

ADMINISTRATIVE PANEL DECISION

Prada S.A. v. 王晓文 (wang xiao wen)

Case No. D2024-0118

1. The Parties

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

The Respondent is 王晓文 (wang xiao wen), China.

2. The Domain Name and Registrar

The disputed domain name <miumibeauty.com> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on January 12, 2024. On January 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 15, 2024, 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 (Not Disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 15, 2024, 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 in English on January 15, 2024.

On January 15, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On January 15, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Chinese of the Complaint, and the proceedings commenced on January 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 12, 2024.

The Center appointed Jonathan Agmon as the sole panelist in this matter on February 15, 2024. 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 was founded in 1913 in Milan, selling leather handbags, travelling trunks, leather accessories and beauty cases, luxury accessories and articles of value. The Complainant has since expanded and now operates in 70 countries and has over 13,700 employees selling luxury handbags, fashion, shoes, and accessories. It has some 615 stores worldwide. In China, where the Respondent is based, the Complainant has a strong presence including retail stores located in Beijing, Chengdu, Dalian, Guangzhou, Hangzhou, Harbin, Qingdao, Shanghai, Shenyang, Shenzhen, Tianjin, Wenzhou and Xi'an.

The Complainant launched its MIU MIU brand in 1993 and has been selling fashion-related goods under this brand ever since. Over the years, numerous press publications were dedicated to the Complainant's MIU MIU brand in China. In addition, the trademark MIU MIU was and presently is supported by intensive advertising campaigns worldwide, including China, with campaigns appearing in online magazines and newspapers such as, inter alia, Vogue, Elle, Grazia Magazine, New York Times, and Beijing Lifestyle.

The Prada e-store was launched in 2010 while the Miu Miu e-store went online in 2011.

The Complainant is the owner of various MIU MIU trademarks worldwide, including the following:

- European Union trademark registration No. 004253191 for MIU MIU, registered on February 16, 2006;
- European Union trademark registration No. 009002734 for MIU MIU (stylized), registered on August 24, 2010;
- International trademark registration No. 593101 for MIU-MIU, registered on October 16, 1992;
- International trademark registration No. 686197 for MIU MIU (stylized), registered on December 2, 1997;
- China trademark registration No. 11645338 for MIU MIU, registered on April 28, 2014;
- China trademark registration No. 11645339 for MIU MIU, registered on March 28, 2014.

The Complainant and its related entities registered over 120 domain names consisting of or comprising the words "Miu Miu" under several different Top-Level Domains ("TLDs"), including its main domain name <miumiu.com> and its Chinese domain name <miumiu.cn>, registered on November 9, 1997, and March 29, 2004 respectively.

The Respondent registered the disputed domain name on December 10, 2020, and it currently resolves to a parking page where it is being offered for sale.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- 1) The disputed domain name is confusingly similar to the MIU MIU trademark in which the Complainant has rights. The disputed domain name incorporates the entirety of the Complainant's MIU MIU trademark with the addition of the non-distinctive suffix "beauty" to the Complainant's trademark. The disputed domain name is therefore confusingly similar to the Complainant's MIU MIU trademark.
- 2) The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not commonly known by the name "Miu Miu". The Complainant has not licensed, authorized, the Respondent to use the Complainant's MIU MIU trademark in anyway, including registering the disputed domain name. The Respondent is also not an authorized reseller of the Complainant. The Respondent is not utilizing the disputed domain name with any bona fide offering of goods and/or services, and the disputed domain name serves to divert Internet traffic away from the Complainant's own webpage or to tarnish the Complainant's trademark. Further, the Respondent is attempting to sell the disputed domain name.
- 3) The disputed domain name was registered and is being used in bad faith. The Complainant's trademark has been registered for years and predates the registration of the disputed domain name. Given the publicity, fame, and goodwill of the Complainant's trademark, it is inconceivable that the Respondent was unaware of the Complainant's trademark before registering the disputed domain name. Further, the disputed domain name is being offered for sale, which is an indication of bad faith. In addition, the Respondent is also intentionally attempting to attract users to its website for commercial gain, by creating confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its website. The Respondent has also failed to reply to the Complainant's numerous cease and desist letters, which is an indication of bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, though it is not seeking to gain any unfair advantage over the Respondent, including the fact that:

- (i) The disputed domain name contains words in Latin characters.
- (ii) The disputed domain name encompasses the English word "beauty".

- (iii) The disputed domain name contains the TLD “.com”, which reveals the Respondent’s intention to target an audience of English-speaking users.
- (iv) The disputed domain name resolves to a webpage entirely drafted in English (the Panel notes while the webpage was mostly drafted in English, there are some Chinese characters as well), which is evidence of the Respondent’s intention to target an audience of English-speaking users and his ability to communicate in English.
- (v) The Complainant communicates in English and would be prejudiced, if it were required to translate the Complaint and participate in this proceeding in Chinese. Requiring the Complainant to translate the Complaint and all documents into Chinese would cause delay and added expense of translating these pleadings if the Respondent fails to participate in the dispute process. It would also be inefficient to hold the proceedings in any other language than English.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of a term “beauty”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or

legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

There is no evidence that the Respondent is commonly known by the disputed domain name. The Respondent was not authorized by the Complainant to use the latter's MIU MIU trademark or to register a domain name incorporating the trademark. There is no evidence that the Respondent uses the disputed domain name for a legitimate noncommercial or fair use, without intent for commercial gain. The disputed domain name resolves to a parked webpage where it is being offered for sale stating that "The purchase cost of domain name is one-time, but your benefits is permanent" which leads the Panel to conclude that the price is likely to be in excess of the Respondent's out-of-pocket registration costs. Such activity, in and of itself does not confer rights or legitimate interests in the disputed domain name in the circumstances of this case. Further, the fact that the Respondent did not respond to the Complainant's cease and desist letter is indicative that he does not have any rights or legitimate interests in the disputed domain name.

In this case, given the Complainant's reputation in the well-known MIU MIU trademark, the Panel also finds that the use of the additional word "beauty" in the disputed domain name effectively impersonates or suggests sponsorship or endorsement by the Complainant. Such finding further leads to the conclusion that the Respondent could not have accumulated any rights or legitimate interests in the disputed domain name in the circumstances of this case. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The disputed domain name incorporates the entirety of the Complainant's well-known MIU MIU mark with the addition of the term "beauty", and it has been used for a parked webpage containing an advertisement for the sale of the disputed domain name. Given the notoriety of the Complainant's MIU MIU mark the Panel finds that in all likelihood, the Respondent was aware of the Complainant and its MIU MIU mark when it applied for and the use of the disputed domain name.

The Complainant's evidence shows that it is more likely than not that the Respondent has acquired the disputed domain name primarily for the purpose of selling the disputed domain name registration to the Complainant or its competitors for commercial gain through attracting Internet users to its website by creating a likelihood of confusion with the Complainant's well-known mark. Given the evidence provided by the Complainant the Panel finds that the Respondent is trying to capitalize on the Complainant's significant good will in the MIU MIU mark.

The Respondent did not file a response nor explain its choice of the disputed domain name. The fact that the Respondent has ignored the Complainant's cease and desist letter and various reminders is strong evidence that the disputed domain name was registered and is being used in bad faith. Accordingly, the Panel draws an adverse inference which leads to its conclusion that the disputed domain name was registered and is being used in bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element 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 disputed domain name <miumibeauty.com> be transferred to the Complainant.

/Jonathan Agmon/

Jonathan Agmon

Sole Panelist

Date: February 29, 2024