

ADMINISTRATIVE PANEL DECISION

VALENTINO S.p.A. v. Lian Junping and Jack Sparrow
Case No. D2024-2321

1. The Parties

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

The Respondents are Lian Junping, China and Jack Sparrow, China.

2. The Domain Names and Registrars

The disputed domain names <valentinoonlineoutlet.com> and <valentinoonlineoutlet.net> are registered with Name.com, Inc. (the “Registrar”).

The disputed domain name <valentinostoreoutlet.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2024. On June 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 7, 2024 the Registrars 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 (Redacted For Privacy, Domain Protection Services, Inc.) and contact information in the Complaint.

The Center sent an email communication to the Complainant on June 10, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar(s), requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amendment to the Complaint on June 12, 2024.

The Center verified that the Complaint [together with the amendment to the Complaint/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 Respondents of the Complaint, and the proceedings commenced on June 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 9, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondent's default on July 15, 2024.

The Center appointed Daniel Kraus as the sole panelist in this matter on August 2, 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 an Italian luxury fashion house founded in 1960, with stores located in over 90 countries. The Complainant is the owner of registered trademarks in the mark VALENTINO, amongst which:

- International Trademark Registration No. 570593, registered on April 24, 1991, and duly renewed, in classes 3, 14, 18 and 25;
- International Trademark Registration No. 764790, registered on November 20, 2000, and duly renewed, in classes 3, 9, 14, 16, 18, 19, 20, 21, 24, 25, 27, 34 and 35;
- European Union Trademark Registration No. 001990407, filed on December 7, 2000, registered on September 18, 2008, and duly renewed, in 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.

The trademarks are used in connection with products in the fashion and leather industry, including clothes, handbags, small leather goods, luggage, shoes, jewelry, eyewear and fragrances.

The Complainant also owns domain names incorporating the mark VALENTINO, such as <valentino.com>, <valentino-outlet.com>, and <valentinooutlet.com>. The first domain name is used for its official website "www.valentino.com". The website "www.valentino.com" provides information about the Complainant's brand and products and an online store where the Complainant's branded goods are advertised and offered for sale.

The disputed domain names <valentinoonlineoutlet.com> and <valentinoonlineoutlet.net> were registered on October 12, 2023, whilst the disputed domain name <valentinostoreoutlet.com> was registered on April 25, 2024, without any authorization from Complainant.

The disputed domain name <valentinoonlineoutlet.com> was previously redirected to a website, displayed at "https://valentinoonlineoutlet.com", featuring the Complainant's trademarks VALENTINO GARAVANI, VALENTINO, and ROCKSTUD and offering for sale, at low prices, purported VALENTINO products which were expressly defined as "replica" and "fake". Moreover, no information was provided about the actual person or entity operating the website. At the day of filing of the Complaint, the disputed domain name <valentinoonlineoutlet.com> redirected, like the disputed domain name <valentinostoreoutlet.com>, to the website "www.valentinostoreoutlet.com", featuring the Complainant's trademarks mentioned above and offering for sale counterfeit VALENTINO products at low prices, in absence of any information about the website operator.

At the time of filing of the Complaint, the disputed domain name <valentinooutletonline.net> redirected to an inactive website.

The disputed domain name <valentinostoreoutlet.com> is configured with Mail eXchanger ("MX") records which means that the disputed domain name can be used to receive and send emails.

Finally, several cease and desist letters have been sent by the representative of the Complainant. All have remained unanswered.

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 names.

Notably, the Complainant claims that it has rights in the mark VALENTINO and that the disputed domain names are confusingly similar to this mark. It points out that the disputed domain names incorporate the VALENTINO mark in its entirety and argue that the disputed domain names differ from the Complainant's trademark by the mere addition of the non-distinctive elements "onlineoutlet" and "storeoutlet" which do not affect the confusing similarity. In fact, the addition of the terms "online", and "storeoutlet" are descriptive of locations where consumers can shop for VALENTINO brand-name items, including at a discount. As for the addition of the suffixes ".com" and ".net", the Complainant points out that many prior Panels found that the addition of a Top-Level Domain is merely instrumental to the use of the Internet and shall thus be disregarded in the assessment of confusing similarity.

Furthermore, the Complainant claims that the Respondents lack a right or legitimate interest in the disputed domain names; that the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name; that the Respondents are not a licensee, authorized agent of Complainant or in any other way authorized to use Complainant's trademark. Specifically, the Respondents are not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain names.

The Complainant further points out that it is not in possession of, nor aware of the existence of any evidence demonstrating that the Respondents might be commonly known by a name corresponding to the disputed domain names as an individual, business, or other organization. The Respondents have not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute. Moreover, the Complainant argues that there is no evidence that the Respondents might have used the disputed domain names in connection with a legitimate noncommercial or fair use of the disputed domain names.

The Complainant points that the disputed domain names <valentinoonlineoutlet.com> and <valentinostoreoutlet.com> have been redirected by the Respondents to websites featuring Complainant's trademarks and offering for sale purported VALENTINO products, without providing any clear and evident disclaimer as to Respondent's lack of relationship with Complainant. According to the Complainant, the Respondent's use of the disputed domain names was, and is, therefore, apt to confuse and mislead Internet users into believing that the websites are operated by the Complainant or by one of its affiliated entities with the Complainant's consent.

Furthermore, the Respondents in this case has been using the disputed domain names to advertise and offer for sale counterfeit VALENTINO products, in view of the very low prices at which the purported VALENTINO goods are offered and the terms "fake" and/or "replica" used by Respondents to describe the products offered on its websites. According to the Complainant, the lack of information about the entity actually operating the Respondent's websites supports the conclusion that the Respondents might have indeed engaged in the sale of counterfeit goods and willfully omitted to indicate its contact details on its websites to avoid being identified and prosecuted for its illegal conduct. For the Complainant, such conduct clearly demonstrates that the Respondents did not intend to use the disputed domain names in connection with any legitimate purpose.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. As to the assessment of the Respondent's bad faith at the time of registrations, the Complainant contends that in light of the extensive use of the trademark VALENTINO since as early as 1960, and the amount of advertising and sales of the Complainant's products worldwide, including online via the Complainant's website "www.valentino.com", the Respondents could not have possibly ignored the existence

of the Complainant's trademark VALENTINO when it registered the disputed domain names, with which it is confusingly similar. The Complainant also points out that the well-known character of the trademark VALENTINO has been recognized in prior UDRP decisions. Indeed, the Complainant adds, the fact that purported VALENTINO products were offered for sale on two of the websites to which the disputed domain names resolved, indicates that the Respondents were fully aware of the Complainant and its trademarks. According to the Complainant, this conduct also clearly indicates that the Respondent's purpose in registering and using the disputed domain names was to capitalize on the reputation of the Complainant's VALENTINO trademark, by attracting Internet users seeking the Complainant's branded products to its websites for commercial gain and intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its websites and the goods offered and promoted through said websites, in accordance with paragraph 4(b)(iv) of the Policy. The fact that the <valentinoonlineoutlet.net> disputed domain name redirects to an inactive website does not affect the Respondent's bad faith, as the concept of "bad faith use" includes not only positive action but also passive holding.

B. Respondents

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

6. Discussion and Findings

Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different disputed domain names registrants. The Complainant alleges that the disputed domain names registrants however have a potential commonality or that there has been a coordinated effort between the disputed domain names, making case consolidation a consideration for efficiency and fairness in the proceedings pursuant to paragraph 10(e) of the Rules.

The disputed domain names registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).

In the present case, the Complainant believes that the three disputed domain names subject to the present Complaint are under the control of the same single individual or entity that is simply using privacy protection services and fictitious names to attempt to evade or hinder the enforcement of the Complainant's intellectual property rights against it.

In support of such inference, the Complainant highlights the following circumstances, which have been also taken into consideration by prior Panels when assessing whether multiple domain names can be found under common control:

- i. The disputed domain names <valentinoonlineoutlet.com> and <valentinoonlineoutlet.net> are both registered in the name of the same shield company (Domain Protection Services, Inc.) and have been registered via the same Registrar (Name.com, Inc.). Moreover, according to the information provided by the concerned Registrar to the Center after the filing of the Complaint, both disputed domain names are registered in the name of Lian Junping, with the same contact details;
- ii. the disputed domain names <valentinoonlineoutlet.com> and <valentinoonlineoutlet.net> were registered on the same day, i.e. on October 12, 2023;
- iii. based on the information provided by the concerned Registrars to the Center after the filing of the Complaint, all the disputed domain names have been registered with the indication of the same physical address located in China. The sole difference between the address indicated for <valentinostoreoutlet.com> and the one mentioned for <valentinoonlineoutlet.com> and <valentinoonlineoutlet.net> is the presence of a letter “P” after the province of Guangdong in the postal address indicated for <valentinostoreoutlet.com>;
- iv. based on the information provided by the concerned Registrars to the Center after the filing of the Complaint, all the disputed domain names have been registered with the indication of the same phone number;
- v. the close similarity amongst the disputed domain names, incorporating the trademark VALENTINO in its entirety with the addition of the terms referred to online sale (“online”, “store” and “outlet”), as better detailed *infra*. Particularly, the disputed domain names <valentinoonlineoutlet.com> and <valentinoonlineoutlet.net> identically reproduce the expression “valentinoonlineoutlet”, whilst the disputed domain name <valentinostoreoutlet.com> is closely similar to said disputed domain names as it reproduces the terms “valentino” and “outlet” in the same position, replacing only the term “online” in the middle with the term “store”;
- vi. the disputed domain names <valentinoonlineoutlet.com> and <valentinostoreoutlet.com> have been redirected to very similar websites and, currently, are pointed to the same website;
- vii. the email address currently published on the website “valentinostoreoutlet.com” is the same as the one that was published, on January 11, 2024, on the website “www.valentinoonlineoutlet.com” (Annex 8.3 to the Complaint);
- viii. according to the information disclosed by the concerned Registrar, the registrant’s name provided for <valentinostoreoutlet.com>, i.e. Jack Sparrow, appears to be fictitious since Jack Sparrow is the name of a well-known character from the “Pirates of the Caribbean” movies;
- ix. the Respondents were involved in a prior UDRP case brought by Complainant, *VALENTINO S.p.A. v. Lian Junping and Jack Sparrow*, WIPO Case No. [D2023-4207](#), concerning the domain names <valentinooutletmall.com> and <valentinooutletsale.com>, that were found to be under common control.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain names registrants (referred to below as the “Respondent”) in a single proceeding.

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 names. [WIPO Overview 3.0](#), section 1.7. 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, namely the VALENTINO marks. [WIPO Overview 3.0](#), section 1.2.1. The Panel finds the entirety of the VALENTINO mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. While the addition of other terms here, the words “onlineoutlet” or “storeoutlet”, may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain names and the VALENTINO mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8. Therefore, 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.

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 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 Panel notes that the Respondent has concealed its identity in the registration of the disputed domain names and the disputed domain names are redirected to a website that also hides the identity of its owner, identifying itself as “Valentino Sale” or “VALENTINO Outlet”. The Panel further notes that apparently the Respondent has provided fictitious names that share no similarities with the term “valentino” in the Whois records of the disputed domain names, one being the name of a popular character of the Caribbean Pirates movies. The Panel further notes that the disputed domain names are redirected to a website that displays the VALENTINO marks and photographs or promotional material related to its products, and purportedly commercializes clothing and accessories of the VALENTINO marks at discounted prices. The Panel notes that this website reproduces the design, combination of colors, and general look and feel of the Complainant’s official websites (at “www.valentino.com” and “www.valentino.cn”). Furthermore, it includes official promotional material of the VALENTINO’s products, as well as the Complainant’s brands and logos. Additionally, the Panel finds that the inclusion of the reputed VALENTINO mark with the additional terms in the disputed domain names (“onlineoutlet” or “storeoutlet”,) create a risk of implied affiliation, as these terms refer to the Complainant’s activity and business in the retail sector. The addition of these terms to the VALENTINO mark within the disputed domain names contributes to generate the impression that the website linked to the disputed domain names is affiliated to or owned by the Complainant and correspond to one of its online stores for discounted or sale products. These circumstances cannot confer rights or legitimate interests to the Respondent under the Policy. The Panel further finds that, in a balance of probabilities, the circumstances of this case indicate that the goods commercialized in the Respondent’s websites may be counterfeits. The concealment of the Respondent’s identity in the registration of the disputed domain names and the content of the website linked to the disputed domain names, and the extremely reduced prices of the products purportedly commercialized in this site, and all other circumstances of this case point to an illegitimate origin of the goods. In this respect, panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Therefore, 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 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 finds that due to the reputation and famous character of the VALENTINO mark, its continuous international use and extensive presence online, the Respondent knew or should have known about the Complainant and its prior rights over the VALENTINO mark when it registered the disputed domain names. Any search for the term “valentino” over the Internet reveals the Complainant and its trademarks. The use of the disputed domain names further corroborates the Respondent’s bad faith, as the disputed domain names are used to redirect traffic to a website that pursues to impersonate the Complainant or one of its online stores reproducing the look and feel of its official websites. This website further includes the VALENTINO marks and copyrighted promotional material of the VALENTINO products, and purportedly offer for sale these products at highly discounted prices. The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by generating a likelihood of confusion with the Complainant and its trademarks. All circumstances of this case indicate, in a balance of probabilities, that the Respondent targeted the Complainant and its trademarks in the registration and the use of the disputed domain names, in bad faith, in an attempt to increase the traffic to a lucrative apparently illegal business in connection to the commercialization of counterfeits of the Complainant’s products. Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. The use of fictitious names and similar apparently inaccurate addresses in the registration of the disputed domain names are further evidence of the Respondent’s bad faith. The Respondent has not come forward to provide any evidence of rights or legitimate interests in the disputed domain names and has not rebutted the Complainant’s allegations of bad faith. Therefore, having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy. Furthermore, the Panel finds that the Respondent shows a pattern of abusive domain name registration, targeting the Complainant and its famous VALENTINO mark with the registration and use of the disputed domain names. Additionally, according to the evidence provided with the Complainant, the Panel has corroborated that the same apparently fictitious names are connected with other prior UDRP cases that were decided against these registrants ordering the transfer of the respective domain names to the trademark owners. [WIPO Overview 3.0](#), section 3.1.2.

Therefore, based on the available record, 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 names <valentinoonlineoutlet.com>, <valentinoonlineoutlet.net> and <valentinostoreoutlet.com> be transferred to the Complainant.

/Daniel Kraus/

Daniel Kraus

Sole Panelist

Date: August 16, 2024