



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (BEIJING OFFICE)

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Decision Submission

English Print

Decision ID	DE-0900255
Case ID	CN-0900278
Disputed Domain Name	www.inferragamo.com
Case Administrator	lvyan
Submitted By	YUN ZHAO
Participated Panelist	
Date of Decision	17-09-2009

The Parties Information

Claimant	SALVATORE FERRAGAMO ITALIA S.P.A
Respondent	zhigao liu

Procedural History

On 30 June 2009, the Complainant submitted a Complaint in the English language to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the "Center") and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules).

On 3 July 2009, the Center sent to the complainant by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules.

On 3 July 2009, the Center transmitted by email to the Registrar, TUCOWS INC., a request for registrar verification in connection with the disputed domain name. On 7 July 2009, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 24 July 2009, the Center transmitted the Complaint to the Respondent.

On 31 July 2009, the Center notified the Respondent of the commencement of the action. On the same day, the Center notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent, and notified the ICANN and the Registrar of the commencement of the proceedings.

The Respondent failed to submit a Response within the specified time period. On 26 August 2009, the Center notified both parties of the Respondent's default.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance on 29 August 2009, the Center notified the parties on 31 August 2009 that the Panel in this case had been selected, with Mr ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 31 August 2009, the Panel received the file from the Center and should render the Decision within 14 days, i.e., on or before 14 September 2009.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

Factual Background

For Claimant

The Complainant in this case is SALVATORE FERRAGAMO ITALIA S.P.A. The registered address is VIA DEI TORNABUONI 2, FIRENZE, ITALY. The Complainant is the owner of the trademark “ferragamo”. The authorized representative in this case is Haiying Fu/Ming Xu.

For Respondent

The Respondent in this case is zhigao liu. The address is xianyou, NA 351000, CN. The Respondent is the current registrant of the disputed domain name <inferragamo.com> according to the Whois information.

Parties' Contentions

Claimant

(1) The effective part of the disputed domain name is confusingly similar to the trademark in which the Complainant has prior rights

Salvatore Ferragamo, the founder of the brand and company of “Salvatore Ferragamo” is always recognized as the Italian legend in the shoe-making industry. After making his first pair of shoes at age nine, young Salvatore decided that he had found his calling. He always had a passion for shoes. “Salvatore Ferragamo” was first used a trademark for shoes in 1927. In that year, after spending 13 years having already found success in the US, Ferragamo returned to Italy and opened a workshop, the predecessor of the complainant “Salvatore Ferragamo Italia S.p.A.” The business of Ferragamo was expanded during the 1950 to a workforce of around 700 expert artisans that produced 350 pairs of hand-made shoes a day. Ferragamo was always recognized as a visionary, and his designs ranged from the strikingly bizarre objet d'art to the traditionally elegant, often serving as the main inspiration to other footwear designers of his time and beyond. Ferragamo died in 1960 at the age of 62, but his name lives on as an international company. At his death, his family has taken over the business and brought continued success to the brand. Salvatore Ferragamo Italia S.p.A. has expanded its operations to include luxury shoes, bags, eyewear, silk accessories, watches, perfumes and a ready-to-wear clothing line. Salvatore Ferragamo Italia S.p.A. is now in its third generation. Shoes remain Ferragamo’s core business and the creative engine of its entire production.

The Complainant owns the prior trademark rights over the term “Ferragamo”. Since 1927, “Salvatore Ferragamo” has been used as the trademark for shoes by the Complainant & its predecessors. The said mark also has been approved for registration in most countries/territories all over the world. “Ferragamo”, as the family name of Salvatore Ferragamo, is also used and registered by the Complainant worldwide including China. Since 1987, the Complainant has begun to spread its business in China and in the same year, the Complainant filed the trademark applications for “Salvatore Ferragamo” series marks before China Trademark Office.

The effective part of the disputed domain name is confusingly similar to the “Ferragamo” mark in which the Complainant has prior rights. The effective part of the disputed domain name is “inferragamo”, which can be divided into “in” and “ferragamo”. “ferragamo” is identical with the “Ferragamo” mark of the Complainant while “in” is only a prep word. Among “inferragamo”, “ferragamo” undoubtedly is the distinctive part. In fact, as revealed in of the complaint, the website under “inferragamo.com” shows as an online store selling Ferragamo shoes. When the common consumers surf on the Internet and find the above website, it is of high possibilities that the consumers would regard the said website as the website run by the Complainant or at least has certain relationship with the Complainant, especially, the Respondent also promotes on the website that “Our Company was established in 2003 as an exclusive online destination offering Ferragamo Shoes at affordable prices”.

(2) The Respondent has no rights or legitimate interests in respect of the disputed domain name

According to preliminary search, the Respondent has no trademark rights or other legitimate interests in the term “inferragamo” or “ferragamo”. The Complainant has never authorized the Respondent to use the “Ferragamo” mark as well.

(3) The domain name was registered and is being used in bad faith

There is no reasonable explanation for the Respondent’s registration of the disputed domain name other than to profit

from the goodwill associated with the brands of Ferragamo. Since the year of 1987, the Complainant begun to spread the business in China and till now, the Complainant has set up about 40 franchised shops in 23 cities around China. By long-term promotion, the brand of Ferragamo has been familiar with by the Chinese consumers. The Respondent, as showed in the Who-is Record, is a Chinese individual named “Zhigao LIU” addressed as Xianyou, where is a Town in Putian City, Fujian Province, China. In the column of “About us” on the website www.inferragamo.com, the Respondent promotes that “Ferragamo is a well-known Italian brand. The founder, Salvatore Ferragamo established it to make unique hand-made footwear. His scientific and creative approach to shoes spawned many innovations such as the wedge heel and cage heel. Film stars and celebrities continue to patronize his company, which has evolved into a luxury goods empire spanning the world. Ferragamo shoes, including athletic, outdoor, casual and slippers, are catalogued as women shoes and men shoes that are available in a variety of comfort styles. When thinking about shoes, Ferragamo shoes have no real competitor. Take your time to look through our catalogue and find the best price about Ferragamo Shoes on our site.” From those words, it is clear that the Respondent is very familiar with the brand history and brand value of Ferragamo.

The prices the Respondent offer for its “Ferragamo” shoes are much lower that the prices of the genuine Ferragamo shoes. As mentioned before, on the website, the Respondent promotes that “Our Company was established in 2003 as an exclusive online destination offering Ferragamo Shoes at affordable prices” . High quality of Ferragamo shoes is ensured by the attention given to model construction and the strong manual component that characterizes the production cycle. That is the reason why Ferragamo can become the world famous brand. Accordingly, the prices of Ferragamo shoes are higher than ordinary shoes. The “affordable prices” offered by the Respondent in fact are not available for genuine Ferragamo shoes. According to the search and check of the Complainant, the shoes sold on the website under the disputed domain name are all counterfeits.

Based on the above, it is obvious that the purpose of the Respondent for registering the disputed domain and building the website selling the counterfeit Ferragamo shoes is to make illegal profits by way of riding on the high reputation of the brand of Ferragamo. The domain is very similar to “ferragamo” . As mentioned above, when surfing online, the consumers might be lured to visit the said website. Then, the Respondent can conduct its online sales for counterfeits by offering low prices to attract the consumers. Such acts of the Respondent would not only cause damages to the prior rights of the Complainant, but also will do harm to the interests of common consumers.

In accordance with Paragraph 4(b)(i) of the Policy, the Complainant requests the Panel to issue a decision to cancel the Disputed Domain Name.

Respondent

The Respondent failed to submit a Response within the specified time period.

Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4 (a) of the Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- 1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) the domain name has been registered and is being used in bad faith.

Identical / Confusingly Similar

The Complainant is a shoe-making company in Italy. Since 1927, the name of its founder, “Salvatore Ferragamo” has been used as trademark for its products. The Complainant began to enter the Chinese market in 1987 and has since then been successful. In the same year, the Complainant filed the trademark applications in China Trademark Office. The Panel has no problem in finding that the Complainant enjoys the prior rights in the trademark “ferragamo” . The disputed domain name is “inferragamo.com” . As the suffix “.com” only indicates that the domain name is registered under this gTLD and is not distinctive, the Panel finds that the addition of a simple/common English word, such as the addition of a prep word “in” , to a trademark does not alter the underlying mark to which it is added. Therefore, main part of the disputed domain name “inferragamo” is confusingly similar to the Complainant’ s trademark “ferragamo” .

The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4 (a)(i) of the Policy

Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant's assertion is sufficient to establish a prima facie case under Policy 4 (a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. The act of registering the disputed domain name and the Respondent's like/dislike do not automatically endow any legal rights or interests with the Respondent.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- (i) Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have 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 you have engaged in a pattern of such conduct; or
- (iii) You have registered the domain name primarily for the purpose disrupting the business of a competitor; or
- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your 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 your website or location or of a product or service on your website or location.

Evidence shows that the Complainant's trademark "ferragamo" has achieved a strong reputation through use and the worldwide significance of the brand name. As such, the public has come to recognize and associate the Complainant's trademarks as originating from the Complainant and no other. The Complainant entered the Chinese market in 1987 and has since then set up about 40 franchised shops in 23 cities in China. The Respondent, as a Chinese resident, registered the disputed domain name and set up a website, which gives introduction to the Complainant. The above fact serves to prove that the Respondent is aware of the existence of the Complainant and its trademark. The action of registering the disputed domain name per se has constituted bad faith.

The evidence submitted by the Complainant shows that the Respondent is using the website of the disputed domain name to sell shoes at so-called affordable prices. This is use of the domain name of the type contemplated by Paragraph 4(b) (iv) of the Policy, and accordingly is further evidence of the registration and use of the domain name in bad faith.

Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

Status

www.inferragamo.com

Domain Name Cancel

Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the <inferragamo.com> domain name should be CANCELLED.

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