

ADMINISTRATIVE PANEL DECISION

Gianni Versace S.r.l. v. Domain Privacy Service FBO Registrant / Josh Patrick, Josh Patrick
Case No. D2022-2896

1. The Parties

The Complainant is Gianni Versace S.r.l., Italy, represented by Studio Barbero, Italy.

The Respondent is Domain Privacy Service FBO Registrant, United States of America / Josh Patrick, Josh Patrick, Canada.

2. The Domain Name and Registrar

The disputed domain name <versace.host> (the “Domain Name”) is registered with Domain.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 5, 2022. On August 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same date, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 9, 2022, 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 August 10, 2022.

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 August 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 7, 2022.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on September 16, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is an international fashion company. It designs, manufactures, distributes and retails fashion and lifestyle products. The Complainant has used the trademark VERSACE in Italy for over forty years. Today, the Versace Group distributes its products through a world-wide network, including over 200 boutiques and over 1500 wholesalers worldwide.

The Complainant owns numerous trademark registrations for VERSACE, such as European Union Trade Mark Registration no. 001665439 registered on September 10, 2001, and International Trademark Registration No. 648708 registered on October 6, 1995.

The Domain Name was registered on October 7, 2021. The Domain Name used to resolve to a website displaying the wording “VERSACE HvH”, and a “Forum” section where users were requested to provide their email address. Moreover, the Complainant argues that at the time of drafting the Complaint, the Domain Name redirected to a Registrar parking page.

5. Parties’ Contentions

A. Complainant

The Complainant owns registered trademark rights over the trademark VERSACE, and argues that the Domain Name is identical to the Complainant’s trademark. The Domain Name incorporates the whole of the Complainant’s trademark without any alteration. The suffix “.host” is merely instrumental to the use in Internet and shall be disregarded for the determination of confusing similarity.

The Complainant argues that it is sufficient for the Complainant to produce *prima facie* evidence to shift the burden of production to the Respondent. The Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant’s trademark. There is no evidence to support that the Respondent is commonly known by the Domain Name. The Respondent cannot establish rights or legitimate interests in the Domain Name, as the Respondent has not made any use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services. The use is evidence of bad faith.

The Complainant submits that the Complainant’s trademark is well-known, and it is inconceivable that the Respondent was unaware of the Complainant’s trademark when the Respondent registered the Domain Name. The misappropriation of a well-known trademark is by itself indication of bad faith. Moreover, the Domain Name has redirected to a website displaying the VERSACE trademark without displaying any disclaimer of non-affiliation with the Complainant. It is therefore likely that the Respondent has registered and used the Domain Name to obtain some commercial gain, by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has established rights in its trademark VERSACE. The Domain Name is identical to the Complainant's trademark.

For the purposes of assessing confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain ("gTLD") as it is viewed as a standard registration requirement, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") section 1.11.1.

The Panel finds that the Domain Name is identical to a trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Respondent is not affiliated with nor authorized by the Complainant. There is no evidence that the Respondent is commonly known by the Domain Name. The Respondent cannot establish rights in the Domain Name, as it has not made use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering. On the contrary, the use suggests bad faith.

The Panel finds that the Complainant has made out a *prima facie* case showing that the Respondent has no rights or legitimate interests in the Domain Name, which has been un rebutted by the Respondent.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant's trademarks were registered before the registration of the Domain Name. The Complainant and its trademarks are well-known. The Domain Name is identical to the Complainant's trademark. Based on the above, and the use of the Domain Name, it is probable that the Respondent was aware of the Complainant's trademark when the Respondent registered the Domain Name.

The misappropriation of a well-known trademark as a domain name may be an indication of bad faith. The Domain Name seems to be registered to attract Internet users by misleading them into believing that the Domain Name is somehow connected to the Complainant, as it displays the wording "VERSACE HvH". Furthermore, it is important to note that the Domain Name included a "Forum" section that requested the user's email addresses. The Respondent has not provided any evidence of good faith use, and as mentioned above, the Respondent's use of the Domain Name further underlines bad faith.

The Panel finds that the Domain Name was registered and is being used in bad faith, within the meaning of the paragraph 4(a)(iii) 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 Domain Name <versace.host> be transferred to the Complainant.

/Mathias Lilleengen/

Mathias Lilleengen

Sole Panelist

Date: September 22, 2022