

ADMINISTRATIVE PANEL DECISION

Luigi Fedeli e Figlio S.r.l. v. Liukun Shi
Case No. D2022-2835

1. The Parties

The Complainant is Luigi Fedeli e Figlio S.r.l., Italy, represented by Carnelutti Law Firm, Italy.

The Respondent is Liukun Shi, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 1, 2022. On August 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 2, 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 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, and the proceedings commenced on August 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 1, 2022.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on September 6, 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

The Complainant is a knitwear company and owner of the Italian fashion brand FEDELI for luxury clothing and accessories, which was founded in 1934. It employs more than 70 employees at the headquarter in Monza, Italy, operates more than 13 flagship stores, and distributes to more than 430 wholesale clients worldwide (Annex 7 to the Complaint).

The Complainant is the owner of several registered figurative trademarks, FEDELI, in multiple jurisdictions worldwide. Below are details of a few exemplary trademarks (Annex 5 to the Complaint):

- European Union Trademark registration No. 003328333, FEDELI, filed on August 27, 2003, registered on October 29, 2004 in Class 25.
- International Trademark registration No. 813883 FEDELI, with a priority date of October 2, 2013, in Class 25 with extensions of protection into several countries worldwide, *inter alia* Japan, Mexico, Republic of Korea, New Zealand, Singapore, Azerbaijan, Kazakhstan, Türkiye, Ukraine, Switzerland, Russian Federation, United Kingdom, China.
- International Trademark registration No. 1300238 FEDELI, with a priority date of January 26, 2016, in Classes 3, 9, 14, 18 with extensions of protection into several countries worldwide, *inter alia* into the European Union, Japan, New Zealand, United Kingdom, United States, Mexico, Republic of Korea, Singapore.
- Chinese Trademark No. 20855718, FEDELI, filed on August 3, 2016, registered on September 28, 2017 in Class 40.

The disputed domain name <thefedelioutlet.com> was registered on December 7, 2021 and resolves an active website, where garments are being offered (Annex 6 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant contends that all three requirements stated in paragraph 4(a) of the Policy are met in the present case.

The Complainant submits that the disputed domain name is confusingly similar to the registered trademarks, namely FEDELI, in which the Complainant has rights. The disputed domain name incorporates the Complainant's trademarks as well as its business name in its entirety. The Complainant further claims, that the Respondent is using the figurative marks of the Complainant's registered trademarks on the website available under the disputed domain name.

The Complainant claims that FEDELI is a famous luxury knitwear company, active since 1934. It further argues that the Respondent has no rights or legitimate interest in respect of the disputed domain name. The Respondent, which appears to be a Chinese individual, has neither acquired a license nor has received authorization of any sort from the Complainant to use the FEDELI mark as a trademark or to include it in a domain name.

The Complainant further contends that the website available under the disputed domain name resembles the Complainant's own main website <fedelicashmere.com> imitating its look and feel by using the figurative marks of the Complainant's trademarks. The Respondent's website additionally contains a description which includes, according to the Complainant, the sentences: "Fedeli [...] the king of fashion in cashmere industry. Its products are 100 % made in Italy. [...] With years of experience.[...]" (Annexes 6 and 8 to the Complaint). The Complainant submits that the disputed domain name was registered and is being used in bad faith.

The purpose of using the disputed domain name can only be, according to the Complainant, that the Respondent is pretending to be an outlet connected to the Complainant, with the clear intention of misleading consumers for a commercial purpose.

According to the Complainant, the Respondent is making use of the disputed domain name for commercial gain, namely to sell garments making consumers believe to be an outlet offering original products of the Complainant at a reduced price. Moreover, the Respondent acts with the purpose of disrupting the Complainant's business.

The Complainant concludes, that the Respondent registered and used the disputed domain name because it's identical by including the FEDELI trademark and, thus, creates an implied risk of confusion. It intentionally pretends a non-existent relationship with the Complainant in order to mislead and attract consumers. This is, in particular, the case, as the website under the disputed domain name imitates the look and feel of the Complainant's website available under <fedelicashmere.com> (Annexes 6 and 8 to the Complaint).

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4 (a) of the Policy, the Complainant must prove that each of the following three elements is present:

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

In the following, the Panel will discuss in consecutive order whether each of these requirements are met.

A. Identical or Confusingly Similar

The test of identity or confusing similarity under the Policy, paragraph 4(a)(i) is limited in scope to a direct comparison between the Complainant's trademark and the textual string which comprises the disputed domain name.

In this case, the Complainant has demonstrated registered trademark rights in the trademark FEDELI which predate the registration of the disputed domain name.

The disputed domain name consists, in the second level domain, of the trademark FEDELI and differs from the Complainant's trademark by its beginning with "the" and by its ending with "outlet". The Complainant's trademark FEDELI is identically reproduced in its entirety in the disputed domain name. The addition of the non-distinctive article "the" and the term "outlet" within the disputed domain name does not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name (see *Karen Millen Fashions Limited v. Ming Li*, WIPO Case No. [D2013-0362](#), see *Philipp Plein v. OPPP OPPP*, WIPO Case No. [D2015-2377](#)), nor is the descriptive Top-Level-Domain <.com>.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and therefore the first requirement of the Policy has been met.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

However, it is consistent case-law of the UDRP panels that it is sufficient for the Complainant to make a *prima facie* case showing that the Respondent has no rights or legitimate interests in a disputed domain names in order to place the burden of production on the Respondent (see e.g. *Credit Agricole S.A. v. Dick Weisz*, WIPO Case No. [D2010-1683](#); *Champion Innovations, Ltd. V. Udo Dussling* (45FHH), WIPO Case No. [D2005-1094](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#); *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#)).

The Panel notes that with respect to paragraph 4(c)(i) of the Policy, there is no evidence in the record that the Respondent, before any notice of the dispute, used or prepared to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services.

The Panel further notes that with respect to paragraph 4(c)(ii) of the Policy, there is no evidence that indicates that the Respondent has ever been commonly known by the disputed domain name or has acquired trademark rights in a name corresponding to it.

Additionally, with respect to paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent has made, and is making, a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

On the contrary, the disputed domain name resolves to a website almost identical to the main website of the Complainant itself. The evidence in the record shows that the disputed domain name has been used in connection with a website offering online sales of sweaters and other garments products using the figurative trademark FEDELI.

Hence, in view of the Panel, there can be no doubt that the Respondent targeted the FEDELI trademark when registering and using the disputed domain name in order to improperly capitalize on the reputation and goodwill associated with the trademark by confusing Internet users searching for the Complainant's products and luring them to the website under the disputed domain name in order to offer them clothing pretending to be the outlet shop of the Complainant. This conduct is not legitimate and does not give rise to rights or legitimate interests of the Respondent in the disputed domain name.

Moreover, the Complainant has not authorized, licensed or permitted in any other way the Respondent to register or use the disputed domain name or its trademarks.

Therefore, the Panel finds that the Complainant has provided sufficient evidence to hold that it is highly likely that the disputed domain name was used for dishonest purposes incapable of conferring any right or legitimate interest in holding the disputed domain name to the Respondent.

In addition, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 2.5.1. ([WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has satisfied the requirements under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, the Complainant has to establish that the disputed domain name has been registered and is being used in bad faith.

The Panel notes that the disputed domain name was registered after the Complainant's trademarks were registered and accepts that the disputed domain name was chosen by reference to the FEDELI trademark.

Prior knowledge of the Complainant's trademark rights is a further indication for a bad faith registration of the disputed domain name (see *TRS, Quality, Inc v. Privacy Protect*, WIPO Case No. [D2010-0400](#)).

The Panel has no doubt whatsoever that the Respondent knew or should have known of the Complainant's earlier rights to the trademark FEDELI and, thus, that the registration of the disputed domain name would in targeted on the Complainant's rights. This is also evidenced by the circumstance that the Respondent has even used the figurative marks of the Complainant's trademarks FEDELI and the description "Fedeli is known as the king of cashmere industry. Its products are 100 % made in Italy. [...] With years of experience.[...]" under the disputed domain name (Annex 6 to the Complaint).

After all, the disputed domain name resolves to a web shop mirroring the one of the Complainant in content, feel and imagery. According to the undisputed allegations of the Complainant and the evidence submitted by it (Annexes 6 and 8 to the Complaint), the associated website has been used for online sales of products of the Complainant without authorization.

The diversion of Internet users is a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous UDRP panel decisions (see *Louis Dreyfus Trademarks B.V. v. Domain Administrator*; See *Privacy Guardian.org / Geren Wenzhen Gu Mangu Geren*, WIPO Case No. [D2019-0247](#); *Hoffmann-La Roche Inc. v. Samuel Teodorek*, WIPO Case No. [D2007-1814](#); *L'Oréal, Biotherm, Lancôme Parfums et Beauté & Cie v. Unais, Inc*, WIPO Case No. [D2005-0623](#)). Bad faith must be assumed where a Complainant provides ample evidence that the disputed domain name was registered with the sole purpose of making users believe that they were connecting to a website affiliated to the Complainant (see *Louis Dreyfus Trademarks B.V. v. David Rosenberg, Louis Dreyfus Commodities*, WIPO Case No. [D2014-2253](#)).

In view of all the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

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 <thefedelioutlet.com> be cancelled.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: September 20, 2022