



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No. **HK-1100387**
Complainant: Salvatore Ferragamo S.p.A. (formerly known as Salvatore Ferragamo Italia S.p.A.)
Respondent : Jone Smith

1. THE PARTIES

The Complainant is Salvatore Ferragamo S.p.A., of Firenze, Italy.

The Respondent is Jone Smith of Hong Kong.

2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name <ferragamobags.com> (the "Disputed Domain Name") is registered with eNom, Inc. (the "Registrar").

3. PROCEDURAL HISTORY

The Complaint was filed with the Asian Domain Name Dispute Resolution Center (the "Center") on 12 August 2011. On 15 August 2011, the Center transmitted by email to NameCheap Inc. (the named registrar in the original Complaint) a request for registrar verification in connection with the Disputed Domain Name. On 22 August 2011, NameCheap Inc. transmitted by email to the Center its response, which, amongst other things, directed the Centre to contact UDRP@enom.com in the event that the domain holder could not be contacted. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On 23 August 2011, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of the Disputed Domain Name and confirming the Respondent's contact details as specified in the Complaint. The Center verified that 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 ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced 30 August 2011. In accordance with the Rules, paragraph 5(a), the due date for Response was 19 September

2011. The Respondent did not submit any response. Accordingly, the Center notified the Parties of the Respondent's default on 27 September 2011.

The Complainant elected to have the Complaint decided by a sole panelist. On 6 October 2011, the Centre appointed Gabriela Kennedy as the sole panelist in the matter. 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 an Italian company that produces, markets and sells worldwide, high end fashion, bags, shoes and fashion accessories, which company has traded under the SALVATORE FERRAGAMO trade mark since at least 1937. The Complainant owns numerous registrations for the FERRAGAMO and SALVATORE FERRAGAMO trade marks around the world, including a figurative mark of the name "Ferragamo" registered in Italy on 20 December 1937, and the trade marks SALVATORE FERRAGAMO and FERRAGAMO registered in Hong Kong on 18 October 1979 and 26 September 1986 respectively. The Complainant also owns a number of domain name registrations incorporating FERRAGAMO, including <ferragamo.com>, <salvatoreferragamo.it>, <ferragamo.it>, <salvatoreferragamo.org> and <salvatoreferragamo.net>, which registrations date from 3 February 1997.

The Respondent appears to be an individual residing in Hong Kong. The Respondent registered the Disputed Domain Name on 14 February 2011. As at the date of this decision, the Disputed Domain Name does not resolve to an active website.

5. **PARTIES' CONTENTIONS**

A. Complainant

The Complainant's contentions can be summarised as follows:

- (a) The Disputed Domain Name is identical or confusingly similar to the Complainant's FERRAGAMO and SALVATORE FERRAGAMO trade marks:
 - (i) the Complainant owns more than 400 applications and registrations for the FERRAGAMO and SALVATORE FERRAGAMO trade marks worldwide;
 - (ii) the Disputed Domain Name is identical or confusingly similar to the Complainant's FERRAGAMO and SALVATORE FERRAGAMO trade marks; and
 - (iii) the addition of the word "bags" is an insignificant difference. If anything, since the Complainant is well known for its high quality handbags, the addition of the word "bags" serves to enhance the likelihood of confusion.

- (b) The Respondent does not have legitimate rights or interests in the Disputed Domain Name:
- (i) the Respondent is not affiliated in any way with the Complainant;
 - (ii) the Complainant has not licensed or otherwise authorised the Respondent to use its FERRAGAMO or SALVATORE FERRAGAMO marks or to apply for any domain name incorporating such marks and names;
 - (iii) to the best of the Complainant's knowledge, the Respondent does not own any trade mark or service mark applications or registrations for FERRAGAMO or SALVATORE FERRAGAMO or any similar marks in connection with any goods or services;
 - (iv) the Respondent registered the Disputed Domain Name more than 30 years after the SALVATORE FERRAGAMO trade mark was first registered in Hong Kong in 1979;
 - (v) the Complainant has been using the FERRAGAMO and SALVATORE FERRAGAMO trade marks in commerce for a long time, such that it has established rights in both marks throughout the world, that are superior to the rights, if any, of the Respondent in / to the Disputed Domain Name; and
 - (vi) to the best of the Complainant's knowledge, apart from the registration of the Disputed Domain Name, the Respondent has not been using the FERRAGAMO and SALVATORE FERRAGAMO trade marks, and the website to which the Disputed Domain Name resolves has nothing to do with FERRAGAMO or FERRAGAMO bags, but rather advertises for sale "GHD" branded hair straighteners.
- (c) The Disputed Domain Name has been registered and is being used in bad faith:
- (i) the Complainant's fame in the FERRAGAMO and SALVATORE FERRAGAMO trade marks is such that the Respondent, at the time of registering the Disputed Domain Name, must have been aware that they are well-known marks belonging to the Complainant. As such, any use of the Disputed Domain Name by the Respondent would be bound to cause confusion among the public;
 - (ii) the words "salvatore ferragamo" and "ferragamo" do not have dictionary meanings, such that no party, except the Complainant, would require the use of such words unless they have improper motives;
 - (iii) the Respondent is the registrant of 94 other domain names, some of which incorporate other well-known trade marks, such as <burberrydiscount.co.uk> and <karenmillencheap.com>, which shows a deliberate practice of registering domain names chosen to resemble the names and marks of other people and are plainly intended to deceive;
 - (iv) the Respondent is a fictitious person invented by an unknown party to carry out his or her cybersquatting activities, as can be noted from the registrant name given by the Respondent for the domain name <burberrydiscount.co.uk>: "burberry trading as Jone Smith"; and

- (v) the Disputed Domain Name discourages Internet users from locating the Complainant's true web sites, thereby diluting the value of its FERRAGAMO and SALVATORE FERRAGAMO trade marks.

B. Respondent

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

The fact that the Respondent has not submitted a Response does not automatically result in a decision in favour of the Complainant. However, the failure of the Respondent to file a Response may result in the Panel drawing certain inferences from the Complainant's evidence. The Panel may accept all reasonable and supported allegations and inferences following from the Complaint as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. D2009-1437 and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. D2000-0403).

6. DISCUSSION AND FINDINGS

Under paragraph 4(a) of the Policy, the burden of proof lies with the Complainant to show each of the following three elements:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used by the Respondent in bad faith.

(i) Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in respect of the FERRAGAMO and SALVATORE FERRAGAMO trade marks on the basis of the numerous trade mark registrations owned by the Complainant for such marks, including registrations for its FERRAGAMO and SALVATORE FERRAGAMO trade marks in Hong Kong, where the Respondent is located, which marks predate the registration of the Dispute Domain Name by over 30 years. The Complainant's requisite rights can also be inferred from its reputation as attached to the FERRAGAMO and SALVATORE FERRAGAMO trade marks throughout the world, which is evidenced by, amongst other things, the Complainant's substantial sales revenue generated from the sale of its products bearing the FERRAGAMO and SALVATORE FERRAGAMO trade marks, both in Hong Kong and worldwide.

It is a well-established rule that in making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the domain extension, in this case <.com>, should be disregarded (*Rohde & Schwartz GmbH & Co. KG v Perthshire Marketing Ltd*, WIPO Case No. D2006-0767).

The Disputed Domain Name incorporates the FERRAGAMO mark in its entirety. The only difference between the Disputed Domain Name and the Complainant's mark is the former's inclusion of the descriptive word "bags" as a suffix. It is well-established that in cases where the distinctive and prominent element of a disputed domain name is the complainant's mark and the only variation is the addition of a generic word, such variation does not negate the confusing similarity between the disputed domain name and the mark. See *Oakley, Inc. v Joel Wong/Blue Host.com- INC*, WIPO Case No. 2010-0100; *Diageo Ireland v. Guinnessclaim*, WIPO Case No. D2009-0679; and *The Coca-Cola Company v. Whois Privacy Service*, WIPO Case No. D2010-0088. The Panel accordingly finds that "FERRAGAMO" is the distinctive and prominent component of the Disputed Domain Name, such that the addition of the word "bags" does nothing to distinguish the Disputed Domain Name from the Complainant's FERRAGAMO mark. The Panel further finds that given that the Complainant offers goods that include bags (and has done so under the "Ferragamo" name since at least 1972 in Italy and 1979 in Hong Kong) the "bags" component of the <ferragamobags.com> domain name, if anything, effects to increase the likelihood of confusion that the Disputed Domain Name is somehow associated with the Complainant (see *Harrods Limited v. Peter Pierre*, WIPO Case No. D2001-0456; *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty Ltd*, WIPO Case No. D2001-0110; and *Christie's Inc. v. Tiffany's Jewelry Auction Inc.*, WIPO Case No. D2001-0075, which support a finding that a domain name's incorporation as a suffix, of a word that describes the goods or services in respect of which the complainant's mark(s) are registered, increases the likelihood of confusion between such domain name and the complainant's mark(s)).

The Panel accordingly finds that "FERRAGAMO" remains as the distinctive and prominent component of the Disputed Domain Name, which is confusingly similar to the Complainant's FERRAGAMO mark, such that element 4(a)(i) of the Policy is satisfied.

(ii) Rights or Legitimate Interests

Paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions states that once a complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of the respondent, the respondent carries the burden of demonstrating it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel finds that there is no evidence to show that the Respondent has any rights in any trade marks or service marks which are identical, similar or related to the Domain Name. Therefore, the Panel will assess the Respondent's rights in the Domain Name (or lack thereof) based on the Respondent's use of the Disputed Domain Name in accordance with the available record.

The Panel accepts that the Complainant has not authorised the Respondent to use the FERRAGAMO trade mark and that there is otherwise no connection between the Complainant and the Respondent. The Panel further accepts that the Respondent has not become commonly known by the Disputed Domain Name and notes in this regard that the "Ferragamo" name is not an ordinary word with a dictionary meaning.

Accordingly the only way for the Respondent to acquire rights or legitimate interests in the Domain Name for the purposes of 4(a)(ii) of the Policy would be through use of the Domain Name for a legitimate non-commercial purposes or in connection with a bona fide offering of goods or services.

At the time of this decision, the Disputed Domain Name is inoperable such that it does not resolve to an active website and an error message is displayed upon attempt to activate the URL at www.ferragamobags.com. Likewise, an archived search for the Disputed Domain Name fails to yield any results. However, a printout from the website to which the Disputed Domain Name resolved on 8 August 2011 (the "Website"), as supplied by the Complainant, shows that the Website was used to offer for sale GHD brand hair straighteners, the price of which products were quoted in Australian dollars. Such use of the Disputed Domain Name clearly does not constitute noncommercial or fair use, and demonstrates that the Respondent has no need to use the Disputed Domain Name, which is not apt for or otherwise relevant to the sale of GHD brand hair straighteners (see *Drake Bliss v. Cyberline Enterprises*, WIPO Case No. D2001-0718, which supports a finding of bad faith use on the ground of use unrelated to the disputed domain name).

Further, on the basis of the Panel's findings of bad faith on the part of the Respondent (as detailed below), the Panel finds that the Respondent's intentional infringing use of the Complainant's FERRAGAMO trade mark in connection with the Disputed Domain Name precludes a finding that any offering of goods on the Website constitutes a bona fide offering (see *Madonna Ciccone p/k/a Madonna v Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847; and *Viacom International, Inc., Paramount Pictures Corporation, and Blockbuster Inc. v TVdot.net, Inc. f/k/a Affinity Multimedia*, WIPO Case No. D2000-1253).

The Panel accordingly finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy in respect of the disputed Domain Name.

(iii) Registered and Used in Bad Faith

Evidence of bad faith includes actual or constructive notice of a well known trade mark at the time of registration of a domain name by a respondent (see *Samsonite Corp. v. Colony Holding*, NAF Case No. FA 94313).

Given the fame and repute of the Complainant's FERRAGAMO mark, and the long-established "Ferragamo" trade name worldwide and in Hong Kong (where the Complainant owns in excess of 10 trade mark registrations incorporating the

"Ferragamo" name), coupled with the uniqueness of the word "Ferragamo", which has no dictionary meaning, the Panel considers that it is highly likely that the Respondent was aware (or at the very least should have been aware) of the Complainant and its marks when registering the Disputed Domain Name, such that bad faith registration is found (see *Caesar World, Inc. v. Forum LLC*, WIPO Case No. D2005-0517 and *The Gap, Inc. v. Deng Youqian*, WIPO Case No. D2009-0113, in support of a finding of bad faith registration based on constructive knowledge of the Complainant's mark(s) on the part of the Respondent).

The Panel notes that the overall objective of the Policy is to prevent abusive domain name registrations, where the respondent is attempting to profit from or exploit a trade mark of another. The Panel considers that the Respondent knew, or at least should have known, of the Complainant's rights in the FERRAGAMO trade mark prior to registering the Disputed Domain Name, and this is in itself an indicator of the type of opportunistic bad faith that the Policy is designed to prevent.

The Panel also notes the Respondent's record of registering other domain names incorporating well-known marks, such as <burberrydiscount.co.uk> (which resolves to an online store that sells purported Burberry brand products at significant discounts) and <karenmillencheap.com> (which does not resolve to an active website, but whose domain name suggests a similar discount website was intended). In the absence of any apparent connection to the owners of either of these brands and given the fact that the goods offered for sale in the case of the Respondent's www.burberrydiscount.co.uk website directly compete with those offered by the brand owner through its own website located at <www.burberry.com>, these domain name registrations by the Respondent are highly suspect and on balance, suggestive of further evidence of bad faith.

At the time of filing the Complaint, the Website was used to offer goods for sale, namely GHD brand hair straighteners. As such, the Panel considers it is not unlikely that the Respondent intentionally capitalised on the fame of the Complainant's FERRAGAMO mark by attempting to attract, for commercial gain, Internet users to the Website by creating a likelihood of confusion (initial or otherwise) with the Complainant's mark as to the affiliation or endorsement of the Website, thereby increasing the traffic to the Website and profiting from the products being offered for sale. Although as at the date of this decision, the Disputed Domain Name is not operable and does not resolve to any active website, the Panel notes that such passive holding on the part of the Respondent does not preclude a finding of bad faith use as the Panel is entitled to consider any circumstances which nonetheless indicate bad faith (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 and *Jupiters Limited v. Aaron Hall*, WIPO Case No. D2000-0574).

In the circumstances of the present case, the cumulative facts of the well-known nature of the Complainant's FERRAGAMO mark, the lack of a response to the Complaint on the part of the Respondent, and the Respondent's apparent record

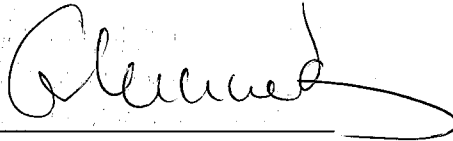
of registering other domain names incorporating well-known trade marks, forms sufficient basis from which the Panel can reasonably infer bad faith use.

Additionally, the Respondent's use of incomplete / inaccurate contact details upon registering the Disputed Domain Name (namely the provision of the email address yahoo@yahoo.com, to which messages sent by the Center repeatedly bounced back, and which email address is also listed as the contact for the domain name <karenmillencheap.com>, of which the Respondent is also the registrant) is accepted by the Panel as further evidence of bad faith use by the Respondent (see *Ebay Inc. v. Wangming*, WIPO Case No. D2006-1107).

The Panel accordingly finds that the Respondent has registered and used the Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

7. **DECISION**

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 <ferragamobags.com> be transferred to the Complainant.



Gabriela Kennedy
Sole Panelist

Date: 20 October 2011