

ADMINISTRATIVE PANEL DECISION

Loro Piana S.p.A. v. Kirill Kirillov, Private Person
Case No. D2022-0131

1. The Parties

The Complainant is Loro Piana S.p.A., Italy, represented by Bird & Bird LLP, Italy.

The Respondent is Kirill Kirillov, Private Person, Russian Federation.

2. The Domain Names and Registrar

The disputed domain names <discount-loropiana.online>, <loropianaofficial.online>, <loro-piana.online>, <loropiana-store.online>, <loropianastore.online>, <msk-loropiana.online>, and <online-loropiana.online> (the “Domain Names”) are registered with REG.RU LLC (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 14, 2022. On January 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On January 17, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Registrar confirmed that the language of the Registration Agreement for the Domain Names is Russian. On January 20, 2022, the Center sent an email communication to the Parties in both English and Russian regarding the language of the proceeding. The Complainant requested that English be the language of the proceeding on January 21, 2022. The Respondent did not comment on the language of the proceeding.

The Center verified that 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 in both English and Russian, and the proceedings commenced on January 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2022. On March 15, 2022, the Center sent email communication regarding Notification of Complaint to the Parties, with the due date for Response on March 25, 2022.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on April 11, 2022. 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

Loro Piana S.p.A., the Complainant in the present proceedings, is an Italian fabrics and clothing company. It specializes in the processing of cashmere, vicuña and extra fine wool. The Complainant currently operates more than 170 flagship stores worldwide.

The Complainant is the owner of numerous LORO PIANA trademark registrations, including:

- the Russian Registration LORO PIANA No. 771151 registered on August 13, 2020;
- the European Union Registration LORO PIANA No. 18162715 registered on May 22, 2020;
- the International Registration LORO PIANA No. 1546962 registered on May 22, 2020.

The Complainant is also the owner of numerous domain names incorporating its LORO PIANA trademark, including <loropiana.com>.

The Respondent registered the Domain Names on the following dates:

- <loropianaofficial.online> registered on July 29, 2021;
- <loro-piana.online> registered on July 29, 2021;
- <loropianastore.online> registered on September 14, 2021;
- <loropiana-store.online> created on September 14, 2021;
- <discount-loropiana.online> registered October 3, 2021;
- <online-loropiana.online> registered on October 3, 2021;
- <msk-loropiana.online> registered on October 4, 2021.

In accordance with the screenshots attached to the Complaint, as of October 6, 2022, one of the Domain Names – <loropianaofficial.online> resolved to a website imitating the Complainant’s official website and purporting to sell authentic products of the Complainant (the “Website”). The rest of the Domain Names resolved, at the time of drafting the Complaint, to inactive websites. As of the date of this Decision, the Domain Names resolve to inactive websites.

5. Parties’ Contentions

A. Complainant

The Complainant requests that the Domain Names be transferred to the Complainant. According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Names are identical or confusingly similar to the LORO PIANA trademark registrations of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Names.

Third, the Complainant submits that the Domain Names were registered and are being used in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the disputed domain name is 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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence". See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

A. Language of Proceedings

The language of the Registration Agreement for the Domain Names is Russian. Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Panel may also order that any documents submitted in a language other than that of the proceeding be translated.

As noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case, and that the proceeding takes place with due expedition (see, e.g., *General Electric Company v. Edison Electric Corp. a/k/a Edison Electric Corp. General Energy, Edison GE, Edison-GE and EEEGE.COM*, WIPO Case No. [D2006-0334](#)).

The Complainant has submitted a request that the language of the proceedings be English.

The Complainant contends *i.a.* that the Domain Names consist of the Latin alphabetical characters and include the English words "discount", "official", "store", and "online". Therefore, according to the Complainant, it may be concluded that the Respondent is familiar with English. On the other hand, the Complainant alleges that it is not familiar with Russian. Thus, conducting the proceeding into Russian would result in substantial additional expenses and inconvenience for the Complainant. Also, translating the Complaint into Russian would delay the proceeding.

The Panel accepts that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Russian. Moreover, the Panel notes that the Respondent did not comment on the language of the proceedings.

Thus, taking these circumstances into account, the Panel finds that it is appropriate to exercise its discretion and allow the proceedings to be conducted in English.

B. Identical or Confusingly Similar

The first element that the Complainant must establish is that the Domain Names are identical or confusingly similar to the Complainant's trademark rights.

The Complainant holds numerous valid LORO PIANA trademark registrations, which precede the registration of the Domain Names.

The Domain Names incorporate the Complainant's LORO PIANA trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of such terms as "official", "store", "discount", "online" or "msk" does not prevent confusing similarity between the Domain Names and the Complainant's trademark. UDRP panels have consistently held that 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. See [WIPO Overview 3.0](#), section 1.8.

The Top-Level Domain "online" in the Domain Names is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Names are confusingly similar to the Complainant's trademark. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Names.

The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has made preparations to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services prior to the dispute; or
- (ii) that it is commonly known by the domain name, even if it has not acquired any trademark rights; or
- (iii) that it intends to make a legitimate, noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that there are the Complainant's LORO PIANA trademark registrations, which predate the Respondent's registrations of the Domain Names. There is no evidence in the case that the Complainant has licensed or otherwise permitted the Respondent to use the LORO PIANA trademark or to register the Domain Names incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Names.

Moreover, it results from the evidence submitted by the Complainant that the Respondent does not make use of the Domain Names in connection with a *bona fide* offering of goods or services, as well as it does not make a legitimate, noncommercial or fair use of the Domain Names without intent for commercial gain. On the contrary, as indicated above, the Respondent used the Website to operate the online store imitating the

Complainant's official online store and to sell allegedly authentic products of the Complainant.

Furthermore, the Panel finds that the nature of the Domain Names suggests an affiliation with the Complainant and its LORO PIANA trademark, as the Domain Names incorporate the Complainant's trademark in its entirety. See section 2.5, [WIPO Overview 3.0](#).

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Names. Thus, there is no evidence in the case file that refutes the Complainant's submissions. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

The third requirement the Complainant must prove is that the Domain Names have been registered and are being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in the LORO PIANA trademark predate the registration of the Domain Names. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration of the Domain Names. This finding is supported by the content of the Website. Moreover, it has been proven to the Panel's satisfaction that the Complainant's LORO PIANA trademark is well-known and unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of products the trademarks identify. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainant's trademark.

Moreover, the Complainant presented evidence that one of the Domain Names – <loropianaofficial.online> was used in bad faith by the Respondent to attract Internet users to the online store imitating the Complainant's official online store and purporting to sell allegedly authentic products of the Complainant. In consequence, the Panel accepts that the Respondent was using this Domain Name in an attempt to attract, for commercial gain, Internet users to this online store by creating a likelihood of confusion with the LORO PIANA trademark as to the source, sponsorship, affiliation, or endorsement of the website or the activity carried out through this website by the Respondent.

Moreover, the rest of the Domain Names resolved to inactive websites. In the overall circumstances of this case, the Panel finds that the Respondent's passive holding of the Domain Names supports the finding of bad faith. As numerous UDRP panels have held, passive holding, under the totality of circumstances of the case, can constitute a bad faith use under the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Novo Nordisk A/S v. CDMS Invest*, WIPO Case No. [D2012-0676](#).

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements under paragraph 4(a)(iii) 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 Domain Names <discount-loropiana.online>, <loropianaofficial.online>, <loro-piana.online>, <loropiana-store.online>, <loropianastore.online>, <msk-loropiana.online>, <online-loropiana.online> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: April 25, 2022