfeit products and uses similar content copied from Complainant's retail website, including wording, images and photographs.

The trademark registrations of Complainant were issued prior to the registration of the Domain Name.

5. Parties' Contentions

A. Complainant

Complainant submits that the Domain Name is confusingly similar to its BRIONI trademark. According to Complainant, the Domain Name contains the whole of the BRIONI mark. The addition of the non-distinctive term "outlet" in the Domain Name does not affect the confusing similarity because the term lacks significance as a source identifier.

According to Complainant, Respondent has no rights or legitimate interests in the Domain Name. Complainant submits that Respondent has used the Domain Name to redirect users to a website displaying the BRIONI trademarks and images taken from Complainant's website, where purported BRIONI products are advertised and offered for sale at discounted prices; no disclaimer is provided as to the lack of affiliation between Respondent's website and Complainant. Respondent's use of the Domain Name is apt to confuse and mislead Internet users into believing that the website is operated by Complainant or by an affiliated entity with Complainant's consent. Furthermore, Respondent in this case is using the Domain Name to advertise and offer for sale *prima facie* counterfeit BRIONI products, in view of the very low prices at which the purported goods are offered by Respondent.

Complainant also submits that the lack of complete and reliable information about the entity operating Respondent's website (as only an address located in the United States is provided, without disclosing the name of the website operator, and the fact that the "Terms and Conditions" sections are clearly made of incomplete templates taken from other websites and include discordant information, such as "The site of the sale of goods are suitable for the law of France"), support the conclusion that Respondent might have indeed engaged in the sale of counterfeit goods and willfully indicated inaccurate and incomplete contact details to avoid being identified and prosecuted for its illegal conduct. Such conduct clearly demonstrates that Respondent did not intend to use the Domain Name in connection with any legitimate purpose; indeed, Respondent's use cannot be considered a *bona fide* offering of goods or services or a legitimate non-commercial or fair use without intent for commercial gain.

Finally, Complainant asserts that Respondent is not a licensee, authorized agent of Complainant or in any other way authorized to use Complainant's trademark. Specifically, Respondent is not an authorized reseller of Complainant and has not been authorized to register and use the Domain Name. In addition Respondent is not commonly known by the Domain Name.

Complainant submits that Respondent registered and is using the Domain Name in bad faith. Given the fact that the BRIONI trademark is well-known Respondent could not have been unaware of its existence when it registered the Domain Name. Indeed, the fact that purported BRIONI products were offered for sale and Complainant's trademarks and official images have been published on the website to which the Domain Name resolves, indicates that Respondent was fully aware of Complainant and its trademarks.

According to Complainant the use of the Domain Name in connection with Respondent's commercial website displaying Complainant's trademarks and images taken from Complainant's website and offering for sale *prima facie* counterfeit BRIONI branded products, clearly indicates that Respondent's purpose in registering and using the Domain Name was to intentionally attempt to attract Internet users seeking Complainant's branded products to its own website for commercial gain, by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website and the goods offered and promoted on said website, according to paragraph 4(b)(iv) of the Policy.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint 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".

Paragraph 4(a) of the Policy requires that the complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (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 will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, Complainant must first of all establish rights in a trademark or service mark and secondly that the Domain Name is identical or confusingly similar to that trademark or service mark.

Complainant has established that it is the owner of several trademark registrations for BRIONI. The Domain Name incorporates the trademark BRIONI in its entirety, with the addition of the generic term "outlet". Many UDRP panels have found that a disputed domain name is confusingly similar where the relevant trademark is recognizable within the disputed domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The generic Top-Level Domain ("gTLD") ".com" is disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

The Panel finds that Complainant has proven that the Domain Name is confusingly similar to Complainant's trademarks under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In the opinion of the Panel, Complainant has made a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name. Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks or to register the Domain Name incorporating its trademarks. Respondent is not making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert Internet users or to tarnish the trademarks of Complainant.

Based on the undisputed submission and evidence provided by Complainant, the Domain Name resolves to a website which operates an online shop that sells counterfeit goods and that uses identical content taken from Complainant's website, including wholesale copying of photographs and other content. The Panel does not consider such obviously illegal use and the lack of complete and reliable information about the entity operating Respondent's website a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the Domain Name. Respondent is also not commonly known by the Domain Name nor has it acquired any trademark or service mark rights.

No Response to the Complaint was filed and Respondent has not rebutted Complainant's *prima facie* case.

Under these circumstances, the Panel finds that Respondent has no rights or legitimate interests in the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of a domain name in bad faith in the event Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service offered on Respondent's website or location.

The Panel finds that the Domain Name has been registered and is being used in bad faith. Noting the status of the well-known BRIONI marks and the overall circumstances of this case, the Panel finds it more likely than not that Respondent knew or should have known Complainant's BRIONI mark.

The Panel notes that the Domain Name resolves to a website which incorporates Complainant's trademark in its entirety, which sells counterfeit products and illegally copies the photographs and other content of Complainant's website, which indicates, in the circumstances of this case, that Respondent registered and used the Domain Name with the intention to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) 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, <brionioutlet.com>, be transferred to Complainant.

/Dinant T. L. Oosterbaan/

Dinant T. L. Oosterbaan

Sole Panelist

Date: November 7, 2022