

ADMINISTRATIVE PANEL DECISION

Prada S.A. v. Client Care, Web Commerce Communications Limited Case No. D2023-4002

1. The Parties

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

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <prada-canada.com>, <pradachile.com>, <prada-danmark.com>, <pradagreece.com>, <prada-ireland.com>, <pradamalaysia.com>, <pradanederland.com>, <pradanz.com>, <pradaoutletitalia.com>, <pradaoutletscanada.com>, <prada-philippines.com>, <pradaportugal.com>, <pradasaudi Arabia.com>, <pradasuomi.com>, <pradaturkey.com>, <prada-uae.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) in respect of the domain names <prada-canada.com>, <pradachile.com>, <prada-danmark.com>, <prada-ireland.com>, <pradamalaysia.com>, <pradanederland.com>, <pradanz.com>, <pradaoutletitalia.com>, <pradaoutletscanada.com>, <prada-philippines.com>, <pradaportugal.com>, <pradasaudi Arabia.com>, <pradasuomi.com>, <pradaturkey.com>, <prada-uae.com> on September 25, 2023. On September 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 27, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Not Disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 2, 2023, 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 October 2, 2023. On October 6, 2023, the Complainant filed an amended Complaint in which it added the disputed domain name <pradagreece.com>.

On October 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <pradagreece.com>. On October 10, 2023, the Registrar transmitted by email to the Center its verification response, confirming that the Respondent is the registrant and its contact details.

The Center verified that the Complaint together with the amendment to the Complaint and amended 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 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 2, 2023.

The Center appointed Ian Lowe as the sole panelist in this matter on November 23, 2023. 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 a Luxembourg company, a world-renowned manufacturer of a wide range of luxury goods, including clothing, footwear, and accessories. The PRADA brand was founded in 1913 when Mario Prada opened a luxury store in Milan selling products including leather handbags, travelling trunks, leather accessories and beauty cases, and luxury accessories. The Complainant now operates in 70 countries with approximately 14,000 employees.

The Complainant is the proprietor of a substantial number of registered trademarks around the world, including Italy trademark number 362017000069322 PRADA registered on July 8, 1978, International trademark number 650695 stylised word PRADA registered on December 15, 1995 designating some 40 countries, and Malaysia trademark number 97006324 stylised word PRADA registered on May 14, 1997 (together the "Mark").

The Complainant is also the owner of over 260 domain names comprising PRADA, including <prada.com> used by the Complainant to promote its products.

The disputed domain names were variously registered between March 24, 2022 and August 11, 2023:

March 24, 2022

<prada-danmark.com>

May 12, 2023

<pradaturkey.com>

<pradagreece.com>

<pradaportugal.com>

<pradaoutletscanada.com>

May 15, 2023

<pradachile.com>

<pradasuomi.com>

<pradanz.com>

<pradamalaysia.com>

<prada-ireland.com>

<pradanederland.com>

<prada-philippines.com>

<prada-uae.com>

June 13, 2023

<pradaoutletitalia.com>

June 25, 2023
<prada-canada.com>

August 11, 2023
<pradasaudiarabia.com>

The evidence filed by the Complainant shows that at the time of filing the Complaint all the disputed domain names resolved to websites at the disputed domain name in question, with the exception of the disputed domain name <prada-canada.com> which redirected to a website at “www.pradaoutletscanada.com” (together the “Respondent Websites”). All the Respondent Websites comprised web pages featuring the Mark and offering for sale a range of what purported to be PRADA branded clothing, footwear, and accessories. The Respondent Websites displayed a large number of photographs taken from the Complainant’s advertising campaigns and offered the products for sale at substantially discounted prices.

The Respondent Websites are either in the English language or the language of the country indicated by the country included in the relevant disputed domain name and offer the goods for sale in the local currency.

The majority of the disputed domain names continue to resolve to a website as evidenced by the Complainant, but <prada-danmark.com> no longer resolves to an active website, and access to websites at the following disputed domain names was blocked by the Panel’s anti-virus software with a warning that the websites in question were infected with a virus:

<pradaoutletscanada.com>
<prada-philippines.com>
<prada-uae.com>
<pradasaudiarabia.com>

Access to the website at <pradaportugal.com> is blocked to the Panel with a warning that the website is a phishing website. The disputed domain name <prada-canada.com> redirects to the website at “www.pradaoutletscanada.com”.

No response was received from the Respondent to cease and desist letters sent by the Complainant’s representative.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to its PRADA trademark, that the Respondent has no rights or legitimate interests in respect of the disputed domain names, and that the Respondent registered and is using the disputed domain names in bad faith within the meaning of the Policy.

B. Respondent

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

6. Discussion and Findings

For this Complaint to succeed in relation to the disputed domain names the Complainant must prove that:

(i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available evidence, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

All the disputed domain names comprise the Mark followed by the name of a country or (in the case of NZ and UAE) a two- and three-letter recognisable abbreviation of a country name. Five of the disputed domain names also include a hyphen, and two include the term "outlet" or "outlets". The Panel finds that the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Accordingly, the Panel finds that the first element required under the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. Accordingly, 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 relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The Respondent has not used the disputed domain names for a *bona fide* offering of goods or services, but rather for websites purporting to be operated by the Complainant and offering for sale what purport to be the Complainant's branded products at very substantially discounted prices, in circumstances where many panels have found an inference that the products in question may not be the genuine products of the complainant. In the Panel's view, the impersonation of a brand owner in this manner cannot confer rights or legitimate interests on the Respondent. See also [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds that the second element of the Policy has been established.

C. Registered and Used in Bad Faith

In light of the use by the Respondent of the Mark in the disputed domain names, and the nature of the Respondent's Websites featuring the Mark and offering what purport to be the Complainant's PRADA branded products, the Panel is in no doubt that the Respondent had the Complainant and its rights in the Mark in mind when it registered the disputed domain names.

The Panel considers that the Respondent has registered and used the disputed domain names to deceive Internet users into believing that the disputed domain names are operated or authorized by the Complainant, and to attract Internet users by creating a likelihood of confusion with the Mark, no doubt for commercial gain. The Panel further considers that the Respondent's Websites impersonating the Complainant cannot amount to fair use of the disputed domain names. The Panel further finds on balance that it may be inferred from the circumstances and from the very heavily discounted prices at which the PRADA branded products have been offered on the Respondent's Websites, that the goods in question are not the genuine products of the Complainant. Such activity also constitutes bad faith. In addition, the current non-use of one of the disputed domain names does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

It follows that, based on the available evidence and absent any explanation from the Respondent, the Panel finds that the Complainant has established the third element 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 disputed domain names <prada-canada.com>, <pradachile.com>, <prada-danmark.com>, <pradagreece.com>, <prada-ireland.com>, <pradamalaysia.com>, <pradanederland.com>, <pradanz.com>, <pradaoutletitalia.com>, <pradaoutletscanada.com>, <prada-philippines.com>, <pradaportugal.com>, <pradasaudiarabia.com>, <pradasuomi.com>, <pradaturkey.com>, <prada-uae.com> be transferred to the Complainant.

/Ian Lowe/

Ian Lowe

Sole Panelist

Date: December 6, 2023