

ADMINISTRATIVE PANEL DECISION

La Rinascente S.p.A. v. Jerry Ferry and Rinascente Outlet
Case No. D2025-0988

1. The Parties

The Complainant is La Rinascente S.p.A., Italy, represented by Leexè Studio Legale, Italy.

The Respondents are Jerry Ferry, Italy and Rinascente Outlet, Italy.

2. The Domain Names and Registrars

The disputed domain name <rinascence-outlet.com> is registered with Tucows Domains Inc.

The disputed domain name <rinascenceoutlet.com> is registered with Hostinger Operations, UAB (the above two Registrars will hereafter be collectively referred to as “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 11, 2025. On March 12, 2025, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On March 12, 2025, and March 13, 2025, the Registrars transmitted by email to the Center its verification response disclosing registrants and contact information for the disputed domain names which differed from the named Respondent (Contact Privacy Inc. Customer 0173992023/ Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint.

The Center sent an email communication to the Complainant on March 13, 2025 with the registrants and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaints 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. The Complainant filed a first amendment to the Complaint on March 17, 2025, and a second (to replace the first one) on March 19, 2025.

The Center verified that the Complaint together with the amendments 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 March 25, 2025. In accordance with the Rules, paragraph 5, the due date for Response was April 14, 2025. The Respondents did not submit any formal response. However, email communications were received from the Respondents on April 14, 2025, and April 17, 2025, confirming both disputed domain names belong to the same owner, and “agree to the voluntary removal or transfer of both domain names”. However, the Complainant has confirmed by email on April 17, 2025 that no settlement options will be explored.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on April 28, 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 is an Italian company, headquartered in Milan, Italy. The Complainant’s origins date back over a century, and its name, “la Rinascente”, was coined by Gabriele d’Annunzio in 1917 and the Complainant’s company bearing the same name was officially registered in the same year.

The Complainant has acquired a high reputation in Italy and abroad, becoming a luxury department store. The Complainant has nine prestigious stores in Italy, in the hearts of main cities (Milan, Rome, Florence and others). On May 26, 2016, Rinascente Milan received the award for best department store in the world at the ceremony in Zurich of IGDS (Intercontinental Group of Department Stores), the largest international association of department stores.

In 2023, visitors to the Complainant’s stores reached 21 million, plus a further 20 million visitors to the e-commerce site.

The Complainant has numerous trademark registrations around the world, consisting of or containing the RINASCENTE.

The Complainant is, inter alia, the owner of the following:

Italian Trademark registration No. 533174 for LA RINASCENTE (word) registered on September 5, 1990;

International Trademark registration No. 581076 for LA RINASCENTE (device) registered on January 7, 1992;

European Union Trademark registration No. 001456052 for LA RINASCENTE (device) registered on January 31, 2001.

The Complainant also owns the domain names, <rinascente.it> (registered on January 29, 1996) and <rinascente.com> (registered on November 4, 2001).

The disputed domain names, <rinascente-outlet.com> and <rinascenteoutlet.com>, were registered on February 2, 2025 and February 24, 2025 respectively.

Currently the disputed domain names are not linked to active websites. However, from the submissions provided by the Complainant, it appears that previously (at least on February 21, 2025) the disputed domain name <rinascente-outlet.com> resolved to a website wholly related to the Complainant, displaying on its home page the image of an entrance to a Rinascente store, closely resembling the real one. Furthermore, on this website the message “benvenuto nell’outlet ufficiale di Rinascente, il luogo dove l’eleganza e la qualità dei migliori brand sono alla portata di tutti” (in English: welcome to the official Rinascente outlet, where the elegance and quality of the finest brands are accessible to all) was displayed. It then appears

that, after this website was taken down following the Complainant's request to the relevant Provider, the same content was put up on the website to which the second disputed domain name, <rinascenteoutlet.com>, resolved.

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 LA RINASCENTE trademark, that the Respondents have no rights or legitimate interests in respect of the disputed domain names, and particularly that it is implausible that the Respondents, located in Italy, were unaware of the Complainant's renowned trademark when they registered the disputed domain names, and thus that they registered and used the disputed domain names with the intention to exploit the goodwill of the Complainant's renowned trademark for their own benefit.

Regarding the Respondents' identity, the Complainant has requested a consolidation of multiple disputed domain names and the Respondents. In support of the above request, the Complainant's main claims are that:

1. the Respondents are related to the extent that a sufficient unity of interest exists such that they may essentially be treated as a single domain name holder for the purposes of Policy paragraph 3(c) of the Rules;
2. the content displayed on the relevant websites to which the disputed domain names resolved was the same;
3. the composition of the disputed domain names is almost identical;
4. the copyright statement displayed on both websites is identical, i.e. "Copyright 2024, rinascence –outlet all rights reserved";
5. consolidation of proceedings would be fair and equitable to all Parties.

B. Respondents

The Respondents have made no formal reply to the Complainant's contentions. However, the Respondent Jerry Ferry, following the Center's notification to the Parties of the Respondent's default, sent the two following informal email communications to the Center affirming that:

".....I would like to respectfully clarify that I had no intention whatsoever of infringing upon any trademark rights. At the time of registration and use of the domain, I was not aware that such activity could be considered unlawful or in violation of intellectual property regulations.

Upon receiving the formal notification and becoming aware of the issue, I took immediate action to cease all related activities. The website has been shut down and is no longer accessible.

Please rest assured that I fully respect intellectual property laws and will cooperate as necessary to resolve this matter appropriately."

"..... I hereby confirm that I am the registrant of the domain names:

<rinascente-outlet.com>

<rinascenteoutlet.com>

At the time of registration and use, I was not aware that these domains could infringe upon any third party rights or applicable laws. As soon as I became aware of the issue, I immediately ceased any related activity. I do not intend to oppose the Complainant's request, and I agree to the voluntary removal or transfer of both domain names, in order to bring this matter to a close without further proceedings."

6. Discussion and Findings

6.1. Late Filing of the second Amendment and of the Respondent's second email

Paragraph 14(a) of the Rules provides that, in the event of a late response, absent exceptional circumstances, panels shall proceed to a decision based solely on the complaint.

Paragraph 14(a) of the Rules is counterbalanced by paragraph 10(b) of the Rules, which requires panels to ensure that parties are treated with equality and that each party is given a fair opportunity to present its case.

The late Amendment was filed with the Center on March 19, 2025, namely one day after the deadline for filing the Amendment had expired.

The Panel however notes that a first Amendment was filed on time, i.e. on March 17, 2025, and that the second Amendment, intended to replace the first one, basically reaffirms, giving additional details, the Complainant's assertions that were already contained in the Complaint and in the first Amendment, to wit, that the disputed domain names are registered by the same entity.

The Panel further notes that:

- the second amendment was filed before commencement of the decision-making process by the Panel;
- the lateness did not delay the decision;
- the second amendment was late only by one day;
- the Respondent has confirmed that he is the registrant of the disputed domain names.

In the case at hand, notwithstanding the absence of exceptional circumstances, taking into account the period of the delay, (one day), and the lack of prejudice to the Respondent, the Panel determines that it will allow and consider the late Amendment in this proceeding.

The second email from the Respondent was filed on April 18, 2025, i.e. after the deadline to file a Response had expired.

The Panel notes that:

- this email was also filed before commencement of the decision-making process by the Panel;
- the lateness did not delay the decision;
- the email was late only by four days;
- the Respondent affirmed he does not intend to oppose the Complainant's request, and that he agrees to the voluntary removal or transfer of both domain names, in order to bring this matter to a close without further proceedings.

In view of the above and exercising its powers according to paragraph 10(b) of the Rules, the Panel deems appropriate to admit the Respondent's late email and will thus consider it in rendering the Decision.

6.2. Consolidation: Multiple Respondents

The Amendments to the 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 Respondent in its second email communication explicitly confirmed that he is the registrant of both disputed domain names, and did not object to the Complainant's consolidation 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, owing to the fact that the Complainant has given credible elements from which to infer the common control, and that the Respondent has explicitly confirmed that he is the registrant of both disputed domain names, has no difficulty in finding that the disputed domain names identified in the Complaint are registered by the same domain name holder.

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.

6.3. Consent to Transfer

As mentioned above, in its informal communications the Respondent consents to transfer the disputed domain names to the Complainant "in order to bring this matter to a close without further proceedings".

Paragraph 4.10 of the [WIPO Overview 3.0](#) considers whether a UDRP panel can decide a case based on a respondent's consent to transfer:

Where parties to a UDRP proceeding have not been able to settle their dispute prior to the issuance of a panel decision using the "standard settlement process" described above, but where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent. In such cases, the panel gives effect to an understood party agreement as to the disposition of their case (whether by virtue of deemed admission, or on a no-fault basis).

In some cases, despite such respondent consent, a panel may in its discretion still find it appropriate to proceed to a substantive decision on the merits. Scenarios in which a panel may find it appropriate to do so include (i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent's consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights.

The Panel has decided to proceed to a substantive determination for the following reasons:

1. While consenting to the requested remedy the Respondent has expressly disclaimed any bad faith.
2. The Complainant has not agreed to accept such consent and has expressed a preference for a recorded decision.
3. There is a question mark over the genuineness of the Respondent's consent.
4. There is a broader interest in recording a substantive decision on the merits.

6.4. Substantive Issues

In order for the Complainant to obtain a transfer of the disputed domain names, paragraph 4(a) of the Policy requires that the Complainant must demonstrate to the Panel that:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

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 Panel finds the mark LA RINASCENTE is recognizable 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.

Although the addition of the other term here, "outlet", may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

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 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. Indeed, the Respondent's informal response appears to confirm the Respondent's lack of any rights or legitimate interests in the disputed domain names.

Moreover, Panels have held that the use of a domain name for illegal activity here, claimed as impersonation/passing off, can never confer rights or legitimate interests on a respondent.

[WIPO Overview 3.0](#), section 2.13.1.

Moreover, the composition of the disputed domain names, being confusingly similar to the Complainant's trademark plus the term "outlet", carries a risk of implied affiliation, and suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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.

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 intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark.

The disputed domain names reproduce, without any authorization or approval, the Complainant's registered LA RINASCENTE trademark. The disputed domain names were registered many years after the Complainant's trademark was registered and became renowned. They were used to resolve to websites wholly related to the Complainant, and to display the message "benvenuto nell'outlet ufficiale di Rinascente, il luogo dove l'eleganza e la qualità dei migliori brand sono alla portata di tutti". Therefore, it is more likely than not that the Respondent, when registering the disputed domain names, had knowledge of the Complainant's earlier rights to the LA RINASCENTE trademark, and chose the disputed domain names intentionally in order to misleadingly attract Internet users to its own website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark, and that this amounts to bad faith use and registration of the disputed domain names.

The Respondent's use of the disputed domain names incorporating the Complainant's trademark to misleadingly direct Internet users to a website where services in direct competition with the Complainant's services are offered, is, in the view of the Panel, sufficient evidence of bad faith registration and use under paragraph 4(b)(iv) of the Policy.

The bad faith registration and use of the disputed domain names are also affirmed by the fact that, immediately after the disputed domain name <rinascence-outlet.com> was taken-down by the relevant Provider (following the request of the Complainant), the Respondent registered the disputed domain name <rinascenceoutlet.com>, which resolved to the same identical web pages displaying the same content that was previously displayed on the website "www.rinascence-outlet.com."

Furthermore, the Panel notes that both disputed domain names resolve to inactive pages at the time of this decision. Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of some of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant’s trademark, the composition of the disputed domain names, the previous use of the disputed domain names, and the Respondent’s concealing its identity when registering the disputed domain names and finds that in the circumstances of this case the current passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

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 <rinascente-outlet.com>, and <rinascenteoutlet.com> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: May 5, 2025