

ADMINISTRATIVE PANEL DECISION

FENDI S.r.l. v. 石佳飞 (jia fei shi)

Case No. D2023-4034

1. The Parties

The Complainant is FENDI S.r.l., Italy, represented by Dreyfus & associés, France.

The Respondent is 石佳飞 (jia fei shi), China.

2. The Domain Name and Registrar

The disputed domain name <fendi-beauty.com> is registered with Cloud Yuqu LLC (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on September 27, 2023. On September 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 2, 2023, 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 (Not disclosed, REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 3, 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 amended Complaint in English on October 5, 2023.

On October 3, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On October 5, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

The Center verified that the Complaint together with the 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 in Chinese and English of the Complaint, and the proceedings commenced on October 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 5, 2023. The Respondent did not submit

any response. Accordingly, the Center notified the Respondent's default on November 9, 2023.

The Center appointed Karen Fong as the sole panelist in this matter on November 27, 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 an Italian luxury fashion house specializing, *inter alia*, in high fashion clothing, accessories, and furniture. The Complainant is part of the LVMH Group which is the owner of numerous well-known luxury brands such as Bulgari, Moët & Chandon, Kenzo, Céline, Marc Jacobs, Louis Vuitton, Loro Piana, Christian Dior, Acqua di Parma and several others. The Fendi House was originally opened in 1925 by Adele and Edoardo Fendi as a fur and leather shop in Via del Plebiscito, Rome. With the appointment of the renowned Karl Lagerfeld as designer of the House, Fendi acquired the status of being an iconic brand, well known all over the world. The trade mark FENDI is ranked among the 10 Hottest Fashion Brands in the world.

The Complainant's primary website at <fendi.com> was registered on December 26, 1995.

The Complainant has trade mark registrations for FENDI all over the world including the following:

- International Trade Mark No. 1250010 designating, among others, China where the Respondent appears to be based, for FENDI registered on February 26, 2015; and
- China Trade Mark Registration No. 25133501A for FENDI registered on September 21, 2018

(together, individually and collectively referred to as "the Trade Mark").

The Respondent appears to be based in China. The disputed domain name was registered on March 17, 2021. The disputed domain name was connected to a website which redirects to a website in Chinese displaying multiple links to job advertisements and providing human resources services. The website appears to be no longer active. The disputed domain name is also set up with an email server.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the disputed domain name, and that the disputed domain name was registered and is being used in bad faith. The Complainant requests transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

A. Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for the following main reasons:

- The disputed domain name is comprised of Latin characters which suggests that the Respondent has knowledge of languages other than Chinese;
- The Complainant is based in France and has no knowledge of the Chinese language;
- There have been other UDRP decisions in relation to the Registrar where the language of proceeding has been English;
- The Complainant having to translate the Complaint into Chinese would unfairly disadvantage and burden the Complainant in terms of costs and delay the proceeding and adjudication of this matter.

The Respondent has not challenged the Complainant's language request and in fact has failed to file a response in either English or Chinese.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

B. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's Trade Mark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

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

The Panel finds the entirety of the Trade Mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Trade Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of the other term here, "beauty" after the Trade Mark and the hyphen symbol may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the Trade Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

C. 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.

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 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 name such as those enumerated in the Policy or otherwise.

Moreover, the nature of the disputed domain name is inherently misleading as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

D. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent must have been aware of the Trade Mark when the Respondent registered the disputed domain name given the Trade Mark was registered prior to registration of the disputed domain name and the fame and reputation of the Trade Mark which forms the dominant element in the disputed domain name. It is therefore implausible that the Respondent was unaware of the Complainant when the Respondent registered the disputed domain name.

In the [WIPO Overview 3.0](#), section 3.2.2 states as follows:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

The fact that there is a clear absence of rights or legitimate interests coupled with the Respondent’s choice of the disputed domain name without any explanation is also a significant factor to consider (as stated in [WIPO Overview 3.0](#), section 3.2.1). The disputed domain name falls into the category stated above and the Panel finds that registration is in bad faith.

The Panel also finds that the actual use of the inherently misleading disputed domain name is in bad faith. The website was clearly set up for the commercial benefit of the Respondent. It is highly likely that Internet users when typing the disputed domain name into their browser, or finding them through a search engine would have been looking for a site operated by the Complainant rather than the Respondent. The disputed domain name is likely to confuse Internet users trying to find the Complainant's website. Such confusion may inevitably result due to the fact that the disputed domain name contains the Complainant's distinctive Trade Mark as the dominant part of the disputed domain name.

The Respondent employs the reputation of the Trade Mark to mislead users into visiting the disputed domain name instead of the Complainant's. From the above, the Panel concludes that the Respondent intentionally attempted to attract for commercial gain, by misleading Internet users into believing that the Respondent's website is that of or authorised or endorsed by the Complainant, and diverting the Internet users to the third party websites.

The Respondent has also established an email server under the disputed domain name. In the absence of any argument to the contrary, this could legitimately be interpreted to be for illegitimate goals, such as the establishing of email phishing schemes. The current non-use of the disputed domain name does not prevent a finding of bad faith under the passive holding doctrine, and such change in use is in fact a further indicator of the Respondent's bad faith.

In the circumstances, the Panel therefore concludes that the disputed domain name was registered and is being used in bad faith.

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 <fendi-beauty.com> be transferred to the Complainant.

/Karen Fong/

Karen Fong

Sole Panelist

Date: December 18, 2023