

DISPUTE RESOLUTION SERVICE

D00014554

Decision of Independent Expert

Salvatore Ferragamo S.p.A.

and

wen ben zhou

1. The Parties

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

Respondent: wen ben zhou
46 D courtfield gardens
London
SW5 0NA
United Kingdom

2. The Domain Name

<salvatorreferragamoshop.co.uk> ("the Disputed Domain Name")

3. Procedural History

The Complaint was filed with Nominet on 23 July 2014. Nominet validated the Complaint on the same day and notified the Respondent by post and by email, stating that the Response had to be received on or before 13 August 2014. No response was received, despite a reminder notification sent on 11 August 2014. On 14 August 2014 Nominet sent a notification of no response to both parties and informed the Complainant's representative that mediation was not possible and that it had until 29 August 2014 to pay the fee for either a full or a summary decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 20 August 2014 the Complainant's representative paid Nominet the fee for a full decision.

On 20 August 2014 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she was independent of each of the parties and that, to the best of her knowledge and belief, there were no facts or circumstances, past or present (or that could arise in

the foreseeable future) that needed to be disclosed as they might be of a such a nature as to call in to question her independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant is an Italian company that manufactures, markets and sells shoes, handbags and other items (including wallets, luggage, belts, clothing, fragrances, gifts and costume jewellery). It has been using the trade mark FERRAGAMO since at least 1927 in relation to shoes and 1968 in relation to handbags.

The Complainant's products can be found at retail stores located in many countries, for example Italy, United States, United Kingdom, France, Germany, Canada, China, Hong Kong, Japan, Korea, Taiwan, Indonesia, Malaysia, Singapore, Thailand, Australia, Spain, Switzerland, Saudi Arabia, Indonesia, Belgium and the Philippines.

The Respondent is Wen Ben Zhou, supposedly of London in the United Kingdom. No other details are known.

The Disputed Domain Name was registered on 4 May 2014. It is being used to point to a website which resembles an official website of the Complainant but which sells counterfeit products bearing the Complainant's trade marks (the website has pages devoted to the Complainant's history, makes reference to one of its UK flagship stores and also contains links to all of the Complainant's official social network profiles).

5. Parties' Contentions

Complaint

Complainant's Rights

The Complainant owns over 400 applications and registrations for the trade marks FERRAGAMO and SALVATORE FERRAGAMO worldwide. In particular the Complainant is the owner of the following registered trade marks directly relevant to this case:

- UK national registration No. 1001070 in the term SALVATORE FERRAGAMO covering goods in class 18, filed on 2 November 1972;
- UK national registration No. 1001071 in the term SALVATORE FERRAGAMO covering goods in class 25, filed on 2 November 1972;
- Community Trade Mark registration No.103259 in the term FERRAGAMO covering goods in classes 3, 6, 9, 14, 16, 18, 24, 25, 26, 28, 33, 35 and 42, registered on 20 April 1998; and
- Italian national registration No.1232276 in the term FERRAGAMO covering goods in class 25, filed on 25 September 1937.

The Complainant asserts that the trade mark FERRAGAMO is unique in the sense that there are no other identical or similar marks or names which are registered or in use by third parties. The Complainant underlines that its trade marks enjoy an indisputable reputation and are consequently synonymous with, and symbolize, the Complainant's reputation and goodwill, which is one of the Complainant's most valuable assets.

The Complainant states that, over the years, it has received substantial publicity by virtue of the quality and uniqueness of its products. In addition, the Complainant has advertised its shoes, handbags and other products bearing the trade mark FERRAGAMO (as well as its other trade marks) worldwide in many famous fashion magazines.

The Complainant asserts that, in recent years, it has spent an average of 40 million EUR per year on advertising and promoting its products worldwide, including products bearing the FERRAGAMO trade marks.

The Complainant concludes that, as a result of its extensive advertising and promotional efforts, as well as the high quality and commercial success of its handbags, shoes and other products bearing the FERRAGAMO trade marks, these trade marks have become extremely well-known within the fashion industry as well as by the public, and are now recognized and relied upon as a symbol of quality shoes, handbags and other products marketed exclusively by the Complainant.

Finally, the Complainant draws attention to the fact that it owns several domain names consisting of the trade marks FERRAGAMO and SALVATORE FERRAGAMO, for example <salvatoreferragamo.com>, <salvatoreferragamo.co.uk> and <ferragamo.net>. The Complainant promotes its products bearing the trade marks FERRAGAMO and SALVATORE FERRAGAMO on the corresponding websites.

The Complainant argues that the Disputed Domain Name is confusingly similar to the Complainant's trade mark because the only difference between the Disputed Domain Name and the Complainant's trade mark is the use of the generic term "shop". In this regard the Complainant argues that 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 or sign, such variation does not negate the confusing similarity between the disputed domain name and the mark.

In this case the Complainant asserts that the suffix "shop", which describes a service that the Complainant could easily offer, should be considered completely insufficient to dispel user confusion from inevitably occurring, and indeed very likely exacerbates it.

Abusive Registration

The Complainant states that the Respondent is not affiliated in any way with the Complainant and, to the best of the Complainant's knowledge, does not own any trade mark applications or registrations for SALVATOREFERRAGAMOSHOP or any similar trade marks in connection with any goods or services.

In addition, the Complainant points out that it has not licensed or otherwise authorized the Respondent to use its FERRAGAMO trade mark, or to apply for any domain name incorporating such mark.

Furthermore, the Complainant asserts that the Respondent is not commonly known by the Disputed Domain Name and does not make any legitimate commercial use thereof either since the sole activity carried out on the website is the unlawful sale of counterfeit products bearing the FERRAGAMO brand. The Complainant therefore argues that the Disputed Domain Name was primarily registered to unfairly disrupt its business.

Moreover, in the Complainant's opinion it is evident that the Respondent registered the Disputed Domain Name with a view to taking unfair advantage of the reputation of the Complainant's trade mark and confusing people into thinking that the corresponding website was controlled by the Complainant. The Complainant argues that the Respondent's registration of the Disputed Domain Name obviously confuses potential customers with regard to the Respondent's affiliation with the Complainant. Indeed the Complainant was made aware of the existence of the Disputed Domain Name when several customers called its flagship store in London complaining about purchases made on the corresponding website.

Response

No Response was received.

6. Discussion and Findings

General

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Disputed Domain Name the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

- "(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

The Policy defines Rights as "*rights enforceable by the Complainant, whether under English law or otherwise*".

The Expert is satisfied, based on the evidence presented, that the Complainant has the necessary Rights in the term SALVATORE FERRAGAMO, notably as a result of the trade marks referred to in the Complainant's submission (as summarised above).

Furthermore, the Policy stipulates that the name or mark in which the Complainant has Rights (SALVATORE FERRAGAMO) must be identical or similar to the Disputed Domain Name (<salvatoreferragamoshop.co.uk>).

It is accepted practice under the Policy to discount the .CO.UK suffix, and so the only difference between the Complainant's trade mark and the Disputed Domain Name is the addition of the generic word "shop". The Expert is of the opinion that this is not significant enough to dispel any similarity between the Complainant's trade mark and the Disputed Domain Name, especially in view of the fact that the Complainant also runs an online shop.

As a result the Expert finds that paragraph 2(a)(i) of the Policy is satisfied and that the Complainant has Rights in respect of a name which is similar to the Disputed Domain Name.

Abusive Registration

Moving on to paragraph 2(a)(ii) of the Policy, "Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

- "(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."*

Having considered the Complainant's submissions in detail, the Expert is satisfied that this is a clear-cut case of abusive registration.

Given the evidence presented regarding the Complainant's substantial history and extensive use and fame of the SALVATORE FERRAGAMO brand, it is clear that the Respondent would have been aware of the Complainant at the time that the Disputed Domain Name was registered. Indeed, in the light of the subsequent use of the Disputed Domain Name, the Expert is satisfied that the Respondent registered the Disputed Domain Name with the Complainant in mind specifically to take unfair advantage of the Complainant's Rights, as required by (i) above.

Furthermore, the Respondent's subsequent use of the Disputed Domain Name to point to a website selling counterfeit products can only have been to take unfair advantage of the Complainant's Rights, as required by (ii) above.

In making these findings the Expert has taken into consideration paragraph 3(a) of the Policy which sets out a non-exhaustive list of factors that may be evidence of abuse. The Complainant has argued that paragraphs 3(a)(i)(C) and 3(a)(ii) are satisfied. The Expert is not certain that paragraph 3(a)(i)(C) is applicable in this case because the Policy states that the Respondent's *primary* motivation for registration of the Disputed Domain name must be unfair disruption of the Complainant's business. Whilst it is highly likely that the Respondent's actions have indeed resulted in such disruption, in the Expert's opinion this was not the main reason why the Respondent registered the Disputed Domain Name. It seems more likely that the Respondent's primary motivation upon registration of the Disputed Domain Name was simply his own financial gain.

However, the Expert finds that paragraph 3(a)(ii) perfectly describes the Respondent's behaviour in that he has used the Disputed Domain Name in a way which has confused or is likely to confuse people or businesses into believing that it was registered to, operated or authorised by, or otherwise connected with the Complainant.

Finally, paragraph 4(a) of the Policy sets out a non-exhaustive list of factors which may be evidence of non-abuse, but the Expert is of the opinion that none of these factors are of any assistance to the Respondent in the present case.

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 balance of probabilities, that the Disputed 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 similar to the Disputed Domain Name, and that the Disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Disputed Domain Name should therefore be transferred to the Complainant.

Jane Seager
11 September 2014