

ADMINISTRATIVE PANEL DECISION

Aquazzura Italia S.r.l. v. 玉梅蒋 (Yumei JIANG)
Case No. D2022-3741

1. The Parties

The Complainant is Aquazzura Italia S.r.l., Italy, represented by Scarpellini Naj-Oleari & Partners, Italy.

The Respondent is 玉梅蒋 (Yumei JIANG), China.

2. The Domain Name and Registrar

The disputed domain name <aquazzurashop.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 October 6, 2022. On October 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 10, 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 October 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 10, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on November 22, 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 company, which manufactures, distributes and sells luxury apparels and accessories.

The Complainant's collections are available at over 300 top retailers in 58 countries, at flagship boutiques in Florence, London, New York, Miami, Doha, Dubai, Milan, San Paolo and Capri, and at its website "www.aquazzura.com".

The Complainant is owner of the Italian Trademark Registration No. 0001557648 made up of the word elements AQUAZZURA FIRENZE and the design element depicting a stylized pineapple, registered since September 17, 2013 for clothing, shoes and hats of class 25 of the Nice Agreement Concerning the International Classification of Good and Services for the Purpose of the Registration of Marks.

The disputed domain name was registered on December 20, 2021, and has been linked to a website offering for sale allegedly counterfeit Aquazzura branded goods.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name <aquazzurashop.com>, which fully incorporates the AQUAZZURA word element of its trademark is confusingly similar to it, since the Respondent's addition of the term "shop" to the AQUAZZURA FIRENZE word element of the trademark does not sufficiently distinguish the disputed domain name from the trademark.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii) or (iii) of the Policy.

The Complainant claims that the Respondent is operating a website at the disputed domain name offering for sale counterfeit Aquazzura goods, which is evidence of bad faith registration and use of the disputed domain name.

The Complainant requests that the disputed domain name <aquazzurashop.com> be transferred from the Respondent to the Complainant.

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 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

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name are identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a nationally or regionally registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced proper evidence of having registered rights in the AQUAZZURA FIRENZE figurative trademark, and for the purpose of this proceeding, the Panel establishes that the Italian Trademark Registration No. 0001557648 satisfy the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assessed whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the [WIPO Overview 3.0](#), the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

According to section 1.10 of the [WIPO Overview 3.0](#), trademark registrations with design elements *prima facie* satisfy the requirement that the complainant show "rights in a mark" for further assessment as to the confusing similarity.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Complainant's trademark is comprised of the word elements AQUAZZURA FIRENZE and the design element depicting a stylized pineapple. To the extent that design elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing confusing similarity under the first element (see section 1.10 of the [WIPO Overview 3.0](#)).

In the Panel's view, it's the word elements that stand out in the Complainant's trademark, particularly the distinctive element AQUAZZURA, which is evidently recognizable with the disputed domain name. The Respondent's addition of the term "shop" in the disputed domain name does not prevent a finding of confusing similarity with the Complainant's trademark.

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

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established rights in the AQUAZZURA FIRENZE figurative trademark.

The Complainant has never authorized the Respondent to use its trademark in any way, and its prior rights in the trademark precede the date of registration of the disputed domain name.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent.

As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with the relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Respondent defaulted and failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant's *prima facie* case.

The Respondent is using the disputed domain name to promote a web shop purporting to sell the Complainant's products, which the Complainant identifies as counterfeit goods. Such use of the disputed domain name is fraudulent, illegal, and can never create any rights or legitimate interests in the disputed domain name (see section 2.13.1 of the [WIPO Overview 3.0](#)).

While panels are generally not prepared to accept unsupported allegations of counterfeiting - even if the respondent defaults - the Panel notes that irrespective of whether the products sold on the website to which the disputed domain name resolves are genuine or not, the Respondent's website still does not qualify as fair use (see sections 2.13.2 and 2.8.1 of the [WIPO Overview 3.0](#)). In this instance, the disputed domain name fails under the Oki Data criteria for its failure to include any disclaimer as to its relation to the Complainant, further exacerbating the risk of implied affiliation caused by replication of the trademark in the construction of the disputed domain name (see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and section 2.5.1 of the [WIPO Overview 3.0](#)).

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

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (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 online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The distinctive word element AQUAZZURA of the Complainant's trademark, which the disputed domain name incorporates entirely, has no dictionary meaning; it is a term invented by and unique to the Complainant and therefore highly distinctive for the corresponding goods.

The websites to which the disputed domain name points prominently feature the Complainant's trademark, and its product images. In the Panel's opinion, this demonstrates that the Respondent knew of the Complainant's and its business and chose to register and use the disputed domain name to target the Complainant and its trademark.

As regards the Complainant's claim of the Respondent's counterfeiting, it is the Complainant, the owner of the corresponding trademark that is in the best situation to competently review and make determination whether the goods at issue are genuine or counterfeit.

Although the Complainant did not submit direct evidence in favor of its allegations, the Panel finds that the following facts and circumstantial evidence are sufficient to support the Complainant's credible claim of the Respondent's illegal activity and draw an inference of counterfeiting on the part of the Respondent:

- the Respondent is not affiliated with the Complainant and has never been authorized to make use of the Complainant's trademark in any way;
- there is no information on the identity of the business behind the website at the disputed domain name and no information whatsoever that could suggest or confirm the business' authenticity;
- the Complainant directly accused the Respondent of counterfeiting and while it is reasonable to expect that a legitimate business would evidently argue and defend against such serious allegations, the Respondent decided not to rebut or reject them, which is hardly a conduct of a legitimate reseller selling authentic goods to consumers.

Use of the disputed domain name to promote the sale of counterfeit goods is manifestly considered evidence of bad faith (see section 3.1.3 of the [WIPO Overview 3.0](#)).

Finally, even if the products sold on the website to which the inherently misleading disputed domain name resolves are genuine products from the Complainant, noting the Respondent is evidently holding itself as the

Complainant, which is false, the Panel finds that the Respondent is intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website at the disputed domain name (see paragraph 4(b)(iv) of the Policy).

Accordingly, the Panel finds 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 <aquazzurashop.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: December 8, 2022