

DISPUTE RESOLUTION SERVICE

D00015119

Decision of Independent Expert

Salvatore Ferragamo S.p.A.

and

Ms Natalie Misacas

The Parties

Lead Complainant: Salvatore Ferragamo S.p.A.

Via de Tornabuoni 2

Florence

FI

50100

Italy

Respondent: Ms Natalie Misacas

Torlundie 1108 Station Road

Ellon
Aberdeenshire
AB41 9AY
United Kingdom

The Domain Name

ferragamoshoes.co.uk

Procedural History

1. I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

2. The following is a summary of the relevant procedural steps in this dispute, -

26 November 2014	Complaint received by Nominet.
27 November 2014	Notification of Complaint sent to parties.
16 December 2014	Response reminder sent.
19 December 2014	No Response received and Notification of no Response sent to parties.

3. A copy of the Complaint with Annexes was sent by Nominet to the Respondent by post on 27 November 2014 and was delivered to the Respondent's registered address and signed for in the name of 'Misacas' on 28 November 2014. A copy of the Complaint with Annexes was also sent by Nominet to the Respondent by email on 27 November 2014 to an email address provided by the Respondent. Nominet was notified by the Mail

Delivery System on the same date that the email was undeliverable. Accordingly, I am satisfied that the Complaint was properly served in accordance with the DRS Procedure.

Factual Background

4. The Complainant is a company incorporated under Italian law. It is the well-known manufacturer and seller of shoes and articles sold under the name 'Salvatore Ferragamo' and 'Ferragamo'. It owns registered trademarks in many jurisdictions in the name 'Ferragamo' and related marks and its goods are sold from retail premises and online, from salvatoreferragamo.com and salvatoreferragamo.co.uk. A WHOIS search shows that the Domain Name was registered by the Respondent on 14 October 2012. A website associated with the Domain Name has been offering for sale shoes and other articles under the Ferragamo brand.

Parties' Contentions

The Complaint

5. The Complaint makes the following allegations, -
 - 5.1 The Complainant is a well-known Italian company which manufactures and sells high quality shoes, handbags and other articles such as leather goods and jewellery. It has been using the trade mark 'Ferragamo' since at least 1927 with respect to shoes and 1968 with respect to handbags.
 - 5.2 The Complainant sells its goods from retail stores in Italy, the UK and elsewhere and makes online sales of its trademarked goods from its web sites at salvatoreferragamo.com and salvatoreferragamo.co.uk.

- 5.3 During the last few years, the Complainant has spent worldwide an average of Euro 40 million per year on advertising and promoting its products, including products bearing 'Ferragamo' trade marks.
- 5.4 The Complainant owns the following registered trade marks, among others, -
- UK trade mark nos. 1001070 and 1001071 in the word mark SALVATORE FERRAGAMO;
 - Community trade mark no.000103259 in the word mark Ferragamo.
- 5.5 The registration of the Domain Name is abusive for several reasons. First, it is confusingly similar to the Complainant's Ferragamo mark. Second, it merely differentiates from that mark by the use of the generic term 'shoes', and the distinctive and prominent element of the Domain Name is the Complainant's mark. The only variation is the addition of a generic word or sign, which does not negate the confusing similarity between the Domain Name and the mark: see *Oakley, Inc. v. Joel Wong/Blue Host.com- INC*, WIPO Case No. D2010-0100 and other cases.
- 5.6 The suffix 'shoe' describes goods that Complainant actually offers through its website and other online platforms and as such should be considered 'completely insufficient to dispel user confusion from inevitably occurring. In fact, doing so very likely exacerbates than ameliorates the confusion', as held in *PepsiCo, Inc. v. QWO*, WIPO Case No. D2004 0865; see too DRS cases D00014445 and D00012904.
- 5.7 The Respondent is not affiliated in any way with Complainant and, to the best of the Complainant's knowledge, it does not own any trade

mark applications or registrations for ‘Ferragamoshoes’ or any similar marks in connection with any goods or services. Further, the Complainant has not licensed or otherwise authorized Respondent to use its ‘Ferragamo’ trade mark, or to apply for any domain name incorporating such mark.

5.8 The Respondent is not commonly known by ‘the domain names’ and does not make any legitimate commercial use of them either, since the sole activity carried out on the website is the unlawful sale of counterfeit ‘Salvatore Ferragamo’ products.

5.9 The domain names at issue were therefore primarily registered to unfairly disrupt the Salvatore Ferragamo business. The website hosted at the domain names is active in the sale of counterfeit Ferragamo articles: see in particular DRS cases D00014554 and. D00014281.

5.10 The Respondent’s bad faith is shown by the fact that she registered ‘the disputed domain name’ with a view to taking unfair advantage of the reputation of the Complainant’s mark and to confusing people into thinking that the website hosted on the same was controlled by the Complainant. The registration of ‘ferragamoshoes.co.uk’ confuses potential customers into believing that there is an affiliation between the Respondent and the Complainant and is intended to do so: see in particular the homepage of the website hosted on the domain name at issue which bears a picture of one of Ferragamo’s flagship stores (the store in Baku, Azerbaijan).

The Response

6. No Response was served.

Discussion and Findings

7. A complainant is required under subparagraphs 2a. and 2b. of the Dispute Resolution Service Policy (“the Policy”) to prove on the balance of probabilities that: -
 - 7.1 he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - 7.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.
8. I refer to the matters set out in paragraph 4 above and adopt them as findings of fact.

Rights

9. By paragraph 1 of the Policy, -

‘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 Complainant owns trade marks which include the following -

- UK trade mark no. 1001070 in the word mark SALVATORE FERRAGAMO covering goods in class 18 (leather articles);
- UK trade mark no. 1001071 in the word mark ‘SALVATORE FERRAGAMO’ covering goods in class 25 (including boots and shoes);

- Community trade mark no.000103259 in the word mark 'Ferragamo' in classes 3, 6, 9, 14, 16, 18, 24, 25, 26, 28, 33, 35 and 42 (covering a wide range of goods).

10. Accordingly, the Complainant has established that it owns Rights. The Rights that have been established subsist in the marks 'Ferragamo' and 'SALVATORE FERRAGAMO'. These marks are each similar to the Domain Name, which incorporates the whole of the word 'Ferragamo' and uses it as the most distinctive part of the Domain Name. Therefore, I conclude that the Complainant owns Rights in marks, namely 'Ferragamo and 'SALVATORE FERRAGAMO', which are each similar to the Domain Name. Thus, the Complainant has established that it has Rights in respect of a name or mark which is similar to the Domain Name.

Abusive Registration

11. By paragraph 1 of the Policy, -

'Abusive Registration means 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.'*

By paragraph 3 of the Policy, -

'3. Evidence of Abusive Registration

- a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:*
 - i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

- A. *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*
- B. *as a blocking registration against a name or mark in which the Complainant has Rights; or*
- C. *for the purpose of unfairly disrupting the business of the Complainant;*
- 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;*
....”

By paragraph 4 of the Policy, -

‘4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

.....’

12. The Domain Name incorporates the Complainant's word mark 'Ferragamo' as its most distinctive element. It also incorporates the name of goods associated with that mark, namely shoes. The Respondent has provided no explanation as to why she chose to register the Domain Name and it is difficult to conceive of any reason for that registration other than to create a representation connected to the Complainant's brand and trade marks. As a result, I find that the choice of the Domain Name was made with the Complainant in mind.

13. The Complainant did not authorise or licence the Respondent to register or use the Domain Name on or before the date of registration of the Domain Name and has not done so since.
14. The only evidence of use of the Domain Name since its registration is its use by the Respondent to host a website that bears the heading 'Ferragamo Shoes, Salvatore Ferragamo Shoes UK, Outlet Ferragamo'. A picture of a Ferragamo retail shop is featured under that heading, which is the Ferragamo retail shop in Baku. The website offers for sale articles held out as Salvatore Ferragamo goods, including varieties of shoe and other articles such as belts, wallets and watches. The copyright notice for the website states, 'Copyright © 2012 Salvatore Ferragamo Shoes UK Online Outlet. ...'.
15. In those circumstances, I find that the purpose of the registration was to create a false representation of a commercial connection between the Respondent and the business operated by the Complainant which makes and sells 'Ferragamo' shoes and other goods.
16. Persons using Google or other internet search facilities to look for Ferragamo shoes online are likely to type those two words into the search and to experience 'initial interest' confusion as a result, believing that the Domain Name is associated with the Complainant's business of selling 'Ferragamo' shoes and other goods. Once those persons are directed to the website associated with the Domain Name, their confusion is likely to be reinforced, confirming the impression of such a commercial connection. That is because the website gives the appearance, that is to say it makes the representation, that it is the UK online outlet for 'Ferragamo' shoes and for other 'Ferragamo' marked goods.
17. In registering the Domain Name, the Respondent is likely to have intended to use it with those purposes in mind; to trade off the back of the Ferragamo marks and business by creating the false representation that the Respondent's business is the UK online outlet for Ferragamo goods. No other purpose for

the registration has been contended for by the Respondent and none is likely on the evidence.

18. The evidence, although somewhat unclear in certain respects, does also establish that the goods offered for sale from that website are counterfeit 'Ferragamo' products. The 'affidavit' referred to in the Complaint is a signed declaration dated 27 October 2014 by Ms. Llaría Pecchioli, the 'Trademarks and Patents Specialist' of the Complainant. The declaration refers to her having 'analyzed' goods offered for sale from 'ferrragamoshoes.co.uk' (with 3 'r's). The screenshot referred to in the declaration and included as Annex 10 to the Complaint is of 'ferrragamoshoes.co.uk' i.e. of the Domain Name (2 r's), albeit that it post-dates the date of the signed declaration by nearly one month, being dated 25 November 2014.
19. Notwithstanding references in the Complaint to domain names in dispute (i.e. to more than one), the enclosure referred to in the declaration is the screenshot of the website at 'ferrragamoshoes.co.uk, i.e. the Domain Name. The evidence does not show whether the analysis referred to in the declaration was from any test purchase or was an inference, e.g. drawn from the prices shown on the website. However, despite the questions raised by the evidence relied on by the Complainant on this point, that evidence has persuaded me that the goods offered for sale on the website are likely to have been counterfeit 'Ferragamo' goods, particularly in view of the Respondent's failure to challenge the Complaint's case on this central matter.
20. I have concluded 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, because the registration was made with a view to unfairly disrupting the Complainant's business. I also find 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, being having confused and being 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. My reasons for these conclusions and findings are those in paragraphs 12-17 above. In other words, the Respondent registered and then used the Domain Name to create a false representation of a commercial connection with the Complainant: that the website associated with the Domain Name was the authorised online UK outlet for the sale of Ferragamo goods. As a result, the Domain Name is an Abusive Registration: see *Seiko UK Ltd v Wanderweb* DRS 00248.

21. My findings in paragraphs 18-20 above that the Respondent has offered for sale counterfeit 'Ferragamo' goods through that online shop constitute additional grounds which support the conclusion that the Domain Name is an Abusive Registration.

Decision

22. The Complainant has Rights in a name or mark, which is similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, I determine that the domain name 'ferragamoshoes.co.uk' be transferred to the Complainant, Salvatore Ferragamo SpA.

Signed:

Dated: 19.01.15

STEPHEN BATE