

## **ADMINISTRATIVE PANEL DECISION**

FENDI S.r.l. v. Sierra Hill

Case No. D2023-4155

### **1. The Parties**

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

Respondent is Sierra Hill, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <fendybeauty.com> (hereinafter, “the Domain Name”) is registered with Wix.com LTD. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 3, 2023. On October 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. Later, on October 12, 2023, the Registrar transmitted by email to the Centers its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Registration Private, Domains by Proxy, LTD) and contact information in the Complaint. On the same day, the Center sent an email communication to Complainant, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on October 16, 2023.

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 October 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 9, 2023.

The Center appointed Enrique Bardales Mendoza as the sole panelist in this matter on November 16, 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**

Complainant is an Italian luxury fashion house specialized, *inter alia*, in high fashion clothing, accessories, and furniture, and is one of the biggest brand around the world. In addition, Complainant uses the following website: “www.fendi.com”.

Complainant is the owner of numerous FENDI trademarks, including:

- International trademark FENDI registered under registration no. 1250010 on February 26, 2015, for goods in international class 9. Notably, in the United States of America.
- International trademark FENDI registered under registration no. 906325 on September 18, 2006, for goods and services in international classes 3, 9, 14, 18, 20, 21, 24, 25, 27 and 35.

Complainant is also the owner of domain name incorporating the FENDI trademark, such as <fendi.com> registered on December 26, 1995.

Finally, the Domain Name was registered on September 19, 2022, and redirects to an inactive website.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

#### **6. Discuss and Findings**

In an UDRP procedure, according to paragraph 4(a) of the Policy, Complainant must accredit the following elements:

- (i) The Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no right or legitimate interests in respect of the Domain Name; and
- (iii) The Domain Name has been registered and is being used in bad faith.

##### **A. Identical or Confusingly Similar**

First of all, Complainant has demonstrated rights through registration and use of the FENDI trademarks.

The term “fendi” in the Domain Name is identical to Complainant’s trademark FENDI. The addition of the term “beauty” within the Domain Name does not prevent a finding of confusing similarity under the first element. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), sections 1.7 and 1.8.

Consequently, the Panel finds that the Domain Name is confusingly similar to the FENDI trademark of Complainant since it incorporates said trademark entirely, and so the requirement established in paragraph 4(a)(i) from Policy has been satisfied.

### **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In the present procedure, the Panel concludes that Respondent does not have any right or legitimate interest with respect to the Domain Name for the following reasons:

- (i) First of all, Respondent has not submitted any response and has not claimed any rights or legitimate interests with respect to the Domain Name. As per the Complaint, Respondent was not authorized to register the Domain Name.
- (ii) Secondly, Respondent did not demonstrate, prior to the notice of the dispute, any use of the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.
- (iii) Thirdly, the Domain Name constitutes a total transcription of Complainant’s trademark together with the term “beauty” (related to Complainant’s business field), which reflects Respondent’s intent to create a direct inference with Complainant.
- (iv) There is no evidence on record giving rise to any rights or legitimate interests in the Domain Name on the part of Respondent within the meaning of paragraphs 4(c)(ii) and 4(c)(iii) of the Policy.

Consequently, the requirement established in paragraph 4(a) (ii) from Policy has been satisfied.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy indicates circumstances that, without limitation, are deemed evidence of the registration and use of the Domain Name in bad faith:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or

- (ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith for the following reasons:

- (i) FENDI trademark had been widely used and registered by Complainant before the Domain Name registration.
- (ii) Respondent had sufficient tools to verify that Complainant is the owner of the FENDI trademarks. For instance, Respondent could have used a search engine for this purpose.
- (iii) Respondent has not provided any good faith explanation since it has not responded to Complainant's contentions. Plus, the lack of response can be taken as an inference of bad faith.
- (iv) Complainant and its trademarks may suffer bad reputation because Internet users are likely to consider the Domain Name as in some way endorse by or connected with Complainant given the Domain Name's composition, as mentioned above.
- (v) The Domain Name is passively held.

Consequently, the requirement established in paragraph 4(a)(iii) from Policy has been 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 Domain Name <fendibeauty.com> be transferred to Complainant.

*/Enrique Bardales Mendoza/*

**Enrique Bardales Mendoza**

Sole Panelist

Date: December 1, 2023