

ADMINISTRATIVE PANEL DECISION

VALENTINO S.p.A. v. Lian Junping and Jack Sparrow
Case No. D2023-4207

1. The Parties

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

The Respondent is Lian Junping and Jack Sparrow, China.

2. The Domain Names and Registrar

The disputed domain names <valentinooutletmall.com> and <valentinooutletsale.com> are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2023. On October 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 10, 2023, the Registrar 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 12, 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 amendment to the Complaint on October 13, 2023.

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 October 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 14, 2023.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on November 17, 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 a fashion house founded in 1960 that operates under the brands VALENTINO, V, ROCKSTUD, and VALENTINO GARAVANI. It offers a wide range of luxury products from “haute couture” and “prêt-à-porter” to an extensive accessories collection that includes bags, shoes, small leather goods, belts, eyewear, silks, and perfumes. The Complainant’s products are available internationally in over 90 countries through a net of 160 directly operated stores and 1,300 points of sale, as well as over the Internet at the Complainant’s official websites and online stores.

The Complainant holds numerous trademark registrations for its brands, including:

- International Trademark Registration No. 570593, VALENTINO, word, registered on April 24, 1991, in classes 3, 14, 18 and 25;¹
- International Trademark Registration No. 969844, VALENTINO GARAVANI, word, registered on July 2, 2008, in classes 8, 11, 19, 20, 21, 27, 36, 42, and 43;²
- International Trademark Registration No. 1522424, V, figurative, registered on December 19, 2019, in classes 3, 9, 14, 18, 25, and 35; and
- International Trademark Registration No. 1130628, ROCKSTUD, registered on July 31, 2012, in class 25.

The aforementioned trademark registrations will collectively be referred to as the “VALENTINO marks”, and, individually, as the “VALENTINO mark”, the “VALENTINO GARAVANI mark”, the “V logo”, and the “ROCKSTUD mark”, respectively.

Prior decisions under the Policy have recognized the international reputation and famous character of the VALENTINO mark.³

The Complainant further owns over 1,000 domain names corresponding to its trademarks, including <valentino.com> (registered on July 21, 1998) and <valentino.cn> (registered on March 17, 2003), which resolve to its official main online store and its official online store for China, respectively.

The disputed domain name <valentinooutletsale.com> (“First Disputed Domain Name”) was registered on January 5, 2022, and the disputed domain name <valentinooutletmall.com> (“Second Disputed Domain Name”) was registered on November 29, 2022.

At the time of drafting this decision, both disputed domain names are redirected to a website at “www.valentinoonlineoutlet.com” that displays the V logo as favicon, the VALENTINO GARAVANI mark at its heading, and other VALENTINO marks within its content. This website contains copyrighted promotional material and images from the Complainant’s products and purportedly offer for sale these products at discounted prices (less than a third of their normal prices). This website is in English language and includes no information about their owner or that of the disputed domain names, and no information about their relationship or lack of relationship with the Complainant and its trademarks. The owner of the site identifies itself as “Valentino Sale” or “Valentino Outlet”.

¹ This International Trademark Registration designates, among other jurisdictions, China.

² This International Trademark Registration designates, among other jurisdictions, China.

³ See, e.g., *Valentino S.p.A. v. hong chen, chen hong*, WIPO Case No. [D2014-2129](#); *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#); *Valentino S.p.A. v. Wu Dong*, WIPO Case No. [D2018-0641](#); and *Valentino S.p.A. v. Lijin Liu*, WIPO Case No. [D2020-0011](#).

According to the evidence provided by the Complainant, the Second Disputed Domain Name was initially redirected to a website at the First Disputed Domain Name with similar content as the website “www.valentinoonlineoutlet.com”; and, at the time of drafting the Complaint, the Second Disputed Domain Name was temporally redirected to a default webpage. The Complainant has further provided evidence of the configuration of mail exchanger records (“MX records”) in the server of both disputed domain names.

On November 24, 2022, and on February 22, 2023, the Complainant sent cease and desist communications to the Respondent through the email addresses indicated in the website at the First Disputed Domain Name and the Registrar’s abuse email address. On November 24, 2022, February 22, 2023, and on March 15, 2023, the Complainant sent various cease and desist communications and reminders to the hosting subsequent providers of the Respondent’s website, requesting the deactivation of this site. The Complainant indicates that it did not receive any response to these cease and desist communications.

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 contends that the disputed domain names are confusingly similar to the VALENTINO mark, as they contain this trademark followed by the terms “outlet”, “sale” and “mall” that do not affect the confusing similarity, and the generic Top-Level Domain (“gTLD”) (“.com”), which is merely instrumental and shall be disregarded in the assessment of confusing similarity.

The Respondent has no rights or legitimate interests in the disputed domain names, as he is not commonly known by the term “valentino” and is not authorized to use the Complainant’s trademarks. The Respondent is using the disputed domain names to offer for sale *prima facie* counterfeit VALENTINO products, in view of the very low prices at which these goods are offered. The fact that the Second Disputed Domain Name has been apparently inactive is to be considered neither as a bona fide offering of goods or services nor as a legitimate non-commercial or fair use. The disputed domain names and the Respondent’s website generate a likelihood of confusion and affiliation with the Complainant and its trademarks.

The disputed domain names were registered and are being used in bad faith. Due to the well-known character of the VALENTINO mark, it is inconceivable that the Respondent was not aware of the Complainant’s rights at the time of the registration of the disputed domain names. The use of the disputed domain names corroborates the Respondent’s bad faith. The Respondent registered and uses the disputed domain names to generate confusion and affiliation in an attempt to increase the traffic to its website in which it commercializes counterfeit products. The temporally non-use of the Second Disputed Domain Name does not affect the Respondent’s bad faith, as the concept of “bad faith use” includes not only positive action but also passive holding, and the Respondent has set up MX records for the disputed domain names, so they may be used for email communication. The Respondent uses a fictitious name and has been involved in prior cases under the Policy with the same fictitious names, which were resolved against the Respondent.⁴ The Respondent’s lack of response to the cease and desist letter is further evidence of bad faith.

B. Respondent

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

⁴ The Complainant cites *Autumnpaper Ltd v. Lian Junping*, WIPO Case No. [D2023-2167](#); *Prada S.A. v. Whois Agent, Domain Protection Services, Inc. / Jack Sparrow*, WIPO Case No. [D2021-1722](#); and *Philip Morris USA Inc. v. Jack Sparrow*, WIPO Case No. [D2016-2220](#).

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, inter alia, in paragraph 10 of the Rules.

A. Preliminary Issue: Consolidation of the Complaint against Multiple Respondents

The Complainant has requested the consolidation of the Complaint against multiple Respondents (the registrants of the disputed domain names).

The Panel considers that the circumstances of this case indicate that the disputed domain names are subject to a common control, and the consolidation is fair and equitable to the Parties. Particularly, the Panel notes, (i) the disputed domain names were registered within a short period (less than a year); and (ii) through the same Registrar; (iii) the structure and semantical concept of the terms included in the disputed domain names are very similar or equivalent; and (iv) the disputed domain names share the same content (initially the second disputed domain name was redirected to a website at the first disputed domain name, and, at the time of drafting this decision, both disputed domain names are redirected to the same website at “www.valentinoonlineoutlet.com”. The Panel also notes that the information provided in the WhoIs for the disputed domain names, according to the Registrar verification, is similar and the registrant's names revealed by the Registrar verifications are apparently fictitious. See section 4.11.2 of the [WIPO Overview 3.0](#).

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 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.

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 “outlet sale” or “outlet mall”, 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.

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 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 currently 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 reproduces the Complainant’s logo as favicon, as well as displays the VALENTINO marks and copyrighted photographs or promotional material related to its products, and purportedly commercializes clothing and accessories of the VALENTINO marks at extremely discounted prices (less than a third of their normal price).

The Panel finds that the said website does not indicate its lack of relationship with the Complainant and its trademarks. On the contrary, this site generates the impression of being affiliated with or owned by the Complainant or any official retailer of the VALENTINO marks. In this respect, 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 copyrighted material of the VALENTINO’s products, as well as the Complainant’s brands and logos, and it does not include any reference to the lack of relationship of the Parties or to the owner of the site identity.

Additionally, the Panel finds that the inclusion of the reputed VALENTINO mark with the additional terms in the disputed domain names (“outlet”, “sales”, “mall”) 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 not confer rights or legitimate interests to the Respondent under the Policy. Panels have recognized that resellers or distributors using a domain name containing the complainant’s trademark to undertake sales may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name only when certain cumulative requirements outlined in the “Ok! Data test” are met, which do not concur here. [WIPO Overview 3.0](#), section 2.8.

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.

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 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, and the Panel further finds remarkable the Respondent's lack of response to the Complaint or the prior cease and desist communications. 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.⁵ [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.

⁵ See footnote No. 4.

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, <valentinooutletmall.com> and <valentinooutletsale.com>, be transferred to the Complainant.

/Reyes Campello Estebarez/

Reyes Campello Estebarez

Sole Panelist

Date: December 1, 2023