

ADMINISTRATIVE PANEL DECISION

Prada S.A. v. Client Care, Web Commerce Communications Limited
Case No. D2023-4007

1. The Parties

The Complainant is Prada S.A., Luxembourg, represented by Studio Barbero, Italy.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <miumiu-danmark.com>, <miumiu-greece.com>, <miumiu-ireland.com>, <miumiu-philippines.com>, and <miumiu-suomi.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 26, 2023. On September 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 28, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Not Disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 28, 2023, 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 amendment to the Complaint on the same day.

The Center verified that the Complaint together with the amendment 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 October 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 3, 2023.

The Center appointed Meera Chature Sankhari as the sole panelist in this matter on November 20, 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 is the owner of trademark registrations for MIU MIU (word mark) and (device) in multiple jurisdictions. The earliest trademark registration, being International Trademark Registration No. 593101 for MIU-MIU (word) in classes 18 and 25 registered as early as the year 1992, followed by the others including the International Trademark Registration No. 686197 for MIU MIU (device) in classes 03, 09, 14, 16, 18, 25, 34, and 42; for MIU MIU (word) in classes 18 and 25 bearing Registration No. 004253191 and MIU MIU (device) in classes 3, 26, and 35 bearing Registration No. 009002734 in the European Union; Malaysian Trademark Registration No. 9300024 for MIU MIU (device) in class 25, etc.

The Complainant owns over 120 domain names consisting of or comprising the trademark MIU MIU under several different Top-Level Domains ("TLDs") including, *inter alia*, <miumiu.com>, which was registered on November 9, 1997.

The Respondent registered the disputed domain names on February 2, 2023, with the same Registrar, i.e., Alibaba.com Singapore E-Commerce Private Limited.

The Complainant, through their representative, sent a cease and desist letter on September 11, 2023, to the Respondent, demanding that the Respondent cease any use of the disputed domain names and transfer them to Complainant. The said letter was sent to the abuse e-mail address of the Registrar, with a request to forward it to the Respondent, as the Registrant online contact form did not work. A reminder was on September 21, 2023, but the Respondent did respond. On September 11, 2023, Complainant's representative also sent cease and desist letters to the hosting providers of the websites published at the disputed domain names, requesting the deactivation of the websites. A reminder was sent on September 21, 2023, but no response was received from the Respondent.

5. Parties' Contentions

A. Complainant

The Complainant claims that in the year 1913, Mario Prada opened a luxury store in the Galleria Vittorio Emanuele II in Milan, selling leather handbags, travelling trunks, leather accessories and beauty cases, luxury accessories and articles of value. The Complainant claims that over the years, the Prada name gained increasing renown and prestige and in 1919 PRADA became an official supplier to the Italian Royal family. From 1986, new stores were opened in New York and Madrid, followed by London, Paris, and Tokyo.

In 1993 a new brand — Miu Miu — was launched, which was designed for women, which now offers women's ready-to-wear, leather goods, and shoes. In 2003, Prada entered into a licensing agreement with Italian eyewear manufacturer Luxottica, that currently produces eyewear for the Prada and Miu Miu brands. In 2015, the Prada Group and Coty Inc. launched the first Miu Miu fragrance. In 2019, Prada entered into a collaboration with the Chinese online luxury platform, Seeco, offering for sale Prada and Miu Miu products. The following year, Miu Miu launched an upcycled collection. In 2022, the Miu Miu brand was awarded "Brand of the Year" by Lyst.

The Complainant claims to have developed a strong network of Directly Operated Stores encompassing Europe (229), the Americas (107), Japan (85), Middle East, and Africa (22) and Asia Pacific (198). The Complainant claims to operate in 70 countries today with approximately 13,988 employees.

The Complainant claims to have promoted and advertised the mark MIU MIU worldwide and extensively, including in the online magazines and newspapers such as, *inter alia*, Vogue, Elle, Grazia Magazine, and New York Times. The Complainant launched the Prada e-store was launched in 2010, while the Miu Miu e-store went online in 2011.

Owing to such substantial investments in advertising, marketing and sales worldwide, coupled with its consistent use of the trademark MIU MIU for decades, the Complainant claims that the mark MIU MIU is a well-known trademark worldwide.

The Complainant alleges that the disputed domain names are confusingly similar to the registered trademark MIU MIU, in which the Complainant has rights as they use the entirety of the Complainant's trademarks.

The Complainant claims that the Respondent did not intend to use the disputed domain names in connection with any legitimate purpose. On the contrary, according to the Complainant, the Respondent's use cannot be considered a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain, because the Respondent has been undoubtedly attempting to gain from the offer for sale of the products advertised on their websites, at very low prices.

Further, the Complainant claims that the Respondent has used the disputed domain names to resolve users to websites featuring the Complainant's trademarks, publishing images of the Complainant's advertising campaigns and is offering for sale purported MIU MIU products at discounted prices, without providing any disclaimer as to the Respondent's lack of relationship with Complainant. The Complainant claims that such use of the disputed domain names is likely to confuse and mislead Internet users into believing that the websites are operated by the Complainant or by an affiliated entity with the Complainant's consent. goods are offered. The Complainant further claims that the copyright lines read "Copyright © 2023" followed by the different disputed domain names, thus clearly generating the impression to be visiting official MIU MIU websites. The Complainant further states that no information about the name and identity of the person or entity operating the websites is provided. In addition, the prices at which products are offered for sale on the Respondent's websites are much cheaper than the prices applied to the MIU MIU products sold by Complainant.

Based on the aforementioned conduct of the Respondent, coupled with the lack of response to the Complainant's cease and desist notice, the Complainant alleges that the Respondent must have been aware of the Complainant and its globally reputed trademarks, which it used for registering the disputed domain names with the ulterior motive of gaining unlawful profits, in bad faith.

Based on the aforementioned grounds, the Complainant seeks transfer of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

To transfer the disputed domain names from the Respondent, the Complainant must prove the following elements as per paragraph 4(a) of the Policy:

- (i) that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

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

Further, since the Respondent has not submitted its response in the case at hand, this Panel finds it appropriate case to “decide the dispute based upon the complaint” as per paragraph 5(f) of the Rules read with paragraphs 14(a) and 14 (b) of the Rules.

Having considered the Complainant’s case and the evidence available, the Panel finds as follows.

6.1 Preliminary Considerations – Consolidation and Language of the Proceedings

In its Complaint, the Complainant requested the consolidation of the Complaint against all five disputed domain names, arguing common control. Further, the Complainant requested that language of the proceedings to be English.

In its amendment to the Complaint, the Complainant amended the Complaint to reflect the single Respondent disclosed by the Registrar. The amendment did not address the language of the proceedings.

For completeness, the Panel notes that since the Registrar has disclosed that the Respondent’s registration agreement was in English, and in view of the Complainant’s corresponding request, the Panel will proceed with its Decision in English. As regards consolidation, given the Registrar’s disclosure of the Respondent, it is evident that all disputed domain names are subject to common control and consolidation is proper.

A. Identical or Confusingly Similar

The Complainant owns registered trademarks for MIU MIU (word) and (device) as well as more than 100 domain names, with “miumiu” and “miu-miu”, including <miumiu.com>, <miu-miu.com>. The disputed domain names consist of the MIU MIU mark, which forms a significant part of it.

Per section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), “where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing”.

The addition of the terms such as, in this case “-danmark”, “-greece”, “-ireland”, “-philippines” and “-soumi” do not prevent a finding of confusing similarity between the disputed domain names and the Complainant’s trademark MIU-MIU, per section 1.8 of the [WIPO Overview 3.0](#).

Per section 1.11.1 of the [WIPO Overview 3.0](#), the applicable TLD in a domain name (here, “.com”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Given the above, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s trademark MIU MIU and with that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has established statutory rights in and to its trademarks MIU MIU and MIU-MIU. The Complainant has further affirmed that it has not granted any license or authorization to the Respondent to use its trademark MIU MIU and/or MIU-MIU, nor is it affiliated with the Respondent. There is no evidence before the Panel to suggest that the Respondent is commonly known by either of the disputed domain names. Rather, the disputed domain names are composed of the Complainant’s fanciful trademark and,

as analyzed further below, it is clear that the Respondent sought to mislead unsuspecting Internet users expecting to find websites authorized by or affiliated with the Complainant, contrary to the fact.

The Panel finds that a *prima facie* case is made by the Complainant, pursuant to which, the burden of production shifts to the Respondent to come forward with an appropriate allegations and relevant evidence demonstrating rights or legitimate interests in the disputed domain names.

The Respondent has failed to demonstrate any rights or legitimate interests over the word “miu miu” or the disputed domain names as per paragraph 4(c) of the Policy.

See: *Deutsche Lufthansa AG v. Mustermann Max, Muster AG*, WIPO Case No. [D2015-1320](#); *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. [D2006-1095](#); *Legacy Health System v. Nijat Hassanov*, WIPO Case No. [D2008-1708](#)).

In addition, the Complainant has demonstrated that the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use but instead for illegal activities. The disputed domain names resolve Internet users to websites, which in all likelihood are offering counterfeit goods bearing the Complainant’s MIU MIU and MIU-MIU fanciful trademarks, which is further corroborated by the fact that:

- i) the goods on the disputed domain names are offered at disproportionately below the market value.
- ii) the Respondent has misappropriated the copyrighted images from the Complainant’s website.

As per section 2.13 of [WIPO Overview 3.0](#), the use of the domain name for illegal activity, including phishing or other types of fraud can never confer rights or legitimate interests on a respondent, which is particularly true in the case of counterfeits and pharmaceuticals. Even if the goods offered at the disputed domain names were genuine, the disputed domain names would not qualify as fair use under the criteria enumerated under section 2.8 of the [WIPO Overview 3.0](#) (the “Ok! Data test”), in view of the fact that the disputed domain names do not contain any clarifying statement as to their lack of relationship with the Complainant.

For all of the reasons stated above, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

The Panel has no difficulty in finding that the disputed domain names were registered in *bad faith* for the following reasons:

- a) it is inconceivable that the Respondent could not have known of the Complainant’s well-recognized and distinctive trademarks MIU MIU and MIU-MIU.
- b) the Respondent most likely had knowledge of the Complainant’s rights in the trademarks MIU MIU and MIU-MIU, which is further established by a pattern of abusive registrations containing such trademark secured by the Respondent and the use to which these disputed domain names have been put.
- c) a pattern of abuse is clear from the fact that the Respondent has registered multiple trademark-abusive domain names corresponding to the third party marks that have been subject to UDRP decisions against the Respondent (see, e.g., *Prada S.A. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-4002](#), *Babolat VS v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-3362](#)).
- d) there are other circumstances, such as offering the Complainant’s goods for a fraction of the original cost and the misappropriation of the copyrighted images from the Complainant’s website, all of which indicate that the Respondent’s intent in registering the disputed domain names was in fact to profit from or otherwise exploit the Complainant’s trademark.

[WIPO Overview 3.0](#), section 3.1.4 states that “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith”. See also [WIPO Overview 3.0](#), Section 3.1.1 read with Section 3.1.2.

The Panel confirms that paragraph 4(b)(iv) is fulfilled and that the Respondent has registered and used the disputed domain names 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 names, <miumiu-danmark.com>, <miumiu-greece.com>, <miumiu-ireland.com>, <miumiu-philippines.com>, and <miumiu-suomi.com> be transferred to the Complainant.

/Meera Chature Sankhari/

Meera Chature Sankhari

Sole Panelist

Date: December 6, 2023