

## **ADMINISTRATIVE PANEL DECISION**

VALENTINO S.p.A. v. Abby Buckley

Case No. D2024-2103

### **1. The Parties**

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

The Respondent is Abby Buckley, Italy.

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

The disputed domain name <valentinowellington.com> is 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”) on May 21, 2024. On May 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 22, 2024, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 22, 2024, 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 the same day.

The Center verified that the Complaint together with the amendment to 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 May 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 17, 2024.

The Center appointed Tommaso La Scala as the sole panelist in this matter on June 19, 2024. 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 worldwide renown Italian luxury fashion company established in 1960, with around 160 stores located in over 90 countries.

The Complainant is the owner of several registered trademarks for VALENTINO, VALENTINO GARAVANI, V (device) and ROCKSTUD, including:

- European Union Trademark No. 001990407 for VALENTINO, registered on September 18, 2008, for classes 3, 9, 14, 16, 18, 19, 20, 21, 24, 25, 27, 34, and 35;
- International Trademark Registration No. 1130628 for ROCKSTUD, registered on July 31, 2012, in class 25;
- International Trademark Registration No. 969844 for VALENTINO GARAVANI, registered on July 2, 2008, and duly renewed, in classes 8, 11, 19, 20, 21, 27, 36, 42, and 43; and
- International Trademark Registration No. 1522424 for V (device), registered on December 19, 2019, in classes 3, 9, 14, 18, 25 and 35.

The Complainant also owns many domain names incorporating the mark VALENTINO, such as <valentino.com>, which resolves to the Complainant's official website at "www.valentino.com".

The disputed domain name was registered on November 24, 2023, and currently resolves to a website featuring the Complainant's trademarks V, VALENTINO, ROCKSTUD and VALENTINO GARAVANI, publishing images taken from Complainant's official advertising campaigns and offering for sale purported VALENTINO products at discounted prices.

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

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

The Complainant is the owner of several trademark registrations in different jurisdictions worldwide that consist of the VALENTINO trademark. The disputed domain name fully incorporates such trademark with the mere addition of the geographical word "wellington" and is therefore confusingly similar to the Complainant's mark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant confirms it has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the VALENTINO trademark in any manner.

The disputed domain name was registered and used in bad faith, since the attempt of impersonating the Complainant carried out by the Respondent for illegitimate purposes cannot be in good faith.

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

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

## **6. Discussion and Findings**

### **A. 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 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.

The Complainant has established rights to the VALENTINO mark, as demonstrated by its registrations and widespread continued use. The disputed domain name is confusingly similar to the Complainant's mark because it contains the entirety of the Complainant's marks with the addition of the geographical term "wellington".

Based on the available record, 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. The Panel finds the entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of 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 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. 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 (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.

The Complainant has shown that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain. On the contrary, the Respondent is trying to impersonate the Complainant.

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 name.

The Respondent did not reply to the Complainant's Cease & Desist letter, nor to the allegations included in the Complaint. 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.

The Panel also finds that the composition of the disputed domain name, with the additional geographical term "wellington", cannot constitute fair use as it effectively suggests affiliation with the Complainant.

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

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

The disputed domain name was registered well after the Complainant first started using its VALENTINO trademark and the Complainant's evidence establishes extensive use of its mark as at the date of registration of the disputed domain name. Given the confusing similarity between the latter and the Complainant's mark, it is clear that the Respondent was aware of the Complainant and its VALENTINO mark as at the date of registration of the disputed domain name and registered it in order to take unfair advantage of it.

The website to which the disputed domain name resolves is currently impersonating the Complainant's website, using without authorization the trademarks VALENTINO, VALENTINO GARAVANI, and V (device), and it seems an e-commerce commercializing suspected VALENTINO fashion items and reproducing the Complainant's website layout, colors, etc.: this is clear evidence of the Respondent's knowledge and awareness of the Complainant.

Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Panel finds that the Respondent has intentionally attempted 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 its website. This constitutes registration and use in bad faith in terms of paragraph 4(b)(iv) of the Policy.

Moreover, UDRP panels have categorically held that the use of a domain name for illegal activity (here, claimed sale of counterfeit goods and impersonation/passing off) constitutes bad faith (see [WIPO Overview 3.0](#), section 3.4). Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds the third element of the Policy has been established.

### **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 <valentinowellington.com> be transferred to the Complainant.

*/Tommaso La Scala/*

**Tommaso La Scala**

Sole Panelist

Date: July 3, 2024