

## **ADMINISTRATIVE PANEL DECISION**

Maison Minelli v. Nestares Sergio Nieto  
Case No. D2024-3429

### **1. The Parties**

The Complainant is Maison Minelli, France, represented by Cabinet Bouchara, France.

The Respondent is Nestares Sergio Nieto, Spain.

### **2. The Domain Name and Registrar**

The disputed domain name <minelli-fr.shop> (the “Disputed Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 21, 2024. On August 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name, which differed from the named Respondent (anonymous holder) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 26, 2024, 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 amended Complaint on the same day.

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 the Respondent of the Complaint, and the proceedings commenced on August 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 17, 2024.

The Center appointed Mariia Koval as the sole panelist in this matter on September 20, 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 operates in the field of design, manufacture and distribution of shoes for women and men, as well as fashion accessories and leather goods, particularly in France, where its core business is based.

The Complainant owns numerous MINELLI trademark registrations (the "MINELLI Trademark") in France, among which are:

- French Trademark Registration No. 1283850, registered on September 13, 1984, in respect of goods in classes 14, 18, 25;
- French Trademark Registration No. 4081461, registered on April 4, 2014, in respect of goods and service in classes 18, 25, 35.

The Complainant also has a registered trademark for MINELLI PARIS, i.e., French Trademark Registration No. 4946379, registered on March 17, 2023, in respect of services in class 35.

The Complainant has built up a considerable online presence and is operating domain name <minelli.fr>. The Complainant also operates various social media platforms, particularly Facebook, Instagram, and LinkedIn, where the MINELLI Trademark is extensively used and promoted.

The Disputed Domain Name was registered on July 9, 2024. As of the date of this Decision, when accessing via a desktop, the Disputed Domain Name resolves to a website which offers female and male clothing for sale. In the section "About Us" the website has a reference to the name "Fulawear". At the same time the website under the Disputed Domain Name is also accessible via mobile phone and resolves to a website which contains the Complainant's trademarks and purports to offer goods under the MINELLI Trademark for sale. The Complainant has also provided evidence showing the same use of the Disputed Domain Name through mobile phone at the time of filing of the Complaint.

#### **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 Name.

Notably, the Complainant contends that the Disputed Domain Name is confusingly similar to the Complainant's MINELLI Trademark since the Disputed Domain Name reproduces the Complainant's MINELLI Trademark in its entirety with the addition of the suffix "-fr" designating France. This added term is a country code and can therefore not prevent a finding of confusing similarity.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name in view of the following:

- the Respondent does not own any rights to the MINELLI Trademark, which belong exclusively to the Complainant;
- the Respondent did not, at any time, request or obtain any authorization, on any ground whatsoever, to reproduce and imitate the Complainant's MINELLI Trademark within the Disputed Domain Name,

- nor in the course of a commercial activity, especially to designate goods that are identical to those of the Complainant, notably ready to wear products;
- there is no relationship whatsoever between the Complainant and the Respondent as the Respondent is not related in any way to the Complainant's business;
  - the Complainant is notoriously known on social networks that the Respondent could not have ignored it.

The Complainant further claims that the Respondent has registered and is using the Disputed Domain Name in bad faith. The Respondent exploits the reputation of the Complainant and the Complainant's MINELLI Trademark in order to attract Internet users to the website under the Disputed Domain Name, by creating a likelihood of confusion with the Complainant's MINELLI Trademark for commercial gain. The website under the Disputed Domain Name strictly reproduces, without any authorization, the Complainant's MINELLI Trademark on all its pages, and from the landing page highly suggesting that the Complainant is affiliated with or, sponsors, the Respondent's website.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

### **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 of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

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.

The Disputed Domain Name completely reproduces the Complainant's MINELLI Trademark in combination with a hyphen, geographical abbreviation "fr", and the generic Top-Level Domain (gTLD) ".shop". According to the [WIPO Overview 3.0](#), section 1.8, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. In this case, the addition of the country code "fr", to the MINELLI Trademark does not prevent a finding of confusing similarity.

According to the [WIPO Overview 3.0](#), section 1.11, the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Furthermore, the use of hyphens in the Disputed Domain Name is irrelevant in a finding of confusing similarity as the MINELLI Trademark is recognizable within the Disputed Domain Name.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's MINELLI Trademark pursuant to paragraph 4(a)(i) of the Policy.

## 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 Name. 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 Name such as those enumerated in the Policy or otherwise.

There is no evidence that the Complainant has licensed or otherwise permitted the Respondent to use its MINELLI Trademark or to register the Disputed Domain Name which is confusingly similar to the MINELLI Trademark. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name.

The Panel is of opinion that there is no evidence that the Respondent is using the Disputed Domain Name to offer bona fide goods or services or making a legitimate noncommercial or fair use. On the contrary, as at the date of this Decision when accessing via a desktop, the Disputed Domain Name resolves to the website which offers female and male clothing for sale; in the section “About Us” the website has a reference to the name “Fulawear”. At the time of filing of the Complaint and drafting this Decision, when accessing via a mobile phone, the Disputed Domain Name resolves to different website which reproduces the Complainant’s trademarks on all its pages and copies the Complainant’s official website’s landing page, purportedly offering for sale goods under the MINELLI Trademark. According to the [WIPO Overview 3.0](#), section 2.8.1, UDRP panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the “Oki Data test”, the following cumulative requirements will be applied to the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

As is seen from the circumstances of this case, the websites under the Disputed Domain Name, both accessible via a desktop and a mobile phone, do not disclose the relationship between the Complainant and the Respondent. On the contrary, according to the section “About Us” on the website under the Disputed Domain Name, accessible via a mobile phone, there is information about the Complainant that creates a false impression that this website is one of the Complainant’s official websites or related to the Complainant. Thus, the Respondent does not satisfy the conditions of the Oki Data test.

Moreover, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The fact that the Respondent has incorporated the Complainant's MINELLI Trademark in its entirety in the Disputed Domain Name with the addition of the term "fr", which is the two-letter country code for France where the Complainant has a primary place for its business, to the Complainant's MINELLI Trademark in the Disputed Domain Name, is further evidence, that the Respondent was well aware of the Complainant's MINELLI Trademark and business at the time of registration of the Disputed Domain Name and has done so for the only purpose of creating an impression that the Disputed Domain Name is connected with the Complainant's MINELLI Trademark.

In light of the above, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name. Therefore, the second element of the paragraph 4(a) of the Policy has been met by the Complainant.

### **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 the Respondent registered and is using the Disputed Domain Name in bad faith in view of the following. The Complainant obtained the registration of the MINELLI Trademark approximately 40 years earlier than the Respondent registered the Disputed Domain Name in 2024. Taking into account all circumstances of this case, the Panel finds that the Respondent was well aware of the Complainant's business and its MINELLI Trademark when registering the confusingly similar Disputed Domain Name that completely incorporates the Complainant's MINELLI Trademark. The Panel considers it is bad faith that the Respondent deliberately chose the Disputed Domain Name to create a likelihood of confusion with the Complainant's MINELLI Trademark, so as to create a false association or affiliation with the Complainant.

Moreover, the Respondent's knowledge of the Complainant's MINELLI Trademark is also supported by the use of the Disputed Domain Name when being accessed through a mobile phone, where goods under the MINELLI Trademark are purportedly offered to sale. Further, the Panel accessed the website at the disputed domain name via the mobile phone at the time of this Decision and noted the products sold under the MINELLI Trademark were at a lower price than the authentic ones and contained the Complainant's logo and original product images. In view of the fact that the Disputed Domain Name resolves to a website (accessible via a mobile phone) displaying the Complainant's MINELLI Trademark, Internet users would most likely be misled into believing that the Disputed Domain Name is related to or authorized by the Complainant.

Furthermore, the Disputed Domain Name, reproducing the Complainant's MINELLI Trademark in its entirety, is evidently deceptive for consumers. The Respondent obviously chose to register the Disputed Domain Name, which is confusingly similar to the Complainant's MINELLI Trademark, for the purpose of attracting Internet users to its website by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and of the products sold on it.

According to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is of the opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the Complainant's well-known MINELLI Trademark, to purportedly sell the Complainant's products, intended to disrupt the Complainant's business and confuse Internet users seeking or expecting the Complainant's website. In view of the absence of any evidence to the contrary and the fact that the Respondent did not file

any response to claim otherwise, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

In light of the above, 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 Name <minelli-fr.shop> be transferred to the Complainant.

*/Mariia Koval/*

**Mariia Koval**

Sole Panelist

Date: October 4, 2024