

**DISPUTE RESOLUTION SERVICE**

**D00011982**

**Decision of Independent Expert**

**PRADA S.A.**

and

**Mr Ronald Hernandez**

**1. The Parties:**

Complainant: PRADA S.A.  
23, Rue Aldringen  
Luxembourg  
L-1118  
Luxembourg

Respondent: Mr Ronald Hernandez  
7370 Highway 128  
Healdsburg  
Georgia  
95448  
United States

**2. The Domain Names:**

*miumiu.org.uk*  
*miumiuhandbags.co.uk*

**3. Procedural History:**

05 October 2012, 17:45, - the Dispute was received.  
08 October 2012, 11:11, - the Complaint was validated.  
08 October 2012, 11:34, - the Notification of the Complaint was sent to the Parties.  
25 October 2012, 02:30, - the Response reminder was sent.  
30 October 2012, 10:38, - no Response was received.  
30 October 2012, 10:38, - the Notification of no response was sent to the Parties.  
05 November 2012, 11:46, - the Expert decision payment was received.

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

- 4.1 The Complainant, a company incorporated in Luxembourg, sells a wide variety of goods including leather goods (such as bags, luggage and accessories), footwear, and clothing. It has stores in Milan, New York, Madrid, London, Paris, Tokyo and other International locations, and has an online presence (e.g. at [www.miumiu.com](http://www.miumiu.com) and [www.pradagroup.com](http://www.pradagroup.com)).
- 4.2 The Complainant owns a number of trade mark registrations for the name *MIU MIU* (the 'Name' or when referring to the trade mark, the 'Mark'). For example, the Complainant owns U.K. Registration No. 2138216A, which was first registered on 5 July 1997, and CTM Registration 4253191, which was first registered on 16 February 2006. Both those registrations are for, among other things, the sale of leather handbags and general clothing.
- 4.3 The Respondent registered the Domain Names on 30 May 2011.

#### **5. Parties' Contentions**

##### **The Complaint**

- 5.1 In summary, the Complainant submitted that the Domain Names should be transferred to it for the reasons below.

##### **The Complainant has Rights in the Domain Names**

- The Complainant submitted that the *MIU MIU* brand was established in 1993 and that the *Prada* and *MIU MIU* brands are well known Internationally, being widely represented in the U.S., as well as in Europe.
- The Complainant stated that it had advertised the Name/Mark widely through various advertising campaigns and through its stores in the U.K. and in the U.S.; the Complainant's *Prada* 'e-store' was launched in 2010, while the Complainant's *MIU MIU* 'e-store' went online in 2011.
- The Complainant explained that it had sought to protect the Name/Mark on the Internet and promote its brand online, by registering several domain names consisting of or comprising the Name/Mark under several different top-level domains. The Complainant's main websites being at [www.miumiu.com](http://www.miumiu.com) and [www.pradagroup.com](http://www.pradagroup.com).
- In light of the Complainant's substantial investments in advertising the Name/Mark, its marketing and sales of goods worldwide, its

consistent use of the Name/Mark for years, and its client base, the Complainant submitted that it has Rights in the Name/Mark.

- The Complainant submitted that the Domain Names are identical to the Name/Mark in which the Complainant has Rights, as the Domain Names in effect incorporate the whole of the Name/Mark.
- The Complainant also submitted that, while the *co.uk* Domain Name includes the non-distinctive element "handbags", it does not affect the confusing similarity between it and the Name/Mark and is only descriptive of one of the Complainant's main products which is sold through the Name/Mark.

The Domain Names, in the hands of the Respondent, are Abusive Registrations

- The Complainant submitted that the Respondent uses the Domain Names in a way which is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant (citing the DRS Decision in *Seiko* (DRS 00248) in support): which they are not.
- The Complainant reported that, at the time of drafting the Complaint, the *.org.uk* Domain Name redirected users to a website displaying the *MIU MIU* logo and images of past advertising campaigns, and that *prima facie* counterfeit *MIU MIU* branded products, alongside products of competitors, were offered for sale.
- Also, that the *.co.uk* Domain Name, although not pointing anymore to an active web site, had previously pointed to the website [www.keepwow.com/](http://www.keepwow.com/) and, subsequently, to a website offering for sale *prima facie* counterfeit *MIU MIU* products.
- The Complainant submitted that, given the "intensive use" of the Name/Mark by the Complainant since as early as 1993 and the amount of advertising and sales of the Complainant's products worldwide, it is "unconceivable" that the Respondent did not have actual knowledge of the Complainant's Name/Mark at the time of the registration of the Domain Names.
- The Complainant also submitted that the Respondent is gaining from the sales of products on the websites connected to each of the Domain Names (the "Websites") and that such conduct demonstrates that the Respondent did not intend to use the Domain Names in connection with any legitimate purpose.
- Also, the Complainant submitted that the Respondent has not provided any evidence of its use of, or demonstrable preparations

to use, the Domain Names in connection with a *bona fide* offering of goods or services before knowing about the Dispute.

- The Complainant submitted that the use of the Domain Names to advertise for sale *prima facie* counterfeit *MIU MIU* goods along with competitors' products is not a legitimate, non-commercial or fair use of the Domain Names without intent for commercial gain. (The Complainant cited in support the Nominet DRS decisions in *Pfizer Inc* (DRS 03244) and *EAS International B.V* (DRS 06133).)
- Finally, the Complainant submitted that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under *.uk* or otherwise) which correspond to well-known names or trade marks in which the Respondent has no apparent rights, and the disputed Domain Names are part of that pattern [two examples were given – *guccihandbags.co.uk*, *jeansuk.me.uk*].

**Respondent's response:**

5.2 No response to the Complaint was provided by the Respondent.

**6. Outstanding formal/procedural issues**

6.1 Although Nominet sent the Complaint to the Respondent as mentioned in section 3 above, no response has been provided by the Respondent to the Complaint. As no exceptional circumstances have been raised by the Respondent as to why no response has been received, the Expert has proceeded to a Decision (as per paragraph 15 b. of the Nominet DRS Procedure (the 'Procedure')).

6.2 While noting paragraph 15 c. of the Procedure (which states that in such circumstances, the Expert will draw such inferences as he considers appropriate), the Expert has drawn no inferences from the Respondent's failure to respond in this case, and has based his Decision on the facts and evidence before him.

6.3 It is important to note that the Complainant does not automatically receive the remedy it has requested merely because the Respondent has not responded to the Complaint (see, for example, Nominet DRS *equazen.co.uk* (DRS 02735) decision).

6.4 The Complainant also made submissions that the Respondent's failure to reply to the Complainant's *cease and desist* letters prior to the Complainant bringing the Complaint "amounts to adoptive admission of the allegations." However, the Expert has not placed any evidential weight on those submissions as he does not consider that they are relevant to Nominet's Dispute Resolution Policy (the "Policy") and consequently his decision.

## 7. Discussions and Findings

### *General*

- 7.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the Policy that, on the balance of probabilities<sup>1</sup>:

*“(i) [it] has Rights in respect of a name or mark which is identical or similar to the Domain Name [paragraph 2.a.i. of the Policy]; and,*

*(ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration [paragraph 2.a.ii. of the Policy].”*

- 7.2 Addressing each of these limbs in turn:

#### *i) Complainant's Rights*

- 7.3 Paragraph 1 of the Policy defines 'Rights' as:

*“[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;”*

- 7.4 The Complainant must have the Rights at the time of the complaint.<sup>2</sup>

- 7.5 The Expert notes that, as referred to by the Complainant at paragraphs 4.2 and 4.3 above, the Complainant is the proprietor of a number of well known trade marks in respect of the Name, and through longevity in the market place, reputation and sales has developed considerable goodwill and reputation in the Name/Mark.

- 7.6 Further, and in agreement with the Complainant, on the balance of probabilities the suffix "handbags" does not sufficiently distinguish the *.co.uk* Domain Name from the Name/Mark and that that suffix should be discounted from the consideration of whether that Domain Name is identical or similar to the Complainant's Name/Mark.

- 7.7 Given those factors, the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Name/Mark, which is identical to (for *.org.uk*) or is at least similar to (for *.co.uk*) the Domain Names. In concluding the above, the Expert has also disregarded the domain suffixes '*org.uk*' and '*co.uk*'.

<sup>1</sup> I.e. on the basis that the Complainant's case is more likely than not to be the true version, see <http://www.nominet.org.uk/disputes/drs/legalissues/>.

<sup>2</sup> See for example, Nominet Appeal decision, *ghd*, DRS No. 03078, at page 9, para 9.2.2.

*ii) Abusive Registration*

7.8 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;"*

7.9 In relation to i. above – the Expert considers that they were Abusive Registrations at the time the Domain Names were registered.

7.10 The Policy at paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Names were Abusive Registrations. Specifically, paragraph 3 a. i. C. includes reference to circumstances indicating that the Respondent registered the Domain Names primarily: "for the purpose of unfairly disrupting the business of the Complainant."

7.11 While it may be helpful to consider the Respondent's intentions at the time he registered the Domain Names (or indeed in relation to his subsequent use of the Domain Names), as the Respondent has not replied to the Complaint, the evidence available to the Expert is that provided by the Complainant.

7.12 Given the goodwill and reputation in the Name/Mark, as described for example at paragraph 5.1 above and summarised at paragraph 7.5 above, the Expert considers that the Respondent would have been well aware of the Complainant and its Name/Mark at the time of his registration of the Domain Names on 30 May 2011.

7.13 On the balance of probabilities, the Expert considers that the Respondent specifically chose the Domain Names in order to benefit from the reputation and goodwill of the Complainant and its *MIU MIU* brand: to attract to the Websites users who were looking to purchase the Complainant's goods, in order that those users then buy the Respondent's goods.

7.14 In this way, the Expert considers that such action took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

7.15 In relation to (ii) above – the Expert considers that they were Abusive Registrations through the use by the Respondent of the Domain Names.

7.16 The Policy sets out at paragraph 3 (a) (ii) that:

*"[there may be evidence of an Abusive Registration if there are] Circumstances indicating that the Respondent is using [...] 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;"*

- 7.17 As evidenced by the Website print-outs provided to the Expert by the Complainant, the Respondent has used both Websites to offer for sale the Complainant's goods (or counterfeit copies thereof) and the goods of the Complainant's competitors (such as Hobo or Totes). Such offerings compete directly with the Complainant.
- 7.18 On the balance of probabilities, given the use of the Complainant's logos on the Websites and the Websites' general make-up, the Expert considers that those accessing the Websites would likely be confused that they and the goods for sale on the Websites are the Complainant's (or are at least endorsed by the Complainant).
- 7.19 As previously mentioned, the Expert considers that using the Domain Names in this way has taken unfair advantage of the Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in the Name/Mark to generate web traffic to the Websites and, by doing so, divert potential Complainant customers to the Respondent.
- 7.20 Such use of the Domain Names as described above is also unfairly detrimental to the Complainant as the Complainant will likely have lost sales income as a consequence.
- 7.21 Finally, in its submission that the Domain Names are Abusive Registrations, the Complainant also refers in substance to the factor set out at paragraph 3 (a) (iii) of the Policy, which states that:

*"[there may be evidence of an Abusive Registration if the] Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;"*

- 7.22 In support of that submission, the Complainant gives the Respondent's registration of the domain names *guccihandbags.org.uk* and *jeansuk.me.uk* as evidence. The Expert notes that the aforementioned domain names were registered by the Respondent either on the day before or the same day as he registered the Domain Names. However, the Expert does not consider that, on the facts before him, two other registrations provide the sufficient evidence of a *pattern* of

registrations.<sup>3</sup> Therefore, the Expert does not consider that submission relevant to his Decision.

7.23 The Expert has considered whether there is evidence before him to demonstrate that the Domain Names are not Abusive Registrations (particularly in reference to paragraph 4 of the Policy) but does not consider there is.

## **8. Decision**

8.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in the Name/Mark which is identical to (for *.org.uk*) and at least similar to (for *.co.uk*) the Domain Names and that the Domain Names in the hands of the Respondent are Abusive Registrations. Therefore, the Expert directs that the Domain Names be transferred to the Complainant.

Signed: Dr Russell Richardson

Dated: 28<sup>th</sup> November 2012

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<sup>3</sup> For further discussion, see paragraph 3.5 of the Nominet Experts' Overview - [http://www.nominet.org.uk/sites/default/files/drs\\_expert\\_overview.pdf](http://www.nominet.org.uk/sites/default/files/drs_expert_overview.pdf).