

ADMINISTRATIVE PANEL DECISION

Premiata S.R.L. v. Amelia Zemlak, Ariana Zilliacus, 卫迎松 (Banks Michelle), Lancaster Lily, Christi Dahlgren, Vanessa Raymond
Case No. D2024-2581

1. The Parties

Complainant is Premiata S.R.L., Italy, represented by Dr. Modiano & Associati S.p.A., Italy.

Respondents are Amelia Zemlak, United States of America (“United States”), Ariana Zilliacus, United States, 卫迎松 (Banks Michelle), China and United States, Lancaster Lily, United States, Christi Dahlgren, United States, and Vanessa Raymond, United States.

2. The Domain Names and Registrars

The disputed domain name <it-premiata.com> is registered with West263 International Limited; the disputed domain names <premiatashoescanada.com>, <premiatashoesphilippines.com>, and <premiatausasale.com> are registered with Key-Systems GmbH; the disputed domain name <premiata-singapore.com> is registered with Dynadot Inc; and the disputed domain name <premiataweb.com> is registered with Sav.com, LLC (collectively the “Registrars”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 25, 2024. On June 25, 2024, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On June 25 and 26, 2024, the Registrars transmitted by email to the Center the verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for Privacy / Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to Complainant on June 27, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar(s), requesting 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. Complainant filed an amended Complaint in English on June 28, 2024.

On June 27, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name <it-premiata.com> is Chinese. On June 28, 2024, Complainant requested English to be the language of the proceeding. Respondent did not submit any

comment on Complainant's submission.

The Center verified that the Complaint together with the 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 Respondent in Chinese and English of the Complaint, and the proceedings commenced on July 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 23, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on July 24, 2024.

The Center appointed Yijun Tian as the sole panelist in this matter on July 29, 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

A. Complainant

Complainant, Premiata S.R.L., is a company incorporated in Italy. Founded in 1985, it is renowned for high-quality shoe manufacturing. By 2019, Complainant produced over 700,000 sneakers, distributed in more than 1,200 high-end stores and five Complainant's stores, including its flagship in Milan's fashion district.

Complainant has rights in the PREMIATA related marks. Complainant is the exclusive licensee of the numerous PREMIATA trademarks worldwide, including the European Union Trade Mark registration for PREMIATA, registered on May 2, 2001 (trademark number: 000418236); and the International trademark registration for PREMIATA, registered on December 19, 2008 (registration number: 1002682) (Annex 5 to the Complaint).

B. Respondents

Respondents are Amelia Zemlak, United States, Ariana Zilliacus, United States, 卫迎松 (Banks Michelle), China and United States, Lancaster Lily, United States, Christi Dahlgren, United States, and Vanessa Raymond, United States.

The disputed domain name <it-premiata.com> was registered by 卫迎松 (Banks Michelle), China and United States, on May 26, 2024; the disputed domain names <premiatashoescanada.com>, <premiatashoesphilippines.com>, and <premiatausale.com> were registered by Lancaster Lily, United States, Christi Dahlgren, United States, and Vanessa Raymond, United States respectively, on May 9, 2024; the disputed domain name <premiata-singapore.com> was registered by Ariana Zilliacus, United States, on April 26, 2024; and the disputed domain name <premiataweb.com> was registered by Amelia Zemlak, United States, on May 28, 2024.

According to the Complaint and relevant evidence provided by Complainant, the disputed domain name <it-premiata.com> has resolved to a website displaying Complainant's contact details, and offering purported PREMIATA branded products; the disputed domain names <premiatashoescanada.com>, <premiatashoesphilippines.com>, and <premiatausale.com> all have resolved to blocked and/or inactive websites; the disputed domain name <premiata-singapore.com> used to resolve to a website prominently displaying the PRENIATA mark and offering purported PREMIATA branded products and currently resolves to an inactive website; and the disputed domain name <premiataweb.com> has resolved to an inactive website.

5. Parties' Contentions

A. Complainant

Complainant contends that the disputed domain names are identical or confusingly similar to the trademark PREMIATA, in which Complainant has rights, and its company name, Premiata S.r.l. The disputed domain names incorporate the PREMIATA trademark in its entirety, combined with terms like "shoes", "sale", "web", "it", "canada", "philippines", "usa", and "singapore". These additions are insufficient to avoid confusion or prevent a finding of confusing similarity with the PREMIATA trademark.

Complainant contends that Respondents have no rights or legitimate interests in the disputed domain names.

Complainant contends that the disputed domain names were registered and are being used in bad faith.

Complainant requests that the disputed domain names be transferred to it.

B. Respondents

Respondents did not reply to Complainant's contentions.

6. Discussion and Findings

6.1. Language of the Proceeding

The language of the Registration Agreements for the disputed domain names <premiatashoescanada.com>, <premiatashoesphilippines.com>, <premiata-singapore.com>, <premiatausale.com>, and <premiataweb.com> is English. The language of the Registration Agreement for the disputed domain name <it-premiata.com> is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

From the evidence presented on the record, no agreement appears to have been entered into between Complainant and Respondents to the effect that the language of the proceeding should be English. Complainant initially filed its Complaint in English, and has requested that English be the language of the proceeding for the following reasons:

- (a) The website content associated with the disputed domain name <it-premiata.com> is entirely in Italian or English, with no Chinese language present.
- (b) The characters in the disputed domain name <it-premiata.com> are Latin/English, not Chinese. "it" and "premiata" are not Chinese words.
- (c) The registrant's email, "[...].@teleworm.us", is composed entirely of Latin characters.
- (d) English is the most commonly used language globally for business, negotiations, administrative matters, and Internet- and computer-related activities.
- (e) According to the Registrar, Respondent Michelle Banks resides in Texas, United States, making it highly probable that she is an English speaker.
- (f) The language of the registration agreement for the remaining five disputed domain names is English.
- (g) Proceeding in Chinese would slow the process and create further difficulties and costs for

Complainant, who is not familiar with the language.

Respondents did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

On the record, Respondents, Amelia Zemlak, Ariana Zilliacus, Banks Michelle, Lancaster Lily, Christi Dahlgren, and Vanessa Raymond, appear to be located in the United States and are thus presumably native English speakers; Respondent, 卫迎松 (Banks Michelle), appears to be located in both China and the United States and it is thus unclear what is the native language of 卫迎松 (Banks Michelle); but considering the following aspects, the Panel has decided that the language of the proceeding shall be English: (a) the disputed domain names are registered in Latin characters, particularly containing English terms (e.g., "shoes", "sale", "web", "it", "canada", "philippines", "usa", and "singapore", rather than Chinese script; (b) the generic Top-Level Domain ("gTLD") of the disputed domain names is ".com", so the disputed domain names seem to be prepared for users worldwide, particularly English speaking countries; (c) the webpages, which the disputed domain name <it-premiata.com> resolved to, were in the English and Italian language; (d) the Center has notified Respondents of the language of the proceeding in both Chinese and English, and Respondents have not indicated any objection to Complainant's request that English be the language of the proceeding; and (e) the Center also notified Respondents in both Chinese and English of the Complaint, and informed Respondents that it would accept a response in either English or Chinese, but Respondents chose not to file any response.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. Complainant alleged that the Respondents, if not the same entity, are at least linked and that the disputed domain names are under common control. 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 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 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 3.0](#), section 4.11.2.

As regards common control, the Panel finds that Complainant has provided sufficient evidence to establish that the disputed domain names or corresponding websites are subject to common control, for the following reasons:

- (a) All registrant details for the disputed domain names are hidden through privacy shields or redacted.
- (b) All disputed domain names were registered in a short span between April 26 and May 28, 2024, with three registered on the same day, May 9, 2024.
- (c) The disputed domain names are structurally identical, all containing the PREMIATA trademark

combined with terms like “shoes”, “web”, “sale”, “canada”, “usa”, “singapore”, or “it”.

(d) Three disputed domain names (<premiatashoescanada.com>, <premiatashoesphilippines.com>, and <premiatausale.com>) share the same registrar (Key-Systems GmbH), email ([...][@domain-contact.org](mailto:domain-contact.org)), and IP origin (cloudflare.com).

(e) Five of six disputed domain names (<premiatashoescanada.com>, <premiatashoesphilippines.com>, <premiata-singapore.com>, <premiatausale.com>, and <premiataweb.com>) are currently inactive, and display error messages, such as “This site can’t be reached”, “Your connection is not private” or “Sorry, you have been blocked”.

(f) Five of six disputed domain names (<premiatashoescanada.com>, <premiatashoesphilippines.com>, <premiatausale.com>, <premiataweb.com>, and <it-premiata.com>) share the same ADMIN-C IP address (cloudflare.com).

(g) The disputed domain names <it-premiata.com> and <premiata-singapore.com> used to direct to websites selling purported PREMIATA-branded goods and displaying copyrighted images of Complainant.

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 “Respondent”) in a single proceeding.

6.3 Substantive Issues: Three Elements

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 Complainant’s trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.4.

The Panel finds the entirety of the PREMIATA 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 “philippines”, “singapore”, “shoes”, “sale”, “web”, “it”, “canada”, “usa” and/or “-” may bear on the 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.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain names. Respondent has not rebutted 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.

More specifically:

(i) there has been no evidence adduced to show that Respondent is using the disputed domain names in connection with a bona fide offering of goods or services. Respondent has not provided evidence of reasons to justify the choice of the term "premiata", the PREMIATA trademark, in the disputed domain names. There has been no evidence to show that Complainant has licensed or otherwise permitted Respondent to use the PREMIATA or to apply for or use any domain name incorporating the PREMIATA marks;

(ii) there has been no evidence adduced to show that Respondent has been commonly known by the disputed domain names. There has been no evidence adduced to show that Respondent has any registered trademark rights with respect to the disputed domain names. Respondent registered the disputed domain names in 2024, long after the PREMIATA marks (registered as a trademark since 2001) became widely known. The disputed domain names are confusingly similar to Complainant's PREMIATA marks; and

(iii) there has been no evidence adduced to show that Respondent is making a legitimate noncommercial or fair use of the disputed domain names. By contrast, four of six disputed domain names (<premiatashoescanada.com>, <premiatashoesphilippines.com>, <premiatausale.com>, and <premiataweb.com>) resolve to inactive websites, which do not represent any bona fide offering. Given the composition of the disputed domain names – combining the Complainant's trademark with terms like country names (such as "Canada") and/or online store-related terms (such as "sale" or "web") – they are likely to mislead Internet users regarding their association with Complainant. The disputed domain name <it-premiata.com> currently resolves to and <premiata-singapore.com> previously resolved to a website prominently displaying the PREMIATA mark or displaying Complainant's contact details, and offering to sell purported PREMIATA branded products. It seems that Respondent is likely making profits through the Internet traffic attracted to the websites under the disputed domain names. (See *BKS Bank AG v. Jianwei Guo*, WIPO Case No. [D2017-1041](#); and *Pet Plan Ltd. v. 权中俊 and 李金梁 (Li Jin Liang)*, WIPO Case No. [D2020-3358](#)).

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, unauthorised account access/hacking, impersonation/passing off, or other types of fraud) 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.

In the present case, the Panel notes that Respondent has registered and used the disputed domain names 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.

Regarding the four inactive disputed domain names, UDRP panels have found that the non-use of domain names (such as a "This site can't be reached" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of four disputed domain names (<premiatashoescanada.com>, <premiatashoesphilippines.com>, <premiatausasale.com>, and <premiataweb.com>) does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness or reputation of Complainant's trademark, and the composition of the four disputed domain names, and finds that in the circumstances of this case the passive holding of the four disputed domain names does not prevent a finding of bad faith under the Policy.

Regarding the active disputed domain names (<it-premiata.com> and <premiata-singapore.com>), Respondent has used the website to which the disputed domain names resolved to purportedly offer for sale Complainant's PREMIATA branded products. Pursuant to paragraph 4(b)(iv) of the Policy, such use falls plainly within the non-exhaustive list of examples of registration and use in bad faith, namely using the confusingly similar disputed domain names with the intention to attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark. Having reviewed the record, the Panel finds that Respondent's registration and use of the disputed domain names <it-premiata.com> and <premiata-singapore.com> constitute bad faith under the Policy.

Based on the information provided by Complainant, the Panel finds that Complainant has a widespread reputation in the PREMIATA marks with regard to its products and services. It is not conceivable that Respondent would not have had Complainant's trademark in mind at the time of the registration of the disputed domain names (in 2024). This has been reinforced by the fact that each disputed domain name incorporates the PREMIATA trademark.

Thus, the Panel concludes that Respondent has engaged in bad faith conduct with respect to the disputed domain names.

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 <it-premiata.com>, <premiatashoescanada.com>, <premiatashoesphilippines.com>, <premiata-singapore.com>, <premiatausasale.com>, and <premiataweb.com> be transferred to Complainant.

/Yijun Tian/

Yijun Tian

Sole Panelist

Date: August 12, 2024