

Case Number: JP2024-0001

## PANEL DECISION

### 1. The Parties

#### Complainant:

Name: PRADA S.A.

Domicile: [Contact details omitted] Luxembourg, Luxembourg

#### Registrant:

Name: Qin Zhendong

Domicile: [Contact details omitted]

### 2. The Disputed Domain Name

The Disputed Domain Name is <pradabeauty.jp>, registered on February 13, 2021 with JPRS.

### 3. Procedural History

As indicated in the Annex attached.

### 4. Factual Background

Whereas the Registrant has not submitted any formal response, the following information from the Complaint is found to be the factual background of this case.

The Complainant is a corporation selling leather handbags, travelling trunks, leather accessories and other articles, with its brand PRADA which dates back to the beginning of the last century. At present, the Complainant operates in 70 countries with approximately 13,700 employees.

The Complainant is the owner of the registered trademarks, PRADA and PRADA BEAUTY, including the following:

- Italian Trademark No. 362017000069322 (PRADA), registered on July 8, 1978;
- European Union Trademark No. 012443362 (PRADA), registered on May 13, 2014;
- International Trademark No. 650695 (PRADA), registered on December 15, 1995;
- Japanese Trademark No. 4188954 (PRADA), registered on September 18, 1998;
- International Trademark No. 823904 (PRADA BEAUTY), registered on March 11, 2004.

In addition, the Complainant operates <prada.com> and <prada-beauty.com>, each of which resolves to websites offering views of the merchandise by theme, photos, videos and text stories frame.

The Registrant registered the Disputed Domain Name <pradabeauty.jp> on February 13, 2021, which resolves an inactive website.

When the Complainant became aware of the unauthorized registration of the Disputed Domain Name, the Complainant instructed a web agency to contact the Registrant in order to ascertain its real intentions as to the Disputed Domain Name. The web agency sent an email to the Registrant, on November 22, 2023, and after some exchanges of emails the agency found that the Registrant would transfer the Disputed Domain Name for 36,000 Euro. Then the Complainant instructed a law firm to send a cease and desist letter, and the law firm sent it by email to the Registrant on December 29, 2023. On December 31, 2023, the Registrant replied to the law firm requesting 6,000 Euro for the transfer of the Disputed Domain Names to the Complainant.

## **5. Parties' Contentions**

### **A. Complainant**

As a preliminary issue, the Complainant requests that the language of the proceeding be English, among others, on the following reasons:

- Requiring the Complainant to translate the Complaint and all documents into Japanese would cause delay;
- The Disputed Domain Name is registered in Latin characters, including English term “beauty”;
- Prior to filing this Complaint, the Registrant replied in English to the communications sent by the web agency and the law firm instructed by the Complainant;
- The price for transfer of the Disputed Domain Name to Complainant indicated by the Registrant in the above reply was indicated in Euro, which reveals the Registrant’s familiarity with international transactions with European users, where English is the most used language;
- In the above reply, for the sale of the Disputed Domain Name, the Registrant proposed to use the Sedo domain name marketplace platform, in which English language is entirely used.

With regard to the merit of the case, the Complainant contends that each of the elements required under Article 4(a) of the JP Domain Name Dispute Resolution Policy (“Policy”) is determined to be satisfied as follows:

First, the condition that the disputed domain name is identical or confusingly similar to the trademark and other indication in which the complainant has rights or legitimate interests should be determined to be fulfilled, since the Disputed Domain Name incorporates the whole of Complainant’s trademark PRADA, and the non-distinctive element “beauty” does not affect the confusing similarity, and the Disputed Domain Name entirely reproduces the Complainant’s trademark PRADA BEAUTY.

Second, the condition that the Registrant has no rights or legitimate interests in respect of the disputed domain name should be determined to be fulfilled, since the Registrant is not a licensee, an authorized agent of the Complainant or in any other way authorized to use the Complainant’s trademarks, and no evidence shows that the Registrant is commonly known by a name corresponding to the Disputed Domain Name and the Registrant uses or used the Disputed Domain Name in connection with a legitimate non-commercial or fair use. Furthermore, the Registrant’s intention to sell the Disputed Domain Name to the Complainant demonstrates that the Registrant has no rights or legitimate interests in the Disputed Domain Name.

Third, the condition that the disputed domain name of the registrant has been registered or is being used in bad faith should be determined to be fulfilled, since the Registrant could not have possibly ignored the existence of the Complainant's well-known trademark PRADA when it registered the Disputed Domain Name, the Registrant has been pointing the Disputed Domain Name to an inactive website since its registration, and the Registrant expressed its intention to sell the Disputed Domain Name.

## **B. Registrant**

The Registrant did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **6.1 Preliminary Issue: Language of the Proceeding**

Article 11 (a) of the Rules for JP Domain Name Dispute Resolution Policy (the "Rules") provides that "(t)he language of the Proceedings shall be Japanese, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the proceeding".

In the present case, the Complainant requests that the language of the proceeding be English on the grounds summarized in 5.A above. The Panel finds the following factors significant in this regard:

- Being a corporation with its headquarters in Luxembourg, the use of Japanese language would produce undue burden on the Complainants in consideration of the absence of any response from the Registrant;
- The Disputed Domain Name includes an English term "beauty;"
- Prior to filing this Complaint, the Registrant replied in English to the communications sent by the web agency and the law firm working for the Complainant.

Considering the circumstances, the Panel determines English to be the language of this proceeding.

## **6.2 Substantive Elements of the Policy**

In accordance with Article 4(a) of the Policy, the Complainant must assert and prove the following three elements are present.

- (i) The domain name of the Registrant is identical or confusingly similar to any mark such as trademark or service mark in which the Complainant has rights or legitimate interests; and
- (ii) The Registrant has no relevant rights or legitimate interests in respect of the domain name; and
- (iii) The domain name of the Registrant has been registered or is being used in bad faith (unfair purpose).

### **A. Identical or Confusingly Similar**

It is established that the first element functions primarily as a standing requirement. The threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name.

The Complainant has shown with evidence the rights in respect of the trademarks PRADA and PRADA BEAUTY for the purposes of the Policy.

The Disputed Domain Name includes the Complainant's trademark PRADA with non-distinctive term "beauty." Regarding the Complainant's trademark PRADA BEAUTY, the Disputed Domain Name reproduces it without a space between "prada" and "beauty". The differences stated are insignificant and they do not have any effect to the determination that the Disputed Domain Name is identical or confusingly similar to the Complainant's trademarks.

Accordingly, the Panel finds the element (i) above has been established.

### **B. Rights or Legitimate Interests**

Although the overall burden of proof in the proceedings is on the complainant, it is established that proving the registrant lacks rights or legitimate interests in a disputed domain name may result in

the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the registrant fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Having reviewed the available facts stated in 5.A above, the Panel finds the Complainant has established a *prima facie* case that the Registrant lacks rights or legitimate interests in the Disputed Domain Name. The Registrant has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. In addition, the fact that the Disputed Domain Name resolves an inactive website shows that the Registrant has not used it for any legitimate purpose.

Accordingly, the Panel finds the element (ii) has been established.

### **C. Registered or Used in Bad Faith**

Regarding the requirement of bad faith registration, in consideration of the business activities of the Complainant’s business, among others, in leather handbags, travelling trunks and accessories with its brand PRADA for about 100 years, it is highly unlikely that the Registrant could have been unaware of the Complainant’s trademark PRADA at the time of registration of the Disputed Domain Name. Therefore, it is found that the Respondent registered the Disputed Domain Name in bad faith.

Regarding the requirement that the Registrant is using the Disputed Domain Name in bad faith, the Panel considers the fact that the Registrant offered to sell the Disputed Domain Name to the law firm working for the Complainant shows that the Respondent’s use of the Disputed Domain Name is done in bad faith.

Since the Respondent did not reply to the Complaint in this proceeding and noting the above, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.

Accordingly, the Panel finds the element (iii) has been established.

## **7. Decision**

For all the foregoing reasons, in accordance with Article 4.i of the Policy and Article 15 of the Rules, the Panel orders that the Disputed Domain Name <pradabeauty.jp> be transferred to the Complainant.

Decided on April 7, 2024

Masato Dogauchi

Sole Panelist

Japan Intellectual Property Arbitration Center

## **Annex: Procedural History**

### **(1) Submission of the Complaint**

The Japan Intellectual Property Arbitration Center (the “Center”) received the complaint (including related documents attached herewith) which includes the request to change the language of the proceedings from Japanese to English from the Complainant by Electronic Transmission on January 26, 2024.

### **(2) Fee Payment**

The Center received the entire fee from the Complainant on February 15, 2024.

### **(3) Confirmation of the Domain Name and the Registrant**

The Center made an inquiry of the registration data to the JPRS on February 15, 2024 and received from the JPRS the verification response confirming the Registrant named in the Complaint is listed as the registrant of the disputed domain name and the e-mail addresses, postal addresses, etc. of the registrant registered by the JPRS on February 15, 2024.

### **(4) Verification of the Formal Requirements**

The Center verified that the Complaint satisfied the formal requirements of the Policy and Rules on January 29, 2024.

### **(5) Commencement of the Proceeding**

The Center notified the Complainant, JPRS and JPNIC of the commencement of the Proceeding by Electronic Transmission on February 20, 2024. The Center sent the Registrant the Commencement Notice by postal service and Electronic Transmission on February 20, 2024. The Commencement Notice informed the Registrant of the commencement date of the Proceeding (February 20, 2024), the deadline for the submission of the Answer (March 21, 2024) and the means for the receipt and submission of documents and asked the Registrant to submit the opinion regarding the language of the proceedings. However, the Commencement Notice sent to the contact address was not delivered by the post office in China at the time of decision and has been put on hold.

### **(6) Submission of the Answer**

Since the Center did not receive the Answer by the deadline for submission, the Center sent a notice on non-submission of the Answer to the Complainant and the Registrant by Electronic Transmission on March 22, 2024, stating that "the Answer shall be deemed not to have been



submitted.” The Center did not receive the opinion regarding the language of the proceedings from the Registrant.

(7) Notice on the Appointment of the Panel and Scheduled Date of Decision

The Complainant elected to have the dispute decided by a single-member panel, and the Center appointed Professor Masato Dogauchi as the sole panelist and forwarded the case file to the Panel by Electronic Transmission on March 28, 2024. The Center notified the Complainant, the Registrant, JPNIC and JPRS of the appointed panelist and scheduled date of decision (April 17, 2024) by Electronic Transmission on March 28, 2024. The Panel submitted the declaration of impartiality and independence to the Center on March 30, 2024.

(8) Decision by the Panel

The Panel determined that the language of the proceedings shall be English, having regard to the circumstances of the proceedings, and then completed the review and rendered the decision on April 7, 2024.