

ADMINISTRATIVE PANEL DECISION

Fiorucci Holdings Limited v. Carolina Rodrigues, Fundacion Comercio Electronico

Case No. D2022-4820

1. The Parties

The Complainant is Fiorucci Holdings Limited, United Kingdom, represented by Bird & Bird LLP, United Kingdom.

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <fiorucciinternational.com> (the “Disputed Domain Name”) 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 15, 2022. On December 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 16, 2023, 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 (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 19, 2022, 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 amended Complaint on December 22, 2022.

The Center verified that the Complaint together with the amended 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 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 27, 2023.

The Center appointed Mariya Koval as the sole panelist in this matter on February 13, 2023. 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, founded in 1967, is an Italian fashion brand headquartered in London, United Kingdom. The Complainant's product range includes clothing, footwear, and accessories with widespread coverage both online and in well-known fashion publications including Vogue, Wonderland, Tatler, and Harper's Bazaar. In addition to its flagship London store, the Complainant's goods are sold worldwide through various retailers in the United Kingdom, United States of America ("United States"), France, Japan, Taiwan, Province of China, Kuwait, and Bahrain. The Complainant's goods are also sold through major online retailers including Asos.com, Zalando.com, and Endclothing.com.

The Complainant owns an extensive international portfolio of trademark registrations for FIORUCCI (the FIORUCCI Trademark), in over 80 jurisdictions, including the following:

- United Kingdom Trademark No. 1119863, registered on August 30, 1979;
- United States Registration No. 1264655, registered on January 24, 1984;
- European Union Trade Mark No. 14755573, registered on March, 31, 2020;
- European Union Trade Mark No. 367250, registered on February 20, 2001.

The Complainant has a significant online presence, operating, among others, the main domain name <fiorucci.com>, which resolves to the Complainant's website, through which the Complainant operates an online store that sells and offers its authentic FIORUCCI branded products.

The Disputed Domain Name was registered on April 14, 2022. As at the date of this decision, the Disputed Domain Name resolves to an inactive website. However, according to the evidence presented by the Complainant (Annexes 6-10 to the Complaint), the Disputed Domain Name previously resolved either to a parked page with different pay-per-click ("PPC") links to third party websites with clothing and accessories, and, among others, with pornographic content; or to the Respondent's website which is a parked page displaying links to the websites of the Complainant's competitors.

5. Parties' Contentions

A. Complainant

The Complainant asserts that it is the owner of an extensive international portfolio of FIORUCCI Trademark registrations worldwide, which is registered in respect of a range of goods and services, including in relation to clothing, footwear and headwear and the retail sale of these goods. The Complainant enjoys significant goodwill and reputation in its FIORUCCI Trademark, the goodwill associated with the Trademark is proprietary to the Complainant and cannot pass to any third party without a formal assignment.

The Complainant further claims that the Disputed Domain Name is confusingly similar to the FIORUCCI Trademark in which the Complainant has rights and clearly intended to imitate and take advantage of the FIORUCCI Trademark. The Disputed Domain Name reproduces the FIORUCCI Trademark in its entirety with addition of the descriptive term "international". The high degree of similarity between the Disputed Domain Name and the FIORUCCI Trademark makes it clear that the Respondent's intention is to associate itself with the FIORUCCI Trademark and its goodwill and reputation.

The Complainant also claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name in view of the following:

- to the best of the Complainant's knowledge, the Respondent is not known by the Disputed Domain Name, nor does it hold any intellectual property rights in the FIORUCCI Trademark;
- the Complainant has not authorised, licensed, approved or otherwise permitted the Respondent to register or use the Disputed Domain Name, the FIORUCCI Trademark, or to operate the Respondent's website in any capacity;
- it is clear that the Respondent is not currently making legitimate or fair use of the Disputed Domain Name. As outlined above, the Disputed Domain Name seemingly at random either a) redirects internet users via multiple websites to an unrelated third party website or b) resolves to the Respondent's website which is a parked page with links to third party websites offering the same goods/services as the Complainant. None of these uses of the Disputed Domain Name can be considered legitimate or fair use;
- the use of the Disputed Domain Name as an apparently dangerous domain name which redirects via multiple domain names to seemingly random third party websites, does not amount to legitimate or fair use of the Disputed Domain Name;
- the Respondent's use of the Disputed Domain Name to redirect consumers away from the Complainant's website, to websites of the Complainant's competitors, is not legitimate or fair use.

The Complainant contends that the Respondent registered and is using the Disputed Domain Name in bad faith based on the following:

- the Respondent was using the Disputed Domain Name in two ways, namely a) to redirect Internet users via multiple domain names to seemingly random third party websites, including websites hosting pornographic content and an adult dating site; and b) to resolve to the Respondent's website which is a parked page displaying links to the websites of the Complainant's competitors;
- in view of the Complainant's strong reputation in the FIORUCCI Trademark and its distinctiveness which is replicated in its entirety in the Disputed Domain Name, the Respondent must have been aware of the Complainant's reputation when it registered the Disputed Domain Name. As a result, the use of the Disputed Domain Name to redirect via multiple websites to apparently random third party websites is strongly indicative that the Respondent was using the Disputed Domain Name in bad faith;
- the Respondent was taking advantage of Internet users seeking the Complainant's international website and redirecting them to unpredictable content which could be (and has been) malicious or pornographic, as well as apparently harmless. The Complainant submits that this is not a normal use of the Disputed Domain Name and suggests that the Respondent is engaged in some form of illegal activity such as phishing or distributing malware;
- the Respondent has used the Disputed Domain Name to redirect Internet users on at least one occasion to a website hosting pornographic content. The use of the FIORUCCI Trademark in the Disputed Domain Name is seriously detrimental to the Complainant's reputation, as it creates a risk that members of the public may be deceived into believing that there is some kind of association between the Respondent's website and the Complainant's business, or that the Complainant has authorised or endorsed the use of its FIORUCCI Trademark in relation to a website hosting pornographic content. The same applies to the use of the Disputed Domain Name to redirect to the adult dating website;
- given the strong reputation of the FIORUCCI Trademark, the Respondent must have been aware that in registering the Disputed Domain Name and using this to redirect consumers to third party websites offering identical goods and services to those protected under the Trademark, it was misappropriating the valuable intellectual property of the Complainant, being the true owner of the FIORUCCI Trademark;

- it is very likely that the PPC links to third party websites generated profit for the Respondent; and that the Respondent had control over the content appearing on the Respondent's website;
- the Respondent's use of the Disputed Domain Name could cause initial interest confusion because a user of the Respondent's website will, based on the Disputed Domain Name alone, be visiting the Respondent's website with the intention of visiting the Complainant's website or a separate website operated, authorised or otherwise endorsed by the Complainant, selling the Complainant's genuine products bearing the FIORUCCI Trademark;
- the Respondent's registration of the Disputed Domain Name has also prevented the Complainant from registering a domain name which corresponds with the FIORUCCI Trademark;
- the Respondent is engaged in a pattern of bad faith conduct. There are over 330 decisions in which the Respondent is identified as the respondent party (Annex 12 to the Complaint).

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

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

A. Identical or Confusingly Similar

The Complainant has properly asserted its rights in the FIORUCCI Trademark due to the long use and numerous registrations worldwide.

The Disputed Domain Name completely reproduces the Complainant's FIORUCCI Trademark in combination with the term "international" and the generic Top-Level Domain ("gTLD") ".com". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, 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. In this case, the addition of the term "international" to the FIORUCCI Trademark does not prevent a finding of confusing similarity and does not change the overall impression of the Disputed Domain Name as being confusingly similar to the Complainant's Trademark.

Also, pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

It is also well established that the gTLD, in this case ".com", is viewed as a standard registration requirement and as such is typically disregarded under the first element confusingly similarity test. See, [WIPO Overview 3.0](#), section 1.11.1.

Therefore, the Panel finds that the Disputed Domain Name is confusingly similar to the FIORUCCI Trademark in which the Complainant has rights. Accordingly, the Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

In accordance with section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is generally deemed to have satisfied the second element.

The Panel finds that the Complainant has made out a *prima facie* case, clearly contending that it has never licensed or authorized the Respondent to use its FIORUCCI Trademark in the Disputed Domain Name or in any other manner. Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name.

Further, the Panel accepts that the way of use of the Disputed Domain Name indicates clear bad faith registration and use. Namely at the date of the Complaint (Annexes 6-10 to the Complaint) the Disputed Domain Name resolved to websites containing PPC links that redirected to different websites, including competitive with the Complainant, and including websites hosting pornographic content and an adult dating site. Such a dynamic redirect through the confusingly similar Disputed Domain Name hardly amounts to a *bona fide* offering, particularly given the potential for commercial gain for the Respondent via the increased Internet traffic to sites that include sponsored PPC links.

Moreover, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. Therefore, the addition of the term “international”, which is descriptive for the Complainant’s manner of business, to the Complainant’s FIORUCCI Trademark in the Disputed Domain Name, is further evidence, that the Respondent was very well aware of the Complainant’s FIORUCCI Trademark and business at the time of registration of the Disputed Domain Name and has done so for the only purpose of creating an impression that the Disputed Domain Name is connected with the Complainant’s FIORUCCI Trademark.

There is no evidence that the Respondent is commonly known by the Disputed Domain Name or any similar name. Moreover, the Respondent is, as the Complainant asserts (Annex 12 to the Complaint), a serial cybersquatter (*i.e.*, an individual who intentionally registers and uses domain names in bad faith for a commercial purpose). The Panel has no reason to believe that this case is anything other than another case in large number of cases brought against the Respondent in respect of the unauthorized use for commercial purposes of well-known trademarks.

The Respondent did not file any response to the Complaint and did not participate in this proceeding, respectively, the Respondent did not present any evidence for supporting any rights or legitimate interests in the Disputed Domain Name.

In view of the foregoing, the Panel finds that the Respondent lacks rights or legitimate interests in the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that indicate bad faith conduct on the part of the respondent, namely:

- (i) circumstances indicating that the respondent has registered or has acquired the disputed 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 the respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the respondent has registered the disputed 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 the respondent has engaged in a pattern of such conduct; or

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

(iv) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's 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 the respondent's website or location or of a product or service on the respondent's website or location.

The FIORUCCI Trademark has been in use more than 40 years before the Disputed Domain Name was registered and that the Complainant has actively promoted its Trademark all these years. Furthermore, the Complainant's FIORUCCI Trademark is original and highly distinctive, and it is obvious that the Respondent could not have registered the Disputed Domain Name, which incorporates the Complainant's FIORUCCI Trademark in its entirety, accidentally. Therefore, the Panel is of opinion that the Respondent was likely well aware of the Complainant's FIORUCCI Trademark when it registered the Disputed Domain Name and obviously chose to register the Disputed Domain Name with the only intention to benefit from the Complainant's reputation.

The Panel also concludes that addition of the term "international" to the FIORUCCI Trademark does not change an impression of strong association of the Disputed Domain Name with the Complainant's FIORUCCI Trademark, but on the contrary, taking into consideration that the Complainant has an active business activity worldwide, even strengthens such association.

In accordance with the [WIPO Overview 3.0](#), section 3.4, UDRP panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution (in some such cases, the respondent may host a copycat version of the complainant's website). Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers. Based on the evidence provided with the Complaint, the Panel finds that the website related to the Disputed Domain Name was previously being used in bad faith. The Disputed Domain Name previously resolved to websites containing PPC links that redirected to different websites, including competitive with the Complainant, and including websites hosting pornographic content and an adult dating site. Such the Respondent's behavior cannot be in any way considered as a good faith.

As regards the current inactive website hosted at the Disputed Domain Name, such passive holding of the Disputed Domain Name does not prevent a finding of bad faith, given the totality of the circumstances present here. [WIPO Overview 3.0](#), section 3.3.

Also, the Panel has found that the Respondent is a serial cybersquatter and that this case is part of that pattern.

According to section 3.6 of the [WIPO Overview 3.0](#), there are recognized legitimate uses of privacy and proxy registration services; the circumstances in which such services are used, including whether the respondent is operating a commercial and trademark-abusive website, can however impact a panel's assessment of bad faith. The Panel considers that, taking into account all circumstances of this case and the fact that the Respondent is a cybersquatter, in this case the Panel considers that the Respondent's use of privacy service constitutes an inference of bad faith registration and use of the Disputed Domain Name.

Finally, the Respondent, not participating in the proceeding, has failed to indicate any facts and/or evidence, which would show the good faith registration or use of the Disputed Domain Names. See *e.g. The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. [D2009-0610](#): “the failure of the Respondent to respond to the Complaint further supports an inference of bad faith.”

In view of the foregoing, the Panel finds that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, 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 <fiorucciinternational.com> be transferred to the Complainant.

/Mariya Koval/

Mariya Koval

Sole Panelist

Date: February 27, 2023