

.nz Dispute Resolution Service

DRS Reference: 784

Missoni SPA v Li Yu

Key words – Identical or Similar trademark - Registered mark – identical;
No rights – unfair registration – unfair use – unfairly disrupting
business of complainant and respondent having no connection
with name or trademark

1. Parties

Complainant:

Missoni SPA

Via I- Rossi, 52

21040 Sumirago (VA)

Italy

Represented by: Dr Fabrizio Bedarida

Respondent:

Li Yu

tanggou town North-west No.3

shuyang, suqian, 223611

CN (CHINA)

2. Domain Name

missoni.co.nz ("the **Domain Name**")

3. Procedural history

The Complaint was lodged on 28/05/2012 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 31/05/2012. The domain/s were locked on 21/05/2012, preventing any changes to the record until the conclusion of these proceedings.

There was no response filed by the Respondent.

The Complainant paid Domain Name Commission Limited the appropriate fee on 29/07/2012 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the **Policy**").

4. Factual background

The Complainant is an Italian fashion company with a world-wide coverage for its clothing and perfume products. It takes its name and trademark from the name of its designer, Ottavio Missoni.

The Complainant owns many trademarks either for the word 'MISSONI' alone or in combination with other words. The first filing for the MISSONI trademark was in Italy in 1969. This trademark was registered in New Zealand in 2009. It has been registered in many other countries.

The Complainant is the owner of many domain names, both top-level and country-specific. These domain names are registered in a large variety of countries.

The Complainant's main website is <missoni.com>. Through this and other websites, it has published information about its products for many years. Several decisions under the UDRP have affirmed the Complainant's world-wide reputation for its mark.

The disputed domain name resolves to a parking site called "OnlyDomains.com" said to be based in Hawkes Bay, New Zealand. The disputed domain name does not resolve to an active website.

The Complainant gave the Respondent no authorisation of any kind to reflect its trademark in a domain name.

5. Parties' contentions

a. Complainant

The disputed domain name is identical with the Complainant's trademark which is known world-wide.

The Respondent has no rights or interests such as would allow him to reflect the Complainant's trademark in a domain name. It is difficult to infer any legitimate use of the domain name by the Respondent who has never made any *bona fide* use of the domain name that currently resolves into a parking site.

The Respondent registered and is using the disputed domain name in bad faith for the following reasons:

- (i) The Missoni trademarks are renowned world-wide, as has been acknowledged by various WIPO Panels.
- (ii) The Respondent registered the disputed domain name on 17 October 2011, a few days after the launch of the 'Missoni for Target' collection on the website of Target – a large discount retailer in the United States. Registration at this time cannot have been a coincidence.
- (iii) There can be no plausible explanation for the Respondent's registration of the disputed domain name which is identical to the

Complainant's famous trademark, particularly when the disputed domain name resolves to a parking site.

- (iv) There are grounds to suspect that the Respondent is associated with an entity called 'Domain-Jet/Jack Sun/Namestar Inc' ('Domain Jet') which has the same telephone number and email address of the Respondent. This entity has registered hundreds of domain names, some corresponding to Missoni trademarks. It has also been involved in WIPO and NAF proceedings under the UDRP and has been found to have made abusive registrations of domain names.
- (v) Domain Jet was well aware of the Complainant's rights at the time of registration of the disputed domain name, as is shown by correspondence between the Complainant's lawyers and Mr Jack Sun in June 2011 concerning the possible transfer by Domain Jet to the Complainant of the domain name <missonifragrance.com> after a WIPO proceeding in respect of that domain name had been instituted against Domain Jet.
- (vi) The world-wide fame of the mark also creates a strong inference that the Respondent knew of the Complainant's rights at the date of registration. The use of the Complainant's entire trademark in the disputed domain name points strongly to the Respondent's bad faith and desire to trade on the goodwill of the Complainant's mark. The Respondent's passive holding of the disputed domain name does not confer any rights.

b. Respondent

The Respondent made no submissions.

6. Discussion and Findings

Because the Respondent chose not to make any factual submissions, the Expert has accepted the statements of fact made by the Complainant.

The first matter which the Complainant has to prove is that it has rights in respect of a trademark which is identical or similar to the Respondent's domain name. The disputed domain name is identical to the registered trademark MISSONI. Because the Complainant has traded under that name throughout the world, it is clear that the disputed domain name is identical to that trading name. The disputed domain name is also confusingly similar to the Complainant's other registered trademarks which incorporate the word "Missoni".

Accordingly, the Complainant has proved that it has rights in respect of a trademark which is identical to the disputed domain name.

The next matter that a complainant must prove is whether there has been an “unfair registration” which is relevantly defined in the Policy as:

“a domain name which either:

- (1) was registered or otherwise acquired in a manner which at the time when the registration took place took unfair advantage of or was unfairly detrimental to the Complainant’s rights; or
- (2) has been or is likely to be used in a manner which took unfair advantage of or was unduly detrimental to the Complainant’s rights.”

A non-exhaustive list of facts which may be evidence that a disputed domain name is an unfair registration is set out in paragraphs 5.1.1 to 5.1.5 of the Policy. The one relevant here is para. 5.1.2, viz:

- 5.1.2 Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant...”

In the present case, the inference is inescapable that the Respondent is using the disputed domain name in a way that is likely to confuse or mislead internet users into believing that the disputed domain name is registered to, operated or authorised by or otherwise connected with the Complainant. For the reasons noted by the Complainant, he must have known of the fame of the Complainant’s mark before he registered the disputed domain name.

The Respondent is clearly engaging in cybersquatting. He had no right to register this name. The world-wide fame of the Complainant as a manufacturer and retailer is clear.

The Panel has no hesitation in finding that the Complaint is proved.

7. Decision

The decision is that the disputed domain name <missoni.co.nz> should be transferred to the Complainant by the Respondent.

Place of decision Auckland

Date 11 July 2012

Expert Name Hon. Sir Ian Barker QC

Signature