Panel Decision for dispute CAC-ADREU-006236

Case number	CAC-ADREU-006236
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Domain names	fendisitoufficiale.eu

Case administrator

Tereza Bartošková (Case admin)

Complainant

Organization	Fendi Adele S.r.l.

Respondent

Name	wu liuquing

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is unaware of any other legal proceeding pending or decided relating the disputed domain name.

FACTUAL BACKGROUND

The Complainant is the owner of one of the most famous brands in Italian fashion industry, FENDI, with worldwide reputation and several word and/or device registered trademarks across the world comprising Europe.
The Respondent registered the FENDISITOUFFICIALE.EU domain name on the 21, September 2011.

On 15 February 2012 the Complainant filed its Complaint with the Czech Arbitration Court, alleging the presence of all the requirements set forth by Section B paragraph 1 (B) (10) (i) a, b and c of the ADR rules and therefore seeking the transfer of the challenged domain name.

On 22 February 2012 the CAC announced the commencement of the ADR proceeding. The Respondent failed to submit any reply and Respondent's default was declared on 24 April 2012.

On 7 May 2012 the appointed panelist Roberto Manno issued a Statement of Acceptance and Declaration of Impartiality.

A. COMPLAINANT

The Complainant is a well-known Italian company active in the business of producing, marketing and selling high-end articles of clothing and accessories. It was launched in 1925 as a fur and leather shop in Rome, but today is a multinational luxury goods brand owned by the fashion group LVMH.

The Complainant provided impressive evidences of the worldwide reputation achieved by the "FENDI" trademark over its 87 years of business life: according to the Complainant the trademark "Fendi" – which enjoys an indisputable reputation – is, consequently, synonymous with and symbolizes the Complainant's reputation and goodwill, which are among the most valuable and important of Complainant's assets.

a) With respect to the first ADR Rules requirement, the domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law.

Indeed, Complainant has sought to protect its rights in and to the trademark "Fendi" and to maintain its exclusivity therein by obtaining, in the European Union, more than 140 registrations for "Fendi" and similar marks since the 1970s. Most of these trademarks cover goods in class 3, 9, 14, 18, 25. Since 1995 Complainant is using the "fendi.com" domain names for e-business and promotional activities.

Respondent's "fendisitoufficiale.eu" domain name is deemed to be confusingly similar to Complainant's "Fendi" trademark, as it consists of the Complainant´s well-known mark plus the very descriptive component "sitoufficiale". The .eu suffix, according to common legal rules in conflicts between domain names and trademarks, is deprived of any weight under the similarity test of the signs.

b) with respect to the second requirement, i.e. the lack of any right or legitimate interest in the domain name, it is Complainant´s submission that the Respondent is out of any title referring the above requirements.

The Respondent has no rights in the domain name, as it does not correspond to a trade mark registered in the name of the Respondent, nor does it correspond to the name of the Respondent itself.

Also, the Respondent is not commonly known as "FENDI". Finally, there is no fair or non-commercial use of the domain name. Indeed, there are clear evidence of the malicious and bad faith conduct, which may be better addressed in the third ADR rules requirement, the

c) The domain name has been registered or is being used in bad faith.

Respondent's registration of "Fendisitoufficiale.eu" obviously confuses potential customers as to the Respondent's affiliation with the Complainant. In fact, the combination of the two words "sito" and "ufficiale" is clearly meant to induce users to believe that the domain name redirects to Complainant's official website.

Furthermore, Respondent's domain name discouraged Internet users from locating Complainant's real official website, thereby diluting the value of Complainant's "Fendi" trademark.

B. RESPONDENT

No Response or other communication has been received on the online ADR Platform from the Respondent in respect of the Complaint.

DISCUSSION AND FINDINGS

It is the Panel´s opinion that all the conditions set forth by art. 21 of Reg. No. 874/2004 are satisfied and consequently the domain name shall be transferred to the Complainant.

a) domain name identical or confusingly similar to Complainant's exclusive rights
According to Art. 21. Reg. No. 874/2004, "A registered domain name shall be subject to revocation […] where that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10."
Complainant provided an impressive set of evidence substantiating its rights in the well-known "FENDI" trademark worldwide, including more than 100 registered trademarks in Europe; worldwide shops using the "FENDI" trademark; and the presence on the Internet since 1995 with the www.fendi.com website.
Compared with the weight (in terms of distinctiveness, reputation) of the FENDI verbal element, the other verbal components of the challenged domain name are very poor and deprived of any differentiating attitude: the suffix "–sitoufficiale" is indeed the Italian translation of "official site". These words have no other purpose than to enhance the exclusivity and authenticity of the website they are referring to, with the result that their distinctive character may not be separated by that of the implicit object of the sentence "this is the official site of …".
This is the implicit reasoning of the decisions referred to by the Complainant in similar case, also involving famous Italian fashion brands: Guccio Gucci S.p.A v. James Madison, Case No. D2011-1324: borseguccisitoufficiale.com, borseguccisitoufficiale.net.

b) Legitimate interest in the name
In the present dispute the Respondent failed to submit any reply and therefore his default has been declared. Complainant denies any kind of authorization, license or agreement giving the Respondent the right to use the FENDI trademark.

The Panel finds that also the requirement set forth by art. 10 of Regulation 874/04 has been fulfilled by the Complainant.

c) The domain name has been registered or is being used in bad faith.
It is the Panel finding that the present case is paradigmatic of bad faith registration and use of a domain name. Under the bad faith test it is possible to investigate the meaning of the verbal component of the domain name other than FENDI, i.e. the suffix "-sitoufficiale", to conclude that these words are clear evidence of the bad faith conduct not exhaustively enlisted by section B, paragraph 11, f) of ADR rules.

In the lack of any right or legitimate interest in using Complainant's trademark, the only reason at the basis of the adoption (since the registration) of the "-sitoufficiale" suffix was indeed to take unfair advantage from FENDI goodwill and reputation.
The use of the challenged domain name confirms these findings: printouts of fendisitoufficiale.eu provided by the Complainant show a number of "Fendi" counterfeited goods. The fact that actually the website has been deleted may not affect the findings and, moreover, it may be regarded as a confirmation of them.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name FENDISITOUFFICIALE be transferred to the Complainant.

PANELISTS

Name	Roberto Manno

DATE OF PANEL DECISION 2012-05-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: fendisitoufficiale.eu

II. Country of the Complainant: Italy, country of the Respondent (as from Eurid Verification): Italy

III. Date of registration of the domain name: 21 September, 2011

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. Italian trademark registration No. 1216848 "Fendi" dating back to December 1, 1976 covering goods in class 3, 18, 24, 25;
2. Community trademark registration No. 3500535 "Fendi" dating back to May 27, 2005

V. Response submitted: NO

VI. Domain name is confusingly similar to the protected right of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Why the Complainant considers the Respondent to lack the rights and legitimate interests: Respondent has no title to use complainant's trademark
2. Rights or legitimate interests the Respondent claims to have: Respondent failed to issue any response
3. Does the Panel consider the Respondent to have no rights or legitimate interests: No rights/legitimate interest

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Why the Complainant considers the Respondent to have registered or use the domain name/s in bad faith: the domain name was registered with the only intention to take unfair advantage of the Complainant´s reputation suggesting the Internet user the false message that the disputed domain names hosted the Complainant's official website.
2. How the Respondent rebuts the statements of the Complainant: no response.
3. Does the Panel consider the Respondent to have registered or use the domain name/s in bad faith: YES

IX. Other substantial facts the Panel considers relevant: meaning of descriptive/fraudulent terms "sitoufficiale"

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant:none.