

DECISION OF THE THIRD PARTY DECIDER

SALVATORE FERRAGAMO S.P.A. / RENZI AG

CASE NO 44410: FERRAGAMO.BE

1. The parties

1. The Complainant in the administrative proceedings is the Italian legal entity SALVATORE FERRAGAMO S.p.A., established in Italy, 50122 Firenze, Via dei Tornabuoni 2, represented by Carloalberto GIOVANNETTI, attorney, with offices located in Italy, 50122 Firenze, Corso dei Tintori 25, hereafter referred to as the “Complainant”.
2. Respondent is the Swiss legal entity RENZI AG, established in Switzerland, 6342 Baar , Haldenstr. 5, hereafter referred to as the “Respondent”.

2. Domain name

3. The domain name at issue is **Ferragamo.be**, registered on 1 November 2007, hereafter referred to as the “Domain name”.

3. Procedural history

4. On 29 August 2016, Complainant filed a complaint and 10 exhibits (hereafter the “Complaint”) to the Belgian Centre for Arbitration and Mediation (hereafter ‘Cepani’) concerning the Domain name. Respondent did not submit a response to the Complaint.

On 11 October 2016, Cepani invited Ms. Sari DEPREEUW to serve as a Third-Party Decider, who sent the signed declaration of acceptance, availability and independence to Cepani on the same day. The appointment was communicated in Cepani’s letter dated 13 October 2016, in which it was also stated that the deliberations would be closed on 20 October 2016 and that a decision was due on 3 November 2016 at the latest.

4. Factual information

5. The Complainant is an Italian company which is producing and selling *inter alia* fine shoes and handbags under the trade mark “Ferragamo” since 1927. It has retail stores in many countries, among which Belgium.

Complainant and supposedly associated companies also hold registrations for several domain names comprising the name ‘Ferragamo’, such as ferragamo.com.br, ferragamo.com.mx and salvatorferragamo.be (Complainant’s exhibits 3 and 4).

Complainant holds 400 registered trade marks and applications for trade marks (Complainant’s exhibit 7). In the context of the present dispute, it puts forward two registered trade marks in particular (Complainant’s exhibits 8):

- EU word trade mark “FERRAGAMO” No. 103259 covering goods in classes 3, 6, 9, 14, 16, 18, 24, 25, 26, 28, 33, 35 and 42, registered in 1998

- Italian figurative trade mark “Ferragamo” No. 1232276 covering goods in class 25, registered in 1937

Complainant brings several exhibits demonstrating its investment in advertising, its presence in fashion magazines and refers to exhibitions dedicated to its collections at the Los Angeles County Museum of Art and at the Guggenheim Museum in New York City (USA), in order to illustrate the worldwide reputation of the Ferragamo brand and its well-known trade mark (Complainant’s exhibits 5 and 6).

Respondent did not submit a response to the Complaint, hence little information is available concerning its activities. The Domain name was registered on 1 November 2007. It seems to have been used as an online shop for sports and outdoor gear (Complainant’s exhibit 10).

5. Position of the parties

a. Position of the Complainant

6. Complainant defends the position that all the conditions under article 10 (b) of the Terms and conditions of domain name registration under the “be.” domain operated by DNS BE (DNS BE Terms and Conditions) are met and consequently requests that the transfer of the Domain name be ordered.

- (i) The Domain name ferragamo.be is **identical** to the Complainant’s trade marks “Ferragamo”.
- (ii) Respondent has **no right or legitimate interest** in the Domain name, considering that Respondent is in no way affiliated with the Complainant and does not own any trade mark applications or registrations for ‘Ferragamo’ or any other mark comprising this sign in connection with any goods or services.
- (iii) Respondent’s Domain name has been registered or is being used in **bad faith**. Considering the worldwide reputation of the “Ferragamo” trade mark, Complainant holds that (i) Respondent uses the Domain name in view of taking unfair advantages of the sign, (ii) the registration of the Domain name will confuse potential customers as to the affiliation with Complainant, (iii) will make it more difficult for Internet users to localise Complainant’s own websites and (iv) will dilute Complainant’s “Ferragamo” trade marks.

b. Position of the Respondent

7. The Respondent did not provide any response.

6. Discussion and findings

8. The Third-party decider decides following the parties’ views and in accordance with dispute resolution policy, the registration agreement and the provisions of the Cepani Rules for domain name dispute resolution (“Rules”) (art. 16.1 Rules).

In the event of a default by one of the parties, i.e. a party does not comply with any of the time periods established by the Rules or the Third-Party Decider, the Third-Party Decider may proceed to a decision on the Complaint (art. 15 Rules).

9. Pursuant to article 10 (b) (1) of the DNS BE Terms and Conditions, the Complainant must assert and prove that:

- (i) the registrant's domain name is identical or confusingly similar to a trade mark, a trade name, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the complainant has rights; and
- (ii) the registrant has no rights or legitimate interests in the domain name; and
- (iii) the registrant's domain name has been registered or is being used in bad faith.

a. Identity

10. The Domain name is "ferragamo.be".

"Ferragamo" is a registered trade mark of Complainant (in particular EU trade mark No. 103259).

The Third-Party Decider finds that the Domain name is identical to EU trade mark No. 103259 of Complainant.

b. Rights or legitimate interest of Respondent

11. Complainant has the burden to prove the absence of rights or legitimate interests of Respondent in the Domain name. Complainant cannot be expected to bring evidence of a negative fact but should demonstrate that, considering the circumstances of the case, serious reasons exist for considering that the registrant has no rights or legitimate interests in the domain name (decision No. 44082 dated 23 May 2006, touringassurance.be).

On the basis of the print screen of the e-commerce outlet accessible via the Domain name (Complainant's exhibit 10), it can be observed that the name "Ferragamo" is not used as a trade name to offer goods (other than in the Domain name). On the contrary, it is referred to another website www.sports.discount.

Complainant points out that there is no affiliation between Respondent and Complainant and that Respondent does not seem to have any trade marks containing the sign "Ferragamo" in relation to any goods or services (Complainant's exhibit 9).

12. The registrant can demonstrate his/her rights or legitimate interests to the domain name by establishing that the circumstances described in article 10.3 DNS BE Terms and Conditions are present.

This has not been done. Respondent did not submit a response to the Complaint.

Absent such response and taking into account the available evidence (in particular Complainant's exhibit 10), it cannot be found that Respondent holds rights or legitimate interests in the Domain name.

c. Bad faith registration or use

13. Complainant must establish that the Domain name was registered or used in bad faith.

Such bad faith registration or use can be demonstrated inter alia in the circumstances described in article 10.2 DNS BE Terms and Conditions. This is not an exhaustive list.

It is accepted that a domain name is registered or used in bad faith, where it includes a reputed trade mark, which is widely known up to a point that the registrant knew or should have known the trade mark and its well-known reputation (case No. 44191, dated 24 March 2010, ryanair.be).

14. According to Complainant, Respondent registered the Domain name in view of taking unfair advantage of the worldwide reputation of the Ferragamo trade mark, which may lead to confusion as to the affiliation of Respondent with Complainant. It states that the use of the Domain name makes it more difficult for internet users to find Complainant's actual website and such use dilutes Complainant's Ferragamo trade mark.

15. It is established that Ferragamo is an internationally well-known brand, with many trade marks covering many territories, including the European Union. It is unlikely that Respondent was not aware of the existence and the reputation of Complainant's trade marks, yet it has registered and used the Domain name consisting of essentially the same well-known trade mark.

It seems established that Respondent registered and used the Domain name in order to obtain unfair advantages, in particular finding customers who would otherwise not have found its online commerce.

Absent a response from Respondent, no justification for such abusive registration and use can be found.

In view of these elements, the Third-party decider holds that Respondent has registered and used the Domain name in bad faith.

7. Decision

16. Considering that the cumulative conditions of article 10(b) of the DNS BE Terms and Conditions are met, the Third-party Decider rules pursuant to article 10(e) of the DNS BE Terms and Conditions that the Domain name be transferred to Complainant.

Brussels, 2 November 2016



Sari Depreeuw