

ADMINISTRATIVE PANEL DECISION

VALENTINO S.p.A. v. paul cai; rosykey tang; disck2356 tang; luse lee; mady james; donger chen; and anquf kiuo
Case No. D2023-4287

1. The Parties

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

The Respondents are paul cai, China; rosykey tang, China; disck2356 tang, China; luse lee, China; mady james, China; donger chen, China; anquf kiuo, United States of America.

2. The Domain Names and Registrars

The disputed domain names <billigevalentinosko.com>, <billigvalentinoreplik.com>, <cheapvalentinocanada.com>, <fakevalentinoaustralia.com>, <fakevalentino.com>, <fakevalentinosale.com>, <replicavalentinosale.com>, <replicavalentinousa.com>, <scarpevalentinosaldi.org>, <udsalgvalentinobillig.org>, <valentinobaratooutlet.com>, <valentinooutletespain.com>, <valentinooutletitalia.com>, <valentinooutletuk.org>, <valentinorebajashombre.com>, <valentinosaleoutlet.com>, <valentinotaschedamen.org>, <valentinousaonline.com>, and <vltnoutlet.com> are registered with Name.com, Inc.

The disputed domain name <economicovalentinodonna.com> is registered with GoDaddy.com, LLC.

(Name.com, Inc. and GoDaddy.com, LLC are hereinafter referred to as the “Registrar”.)

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 16, 2023. On October 17, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On October 17 and October 20, 2023, respectively, 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 and contact information in the Complaint.

The Center sent an email communication to the Complainant on October 27, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, 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. The Complainant filed an amendment to the Complaint on October 31, 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 November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 23, 2023.

The Center appointed John Swinson as the sole panelist in this matter on November 30, 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 well-known fashion brand that has traded under the mark VALENTINO for over 50 years.

The Complainant’s products are available in approximately 90 countries, including in retail stores operated by the Complainant.

The Complainant owns numerous trade marks for VALENTINO including International Registration No. 570593, registered on April 24, 1991, in classes 3, 14, 18 and 25, designating, among others, China.

The Complainant operates a website at <valentino.com>.

The disputed domain names were registered between June 6, 2022, and May 5, 2023.

The Respondent did not file a Response, so little information is known about the Respondent. (For the reasons set out below, this decision will refer to all Respondents as “the Respondent”.)

All the disputed domain names, except <replicavalentinousa.com>, divert to the “Davi” website at <daviwholesale.ru>, and some divert to a webpage on this website located at “www.daviwholesale.ru/valentino”. This website advertises and appears to sell product’s that look similar to the Complainant’s products at substantially reduced prices. This website also advertises and appears to sell other high-end fashion brands.

The disputed domain name <replicavalentinousa.com> currently diverts to a website located at <jerseyswholesale.org> that sells discount American football jerseys. At the time of filing of the Complaint, the disputed domain name <replicavalentinousa.com> resolved to a default webpage.

The Complainant sent cease and desist letters to the Respondent but did not receive any response.

Some of the parties in the present case were parties to a prior case under the Policy that also involved the Complainant, namely *Valentino, S.p.A. v. bixiang lin, donger chen, paul cai, mady james, rosykey tang, qi li, and luse lee*, WIPO Case No. [D2023-2189](#).

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 all the disputed domain names (except one) are being used to direct Internet traffic to a website that appears to sell pirated fashion products of the Complainant and the Complainant's competitors.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The *onus* of proving these elements is on the Complainant.

6.1 Preliminary Issue: Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name 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.

As regards common control, the Panel notes that nineteen of the twenty disputed domain names resolve to the same website, nineteen of the twenty disputed domain names are registered with the same Registrar, and groups of the disputed domain names are registered using the same name, email address and addresses. For example, <valentinooutletuk.org>, <cheapvalentinocanada.com>, <fakevalentinoaustralia.com> and <replicavalentinousa.com> were all registered on the same date in the name of "disk2356 tang", and according to the Registrar's records, share the same e-mail address, have the same postal address in Fujian, China, the same telephone number and the same name servers.

The disputed domain names are in a similar format in that they consist of the term “valentino” (with one using the abbreviation “vltn”) together with additional dictionary or geographical terms.

None of the Respondents have come forward to object to consolidation.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

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

The Panel will refer to all Respondents as “the Respondent” in this decision.

6.2 Substantive Issues

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 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. [WIPO Overview 3.0](#), section 1.2.1.

In respect of nineteen of the disputed domain names, the Panel finds the entirety of the mark is reproduced within each of such disputed domain names. Accordingly, each of these nineteen disputed domain names is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

In respect of the disputed domain name <vltnoutlet.com>, the Panel considers “vltno” to be an abbreviation for “Valentino”. It is well established that the content of the Respondent’s website is normally disregarded when assessing confusing similarity under the first element of the Policy. The test is to be conducted by way of a side-by-side comparison of the Complainant’s trademark and the disputed domain name. *Harry Winston Inc. and Harry Winston S.A. v. Jennifer Katherman*, WIPO Case No. [D2008-1267](#). However, in certain circumstances, it is permissible for the Panel to consider the website at the disputed domain name to gain an indication of the Respondent’s intention for the disputed domain name. See *Fenix International Limited v. Privacy services provided by Withheld for Privacy ehf / Darko Milosevic, Rocket Science Group*, WIPO Case No. [D2022-1875](#) and the cases cited in that decision. The disputed domain name <vltnoutlet.com> resolves to a website that trades off the Complainant’s reputation and includes what appears to be the Complainant’s products or, more likely, pirated products that are branded as the Complainant’s products. An Internet user visiting the website at the disputed domain name <vltnoutlet.com> would most likely understand VLTNO in the disputed domain name to refer to the Complainant’s VALENTINO trademark. The Panel finds that such use supports a finding of confusing similarity.

Accordingly, the Panel finds the Complainant’s mark is recognizable within the disputed domain name <vltnoutlet.com>. Accordingly, this disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, for example, “fake”, “australia” and “outlet”, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established in respect of each of the disputed domain names.

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 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 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.

Panels have held that the use of a domain name for illegal activity, here, claimed sale of counterfeit goods can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent uses the disputed domain names to divert Internet traffic to websites selling fashion items and apparel. One of the websites to which nineteen of the disputed domain names divert appears to sell pirated goods. This inference is supported by the extremely low prices and that some of the disputed domain names resolving to this website include the term “fake”. The other website sells football jerseys.

Panels have held that the use of a domain name for illegal activity, here, claimed sale of counterfeit good constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent’s registration and use of the nineteen of the disputed domain names that divert to the <daviwholesale.ru> website constitutes bad faith under the Policy.

Additionally, in respect of all of the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites or other on-line locations, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s websites or locations or of a product or service on the Respondent’s websites or locations. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4

Based on the available record, the Panel finds that the Complainant has established the third element 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 disputed domain names <billigevalentinosko.com>, <billigvalentinoreplik.com>, <cheapvalentinocanada.com>, <fakevalentinoaustralia.com>, <fakevalentino.com>, <fakevalentinosale.com>, <replicavalentinosale.com>, <replicavalentinousa.com>, <scarpevalentinosaldi.org>, <udsalgvalentinobillig.org>, <valentinobaratoutlet.com>, <valentinooutletespain.com>, <valentinooutletitalia.com>, <valentinooutletuk.org>, <valentinorebajashombre.com>, <valentinosaleoutlet.com>, <valentinotaschedamen.org>, <valentinousaonline.com>, <vltnoutlet.com>, and <economicovalentinodonna.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: December 12, 2023