

## **.hk Domain Name Dispute Resolution** **ARBITRATION PANEL DECISION**

Complainant: Salvatore Ferragamo S.p.A.

Respondent: Duan Zuochun

Case Number: DHK-1200086

Contested Domain Name: <salvatorreferragamo.hk>

Panel Member: Jacques de Werra

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### **1. Parties and Contested Domain Name**

The Complainant is Salvatore Ferragamo S.p.A., of Florence, Italy (“the Complainant”).

The Respondent is Duan Zuochun, China (“the Respondent”).

The domain name at issue is <salvatorreferragamo.hk> (“the Disputed Domain Name”) and was registered by Respondent with Web Commerce Communications Limited, Kuala Lumpur, Malaysia (“the Registrar”).

### **2. Procedural History**

The Complaint was filed with the Hong Kong International Arbitration Center (“HKIAC”) on December 17, 2012. On December 18, 2012, the HKIAC transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 18, 2012, the Registrar transmitted by email to the HKIAC its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The HKIAC verified that the Complaint satisfied the formal requirements of the HKDNR Domain Name Dispute Resolution Policy (the “Policy”), the HKDNR Domain Name Dispute Resolution Policy Rules of Procedure (the “Rules”), and the HKIAC Supplemental Rules (the “Supplemental Rules”).

The HKIAC formally notified the Respondent of the Complaint, and the proceedings commenced on December 24, 2012. Pursuant to art. 5 of the Rules,

the due date for Response was January 17, 2013. No Response was filed with the HKIAC.

The HKIAC appointed Jacques de Werra as the sole panelist in this matter on January 29, 2013.

The Panel determines that its appointment was made in accordance with para. 6 of the Rules and Articles 8 and 9 of the Supplemental Rules.

### **3. Factual Background**

The Complainant is a well-known Italian company engaged in the business of manufacturing and sale of fine footwear, handbags and fashion accessories which was founded in 1927. The Complainant has advertised Complainant's products worldwide particularly in famous fashion magazines.

The Complainant is the owner of many trademarks containing the "SALVATORE FERRAGAMO" words, including the trademarks No 1979B1255 and 1979B1256 registered in Hong Kong on June 16, 1977 for various goods in classes 18 and 25 (hereafter the "Trademark"). Products of the Complainant are sold under the FERRAGAMO Trademark in many countries in the world including in Hong Kong.

The Complainant is also the owner of domain names containing the "FERRAGAMO" word or the Trademark as such, including the top level domain names [www.ferragamo.com](http://www.ferragamo.com), [www.salvatorreferragamo.com](http://www.salvatorreferragamo.com), and the Hong Kong country code the domain name [www.salvatorreferragamo.com.hk](http://www.salvatorreferragamo.com.hk).

The Disputed Domain Name was registered by the Respondent on September 20, 2011. It does not resolve to an active website. On November 15, 2012, the Respondent sent an email to the Complainant offering the Disputed Domain Name for sale for Euro 5000 (together with another domain name that was apparently held by the Respondent which also contained the Ferragamo name, i.e. [www.ferragamo.hk](http://www.ferragamo.hk)), after having received a cease and desist letter from the Complainant's representatives.

### **4. Parties' Contentions**

#### The Complainant

The Complainant's contentions may be summarized as follows:

- i. The Disputed Domain Name reflects the Trademark in its entirety and is thus identical to the Trademark;

- ii. The Respondent has no right or legitimate interest in the Disputed Domain Name because it incorporates the Trademark which is exclusively owned and used by the Complainant and is well-known. The Respondent is not commonly known by the Disputed Domain Name or by a name corresponding to the Trademark and is not engaged in any business or commerce under the Trademark. The Respondent it is not authorized or licensed to use the Trademark and has not been given permission to use the Trademark by the Complainant. The Respondent is not making any legitimate, non-commercial or fair use of the Disputed Domain Name;
- iii. The Respondent registered and uses the Disputed Domain Name in bad faith because it offered it for sale to the Complainant; the registration of the Disputed Domain Name which incorporates the Trademark which is well-known by the Respondent who has no relationship with the Trademark is evidence of bad faith; there can be no doubt that the Respondent was aware of the Trademark when registering the Disputed Domain Name. Furthermore, the Respondent has been the respondent in numerous prior disputes which have been decided against the Respondent.

### The Respondent

The Respondent did not file any response in the proceedings.

## **5. Findings**

According to Paragraph 4a of the HKDNR Domain Name Dispute Resolution Policy (the "Policy") which is applicable hereto, the Complainant has the burden of proving that:

- (i) the Disputed Domain is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and
- (iii) the Disputed Domain has been registered and is being used in bad faith; and
- (iv) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name.

### **(1). Identical/confusing similarity**

The Panel is satisfied that the Complainant has rights to the Trademark in various jurisdictions, including in Hong Kong, and that its marketing efforts have created a strong brand recognition of the Trademark in many countries.

A comparison between the Disputed Domain Name and the Trademark shows that the Disputed Domain Name is identical to the Complainant's Trademark.

As a result, based on the rights of the Complainant in the Trademark and on the identity between the Trademark and the Disputed Domain Name, the Panel finds that the conditions of paragraph 4(a)(i) of the Policy are met.

## **(2). Rights or Legitimate Interests of Respondent**

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the 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.

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, previous panels have consistently ruled that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the domain name, once the Complainant has made a *prima facie* showing. See *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

In the Panel's opinion, the Complainant has made a *prima facie* case against the Respondent. The Respondent indeed registered the Disputed Domain Name which is identical to the Trademark owned by the Complainant.

The Complainant has also alleged (without being contradicted) that the Respondent has no right in the Disputed Domain Name, that he is not authorized or licensed to use the Trademark by the Complainant and that the Respondent has not been commonly known by the Disputed Domain Name.

The Panel thus accepts the Complainant's *prima facie* showing and it was consequently up to the Respondent to come forward with evidence of a right to or legitimate interests in the Disputed Domain Name, which has not been done given Respondent's absence of participation in these proceedings.

Accordingly, the Panel finds that the Respondent has no right or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

### (3). **Bad faith**

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct;
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its website or other on-line 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

In this case, the Panel holds that the Respondent registered the Disputed Domain Name in bad faith because the Trademark is distinctively identifying the Complainant so that the choice of the Disputed Domain Name cannot be reasonably explained otherwise than as a reference to the Trademark of the Complainant. The Respondent's bad faith in the registration and use of the Disputed Domain Name is further confirmed by the fact that the Respondent had already registered domain names corresponding to well-known trademarks of third parties and was respondent in several domain name dispute proceedings which were decided against the Respondent (showing that the Respondent had targeted other high end (Italian) fashion brands, including Loro Piana:

<http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2012-1114>). It is also confirmed by the fact that the Respondent offered the Disputed Domain Name for sale for a price exceeding the documented out-of-pocket costs directly related to the Disputed Domain Name.

For these reasons, the Panel considers that the Complainant has established that the Disputed Domain Name was registered and is being used in bad faith by the Respondent pursuant to paragraph 4(a)(iii) of the Policy.

## **6. Conclusions**

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <salvatoreferragamo.hk> be transferred to the Complainant.

Dated February 27, 2013

Jacques de Werra