

ADMINISTRATIVE PANEL DECISION

Gianni Versace S.r.l v. Andre Machado, Home
Case No. D2022-2986

1. The Parties

Complainant is Gianni Versace S.r.l, Italy, represented by Studio Barbero, Italy.

Respondent is Andre Machado, Home, Brazil.

2. The Domain Name and Registrar

The disputed domain name <versace.cam> is registered with AC Webconnecting N.V. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 12, 2022. On August 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 12, 2022, the Registrar transmitted by email to the Center its verification response confirming that 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 Respondent of the Complaint, and the proceedings commenced on August 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on September 13, 2022.

The Center appointed Fernando Triana as the sole panelist in this matter on September 15, 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

Complainant is one of the leading international fashion companies, as well as a symbol of Italian luxury worldwide. It designs, manufactures, distributes and retails fashion and lifestyle products including haute couture, prêt-à-porter, accessories, jewelry, watches, eyewear, fragrances, and home furnishings.

Complainant owns the trademark VERSACE in the European Union Registration No. 001665439 (word mark), filed on May 18, 2000, registered on September 10, 2001 and duly renewed, in international classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41 and 42; and in other jurisdictions.

Complainant owns over 500 domain names including the trademark VERSACE, such as, <versace.com>, since at least March 25, 1997.

The disputed domain name was registered on February 28, 2022 and is currently redirecting to a Registrar parking page.

5. Parties' Contentions

A. Complainant

Complainant owns the trademark VERSACE in the European Union, Brazil, and has International Registrations.

Complainant is one of the leading international fashion companies, as well as a symbol of Italian luxury worldwide, founded in 1978.

Complainant owns over 500 domain names including the trademark VERSACE, such as, <versace.com>, since at least March 25, 1997.

Respondent registered the disputed domain name on February 28, 2022, without authorization of Complainant.

The disputed domain name redirects to a parked website.

Complainant sent several Cease and Desist Letters to Respondent and never received a response.

The disputed domain name is identical to Complainant's trademark.

Respondent is not a licensee, authorized agent of Complainant or in any other way authorized to use Complainant's trademark VERSACE.

VERSACE is a well-known trademark.

Respondent is not commonly known by the disputed domain name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Likewise, paragraph 10(d) of the Rules, provides that “the Panel shall determine the admissibility, relevance, materiality and weight of the evidence”.

The Panel wishes to place special emphasis on the evidence filed to prove assertions, which has been thoroughly studied in order to determine its relevance and weight in arriving at a decision. The statements that have been accompanied by evidence have been given more importance than the mere unsubstantiated assertions.

Paragraph 4(a) of the Policy requires that Complainant prove each of the following three elements to obtain an order that the disputed domain name be cancelled or transferred:

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

This discussion, based on the evidentiary support submitted by Complainant, noting that Respondent did not reply to Complainant’s contentions, will be discussed as follows:

First of all, the Panel will determine whether or not the disputed domain name is identical or confusingly similar to the trademark in which Complainant has rights. Secondly, the Panel will verify if Respondent has any rights or legitimate interests in respect of the disputed domain name; and thirdly, the Panel will establish whether or not the disputed domain name has been registered and is being used in bad faith by Respondent.

A. Identical or Confusingly Similar

Complainant contends to be the owner of the trademark VERSACE in several jurisdictions, since at least 2001 in international classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41 and 42.

a) Existence of a trademark or service mark in which Complainant has rights

Firstly, it is important to point out that paragraph 4(a) of the Policy requires the existence of a trademark or a service mark.

When a sign is registered as a trademark, the owner is granted with an exclusive right over the mark, which entitles him to prevent any third party from using the registered sign or any other sign confusingly similar to it.

In this case, Complainant proved its rights in the trademark VERSACE as per the Annexes 3.

This information appears to be incontestable and conclusive evidence of Complainant’s ownership of the cited trademark and the exclusive right to use them in connection with the stated services.

Thus, Complainant established its rights in the trademark VERSACE.

Therefore, the Panel concludes that Complainant has demonstrated rights in the trademark VERSACE for purposes of Paragraph 4(a)(i) of the Policy.

b) Identity or confusing similarity between the disputed domain name and Complainant's trademark

Complainant alleges that the disputed domain name is identical to the trademark VERSACE.

In the first place, before establishing whether or not the disputed domain name is confusingly similar to Complainant's trademark VERSACE, the Panel wants to point out that the addition of a generic Top-Level Domain ("gTLD"), *i.e.*, ".com," ".biz," ".cam," ".org," or ".net", as in the case, is generally disregarded when determining if the disputed domain name is identical or confusingly similar to the trademark, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.11.1.

Hence, the inclusion of the ".cam" gTLD, in the disputed domain name, is not a factor in analyzing whether a disputed domain name is identical or confusingly similar to the mark in which Complainant asserts rights.

Furthermore, disregarding the ".cam" gTLD, the disputed domain name is identical to the Complainant's VERSACE trademark and thus, the requirement set forth in Paragraph 4(a)(i) of the Policy is duly complied with.

B. Rights or Legitimate Interests

a) Prima facie case

Regarding this second element of Paragraph 4(a) of the Policy, UDRP panels have unanimously found that requiring Complainant to prove the lack of rights or legitimate interests of Respondent in the disputed domain name is often an impossible task: it is not only a negative but also demands access to information that is mostly within the knowledge of Respondent¹.

In *Julian Barnes v. Old Barn Studios Ltd.*, WIPO Case No. [D2001-0121](#), the Panel stated that:

"Is the Respondent required to adduce any such evidence, if the onus is on the Complainant to prove the three elements of paragraph 4 of the Policy? While the overall burden of proof is on the Complainant, this element involves the Complainant proving matters, which are peculiarly within the knowledge of the Respondent. It involves the Complainant in the often impossible task of proving a negative. In the Panel's view the correct approach is as follows: the Complainant makes the allegation and puts forward what he can in support (*e.g.* he has rights to the name, the Respondent has no rights to the name of which he is aware, he has not given any permission to the Respondent). Unless the allegation is manifestly misconceived, the Respondent has a case to answer and that is where paragraph 4(c) of the Policy comes in. If the Respondent then fails to demonstrate his rights or legitimate interests in respect of the Domain Name, the complaint succeeds under this head".

Therefore, a Complainant is required to make a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Once this *prima facie* case is made, the burden of production shifts to Respondent, who must come forward with concrete evidence of its rights or legitimate interests². If Respondent fails to do so, Complainant is deemed to have met the second element of Paragraph 4(a) of the Policy.

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name because of the following: i) Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services; ii) Respondent is not a licensee of Complainant, nor has Respondent been otherwise authorized by Complainant to make any use of its VERSACE trademark, in a domain name or otherwise; and iii) Respondent is not currently making a legitimate noncommercial or fair use of the

¹ See *Arla Foods amba v. Bel Arbor / Domain Admin, PrivacyProtect.org*, WIPO Case No. [D2012-0875](#); see also *F. Hoffmann-La Roche AG v. Bargin Register, Inc. - Client Servs.*, WIPO Case No. [D2012-0474](#).

² See *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

disputed domain name, without intent for commercial gain to misleadingly divert consumers.

The Panel accepts these assertions as a *prima facie* case made by Complainant that shifts the burden of production to Respondent.

b) Respondent's rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy includes a non-limited listing of circumstances that serve to prove Respondent's rights or legitimate interests in a disputed domain name:

(i) before any notice of the dispute, Respondent's use of, or demonstrable 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; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Respondent did not file any Response, thus, failed to rebut Complainant's *prima facie* case, and to show its rights or legitimate interests in the disputed domain name. Hence, as per paragraph 14 of the Rules, the Panel shall draw such inferences therefrom as it considers appropriate:

- Respondent's use of the disputed domain name is not in connection with a *bona fide* offering of goods or services, as it uses a third party's trademark. Consequently, Respondent's use is directed to capitalize on the goodwill of Complainant's VERSACE trademark by attracting Internet users to its disputed domain name.
- There is no evidence within the file proving that Respondent is commonly known by the disputed domain name.
- There is no evidence within the file proving that Complainant licensed or otherwise permitted any use by Respondent of its trademarks.
- There is no evidence within the file justifying the choice of the trademark VERSACE to create the disputed domain name for a *bona fide* purpose.
- There is no evidence within the file proving Respondent's rights over the trademark VERSACE anywhere in the world.
- The disputed domain name is identical to the trademark VERSACE. The nature of the disputed domain name creates a high risk of implied affiliation or association with Complainant (section 2.5.1 of the [WIPO Overview 3.0](#)).

The Panel thus concludes that Respondent lacks rights and legitimate interests in the disputed domain name.

Therefore, the second requirement of paragraph 4(b) of the Policy is met.

C. Registered and Used in Bad Faith

According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of his/her website or location or of a product or service on its website or location.

It is evident to the Panel that Respondent knew of the existence and importance of Complainant's trademark when registering the disputed domain name. It is not a coincidence to include a well-known trademark within a domain name. Indeed, VERSACE is a well-known and famous trademark as has been established before:

"The [VERSACE] Trade Mark is well known and has no other significance than being obviously connected to the Complainant"³.

Moreover, Complainant sent several Cease and Desist letters to Respondent, without receiving a response. Thus, Respondent was aware of the dispute before the filing of the Complaint. Nevertheless, continued with the registration.

The disputed domain name is identical to Complainant's VERSACE trademark and resolves to a Registrar parking page. The Panel finds that the holding and use of the disputed domain name in these circumstances are enough to conclude that Respondent registered and is using the disputed domain name to disrupt Complainant's business and to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement.

Therefore, the three elements of the Policy 4(a)(iii) are satisfied in the present case in respect to Respondent of the disputed domain name.

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 <versace.cam> be transferred to Complainant.

/Fernando Triana, Esq./

Fernando Triana, Esq.

Sole Panelist

Date: September 29, 2022

³ *Gianni Versace S.r.l. v. Xiulin Wang aka Wangxiulin*, WIPO Case No. [D2020-0539](#).