

## DISPUTE RESOLUTION SERVICE

**D00014281**

### Decision of Independent Expert

Salvatore Ferragamo S.p.A.

and

he yi

#### **1. The Parties:**

Lead Complainant: Salvatore Ferragamo S.p.A.  
Via Dei Tornabuoni 2  
Florence  
FI  
50100  
Italy

Respondent: he yi  
46 D courtfield gardens  
London  
London  
SW5 0NA  
United Kingdom

#### **2. The Domain Name:**

<salvatoreferragamooutlet.co.uk> (the Domain Name)

#### **3. Procedural History:**

The Complaint was filed with Nominet on 29 May 2014. Nominet validated the Complaint on 30 May 2014 and notified the Respondent by post and by email stating

that the Response had to be received on or before 20 June 2014. The Respondent did not file a Response.

On 23 June 2014 Nominet informed the Complainant that it had until 7 July 2014 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 4 July 2014 the Complainant paid Nominet the required fee.

On 9 July 2014, the undersigned, David Taylor ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an Expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question his independence and/or impartiality. The Expert was appointed on 14 July 2014.

#### **4. Factual Background**

The Complainant is a well-known Italian company which is active in the business of manufacturing, marketing and selling shoes, handbags and other articles. The Complainant's products are sold all over the world, including in the United Kingdom.

The Complainant owns more than 400 trade mark applications and registrations consisting of SALVATORE FERRAGAMO and FERRAGAMO worldwide, including but not limited to the following:

- United Kingdom Trade mark No. 1001070, SALVATORE FERRAGAMO, for goods in class 18, registered on 2 November 1972 and duly renewed;
- United Kingdom Trade mark No. 1001071, SALVATORE FERRAGAMO, for goods in class 25, registered on 2 November 1972 and duly renewed;
- Community Trade mark No.103259, FERRAGAMO, registered on 20 April 1998, for goods in class 3, 6, 9, 14, 16, 18, 24, 25, 26, 28, 33, 35, 42;
- Italian Trade mark No.1232276, FERRAGAMO (figurative), registered on 25 September 1937, for goods in class 25.

The Complainant also owns several domain names consisting of "Ferragamo" or "Salvatore Ferragamo", including but not limited to: <salvatoreferragamo.com>, <salvatoreferragamo.co.uk>, <ferragamo.net> which point to websites promoting the Complainant's products.

The Domain Name was registered on 18 March 2014 by the Respondent. It is currently pointing to a website purportedly offering for sale SALVATORE FERRAGAMO products.

The Respondent appears to be based in London, United Kingdom. No further details are known about the Respondent.

## **5. Parties' Contentions**

### **The Complainant**

The Complainant asserts that it is a joint stock company based in Italy and that it is active in the business of manufacturing, marketing and selling shoes, handbags and other articles.

The Complainant asserts that it has been using the trade mark FERRAGAMO since at least 1927 with respect to shoes and 1968 with respect to handbags and underlines that it has "a long and illustrious history". The Complainant further explains that the founder of the Complainant's business, Salvatore Ferragamo, began his career in 1914 in Santa Barbara, California, and first achieved notoriety by creating hand-made shoes for the burgeoning film industry, including for Mary Pickford and Douglas Fairbanks. Eventually, Salvatore Ferragamo achieved worldwide reputation as the "shoemaker to the stars", including Gloria Swanson, Lillian Gish, Joan Crawford, Clara Bow, Greta Garbo, Sophia Loren, Susan Hayward, Marilyn Monroe and Audrey Hepburn.

The Complainant explains that today it manufactures a wide variety of products including wallets, luggage, belts, apparel, fragrances, gift items and costume jewellery.

The Complainant's products are sold in many countries throughout the world, including in the United Kingdom.

The Complainant asserts that it owns more than 400 trade mark applications and registrations in the name FERRAGAMO and SALVATORE FERRAGAMO worldwide. In addition, the Complainant has provided evidence of several trade mark registrations directly relevant to the present dispute, including UK, Italian and Community trade marks (as described above).

The Complainant further submits that it owns many domain names consisting of the trade marks FERRAGAMO and SALVATORE FERRAGAMO, including but not limited to <salvatoreferragamo.com>, <salvatoreferragamo.co.uk>, <ferragamo.net> which point to websites promoting its products.

The Complainant asserts that it has extensively advertised its products through the most famous fashion publications worldwide and has provided numerous samples of advertisements from these publications, including ELLE and VOGUE.

Furthermore, the Complainant has demonstrated that over the past years it has spent an average of 40 million Euros per year in advertising and promoting its products. The Complainant further submits that as a result of its extensive advertising and promotional efforts, its trade marks have acquired considerable renown and goodwill, and that they are amongst its most valuable and important assets.

The Complainant contends that the registration of the Domain Name is abusive, first, because the Domain Name (<salvatoreferragamooutlet.co.uk>) is similar to its trade marks. The Complainant submits that the distinctive and prominent element of the Domain Name is the Complainant's SALVATORE FERRAGAMO trade mark and that the addition of the term "outlet" does not negate the confusing similarity between the Domain Name and the Complainant's trade mark. To support its claim, the Complainant relies on the following decisions: *Oakley, Inc. v. Joel Wong/Blue Host.com- INC*, WIPO Case No. D2010-0100; *Diageo Ireland v. Guinnessclaim*, WIPO Case No. D2009-0679; and *The Coca-Cola Company v. Whols Privacy Service*, WIPO Case No. D2010-0088.

The Complainant further contends that the suffix "outlet" describes a service that the Complainant could easily offer and should therefore be considered "completely insufficient to dispel user confusion from inevitably occurring. In fact, doing so very likely exacerbates than ameliorates the confusion", citing *PepsiCo, Inc. v. QWO*, WIPO Case No. D2004 0865, amongst other decisions relating to the term "outlet".

The Complainant also contends that the Respondent is not affiliated in any way with the Complainant nor does it own any trade mark registrations in "salvatoreferragamooutlet" or any similar trade marks, as shown by a search carried out by the Complainant.

The Complainant further contends that it has not licensed or otherwise authorised the Respondent to use its trade marks, or to apply for any domain name incorporating its trade marks and that the Respondent is not commonly known by the Domain Name.

It further contends that the Respondent is not making a legitimate non-commercial use of the Domain Name "since the sole activity carried out on the website is the unlawful sale of counterfeit 'Salvatore Ferragamo' products". To support its claim, the Complainant has provided an affidavit signed by its internal trade mark specialist attesting that it had analysed samples offered for sale on the website associated with the Domain Name and had confirmed that these were "illegitimate copies and that are bearing Salvatore Ferragamo S.p.A.'s counterfeit trademarks".

The Complainant therefore claims that the Domain Name was primarily registered to unfairly disrupt the Complainant's business, in accordance with paragraph 3(a)(i)(C) of the Policy and relies on the Nominet decision DRS 12819 (<storemoncler.co.uk>)

to support its claim. In this decision, the disputed domain name was also pointing to a website offering for sale counterfeit products and the panel held that *"it is difficult to imagine that the Domain Name was registered for any purpose other than unfairly to disrupt the business of the Complainant, not least by using the Domain Name to piggyback on the trading goodwill owned by the Complainant to sell counterfeit versions of the Complainant's products. Indeed, it is difficult to think of a more egregious example of unfair disruption of a business. Accordingly, the Complaint succeeds on this ground"*.

The Complainant also contends that the Respondent registered the Domain Name to take unfair advantage of the reputation of the Complainant's trade mark and to confuse people into thinking that the website is associated to or affiliated with the Complainant. The Complainant argues that the fact that the website associated with the Domain Name contains pages devoted to the Complainant's history and includes a reference to one of the Complainant's flagship stores in the UK as well as to links to all of the Complainant's official social networks confuses internet users as to the Respondent's affiliation with the Complainant and that, as a matter of fact, the Complainant became aware of the existence of the Domain Name following several complaints made by customers at the Complainant's flagship store in London regarding purchases made through the website associated with the Domain Name.

### **The Respondent**

The Respondent did not submit a Response.

## **6. Discussions and Findings**

### **General**

Under paragraph 2(a) of the Policy, in order to obtain the transfer of the Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, the following:

*"(i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

*(ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration."*

### **Complainant's Rights**

As for paragraph 2(a)(i), paragraph 1 of the Policy defines "Rights" as follows:

*"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning."*

The Expert notes that the Complainant has submitted evidence that it is the registered owner of a number of trade marks in respect of the name SALVATORE FERRAGAMO in many jurisdictions throughout the world, including in the United Kingdom, and that these trade marks have developed considerable renown and goodwill worldwide.

The Expert is satisfied, based on the evidence put forward by the Complainant, that the Complainant has established Rights in respect of the name SALVATORE FERRAGAMO.

Paragraph 2(a)(i) of the Policy also provides that the name or mark in which the Complainant has Rights must be identical or similar to the Domain Name.

The Expert notes that the Domain Name incorporates in its entirety the Complainant's trade mark SALVATORE FERRAGAMO.

Furthermore, it is well established that the addition of descriptive terms such as "outlet" does nothing to distinguish a domain name from a complainant's trade mark. In addition, the Expert accepts the Complainant's contention that the term "outlet" exacerbates the confusion between the Domain Name and the Complainant's trade mark as it refers to a type of retail store that the Complainant could operate to sell its products.

Finally, it is accepted practice under the Policy to discount the ".CO.UK" suffix in this assessment.

The Expert therefore finds that that the Complainant has Rights in respect of a name which is identical or similar to the Domain Name and has thus satisfied paragraph 2(a)(i) of the Policy.

### **Abusive Registration**

Paragraph 2(a)(ii) of the Policy requires the Complainant to prove that the Domain Name is an Abusive Registration.

Paragraph 1 of the Policy defines Abusive Registration as *"a domain name which either:*

*(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*

*(ii) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".*

A complainant must therefore prove one or both of these on the balance of probabilities.

### **(i) Abuse at the Time of Registration**

As for Paragraph 1(i) of the Policy, the Expert considers that there was an Abusive Registration at the time of registration of the Domain Name.

Based on the evidence put forward by the Complainant, it is clear that the Complainant's SALVATORE FERRAGAMO trade mark enjoys considerable goodwill and reputation worldwide, including in the United Kingdom. The Expert is therefore persuaded that the Respondent was aware of the Complainant's Rights at the time of registration of the Domain Name, particularly in view of the subsequent use of the Domain Name, and thus registered the Domain Name to profit from the Complainant's goodwill.

Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence of Abusive Registration of a domain name.

The Complainant expressly relies on paragraph 3(a)(i)(C) of the Policy which provides that:

*i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

*C. for the purpose of unfairly disrupting the business of the Complainant".*

The Expert notes that the circumstance invoked by the Complainant set out in paragraph 3(a)(i)(C) concerns the Respondent's motives at the time of registration of the Domain Name. Whilst the Expert finds that the Respondent's actions could indeed have resulted in an unfair disruption of the Complainant's business, in the Expert's view, this was not the main reason why the Respondent registered the Domain Name. Rather, it seems more likely that, as explained previously, the Respondent acquired the Domain Name primarily to take advantage of the Complainant's goodwill and renown for his own financial gain. See Nominet DRS 12940 (<cashconverters.org.uk>).

The Expert is therefore satisfied that the Domain Name was *registered* in a manner which, at the time when the registration took place, took unfair advantage of and was unfairly detrimental to the Complainant's Rights, in accordance with paragraph 1(i) of the Policy.

**(ii) Abusive Use**

As regards (ii) above, the Expert also finds that the Domain Name has been used in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights.

The Complainant expressly relies on paragraph 3(a)(ii) of the Policy, which provides as follows:

*ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;*

The Expert finds that this circumstance invoked by the Complainant adequately describes the Respondent's behaviour.

The Respondent has been using the Domain Name which incorporates in its entirety the Complainant's trade mark in conjunction with the term "outlet" in order to attract internet users that are seeking the Complainant's products at reduced prices (as suggested by the term "outlet") to its website, which purportedly offers for sale the Complainant's products. The Expert thus finds that the Respondent's use of the Domain Name itself is misleading internet users searching for the Complainant into believing that the Domain Name is registered to or authorised by the Complainant.

Furthermore, the Expert finds that the confusion created by the Domain Name itself is exacerbated by the nature of the website to which it is resolving (as evidenced by the screen captures of the website submitted by the Complainant). The Expert is of the view that the fact that the website prominently displays the Complainant's trade mark, that there are no disclaimers disclosing the nature of the relationship (or lack thereof) between the Complainant and the Respondent and the reference to the Complainant's flagship store in London are strong indications that the Respondent is fraudulently misrepresenting to internet users that the website is operated or authorised by the Complainant.

In addition, the Expert is of the view that the Respondent's use of the Domain Name to point to a website offering for sale counterfeit goods (as evidenced by the affidavit submitted by the Complainant) clearly amounts to an Abusive Registration, as the Respondent is not only unduly profiting from the Complainant's goodwill for his own



financial gain, but is also unfairly damaging the Complainant's trade mark, brand and business activity.

The Expert therefore finds that the Domain Name is being *used* in a manner which is taking unfair advantage of and is also unfairly detrimental to the Complainant's Rights, in accordance with paragraph 1(ii) of the Policy.

Finally, Paragraph 4(a) of the Policy sets out a list of factors on which a respondent may rely on to demonstrate that the Domain Name is not an Abusive Registration.

The Respondent has failed to submit a Response to the Complainant's contentions. However, the Expert has examined the circumstances set out in Paragraph 4(a) of the Policy and finds that, taking into account the nature of the Domain Name and the use to which it has been put by the Respondent (as described above), none of those circumstances would seem to assist the Respondent.

In summary, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on the balance of probabilities, that the Domain Name is an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

## **7. Decision**

The Expert finds that the Complainant has Rights in a name which is identical or similar to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The Domain Name should therefore be transferred to the Complainant.

**Signed:** David Taylor

**Dated:** 28 July 2014