

## ADMINISTRATIVE PANEL DECISION

PRADA S.A. v. zhenyong fan  
Case No. D2024-5285

### 1. The Parties

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

The Respondent is zhenyong fan, China.

### 2. The Domain Name and Registrar

The disputed domain name <pradaoutletshop.com> is registered with NameCheap, Inc. (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 23, 2024. On December 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 23, 2024, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 30, 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 amendment to the Complaint on December 31, 2024.

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 January 10, 2025. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 3, 2025.

The Center appointed María Alejandra López García as the sole panelist in this matter on February 5, 2025. 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 contends that it is a recognized Italian luxury fashion company, renowned for its sophisticated style and high-end products. Established in 1913 by Mario Prada, initially focused on leather goods, including handbags and travel accessories. Through the years, the Complainant contends that it evolved into a global symbol of luxury, offering a wide range of products such as ready-to-wear clothing, shoes, perfumes, and fashion accessories, among others.

The Complainant operates in 70 countries with 14,800 employees approximately.

The Complainant registered over 260 domain names consisting of or comprising the trademark PRADA under several different Top-Level Domains ("TLDs"), including, inter alia, <prada.com>, registered on June 9, 1997.

The Complainant owns the trademark PRADA, in multiple jurisdictions, including as follows:

- Italian Trademark, for PRADA (word mark), Reg. No. 362017000069322, registered on July 8, 1978, in International Classes ("ICs") 14, 16, 18, and 25; and duly renewed.
- European Union Trade Mark for PRADA (word mark), Reg. No. 271163, registered on November 8, 2000, in ICs 9, 16, and 21; and duly renewed.
- Chinese Trademark for PRADA (word mark), Reg. No. 1263052, registered on April 14, 1999, in IC 18, and duly renewed.

The disputed domain name was registered on May 30, 2024, and resolves to an active website that offers and sells purportedly counterfeit products under the Complainant's trademark PRADA. Additionally, the mail exchanger ("MX") records have been set.

#### **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.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, the Complainant must satisfy each of the three following elements:

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

No Response or any kind of communication has been submitted by the Respondent, despite the cease-and-desist letter sent by the Complainant on June 28, 2024; and the subsequent fair opportunity given by the Center to present its case under paragraph 2(a) of the Rules. However, the Complainant must establish the three elements of paragraph 4(a) of the Policy. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.3. Therefore, this Panel shall analyze the evidence submitted by the Complainant and decide this dispute under the "balance of probabilities" or "preponderance of the evidence" standard. See, paragraphs 14 and 15(a) of the Rules, and [WIPO Overview 3.0](#), section 4.2.

#### **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.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the 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, "outlet", and "shop", 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 name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

As for the applicable generic Top-Level Domain ("gTLD") ".com", it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark, as it is a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11.1.

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 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.

Especially this Panel notes that given the use of the disputed domain name, where the Respondent offers for sale purported PRADA products at discounted prices, without any kind of Complainant's authorization or providing any disclaimer as to the Respondent's lack of relationship with the Complainant, does not constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain as set out in paragraph 4(c) of the Policy.

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

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 the Respondent registered a domain name, whereby at the time of its registration, the Complainant's trademark rights not only significantly predate, but were well-known worldwide. Furthermore, given the content and use of the disputed domain name to offer and sell purported counterfeit products, where the MX records are set, to this Panel, is obvious that the Respondent was not only well aware of the Complainant's trademark value but that it has incurred paragraph 4(b)(iv) of the Policy.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or other types of fraud) 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 disputed domain name constitutes bad faith under 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 name <pradaoutletshop.com> be transferred to the Complainant.

*/María Alejandra López García/*

**María Alejandra López García**

Sole Panelist

Date: February 17, 2025