

# DISPUTE RESOLUTION SERVICE

D00024303

## Decision of Independent Expert

PRADA S.A.

and

Tong Hao

### 1. The Parties:

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

Respondent: Tong Hao  
ZhejiangHangzhou  
Xihu  
HangZhou  
Zhejiang  
31000  
CN

### 2. The Domain Name:

pradabeauty.uk (the "Domain Name")

### **3. Procedural History:**

I 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.

28 December 2021 08:54 Dispute received  
29 December 2021 13:39 Complaint validated  
29 December 2021 13:48 Notification of complaint sent to parties  
18 January 2022 01:30 Response reminder sent  
21 January 2022 17:19 No Response Received  
21 January 2022 17:19 Notification of no response sent to parties  
26 January 2022 11:10 Expert decision payment received

### **4. Factual Background**

The Complainant, PRADA S.A., is an Italian fashion house and owner of the registered trade marks PRADA and PRADA BEAUTY. In 1913, Mario Prada opened an exclusive store selling handbags, travel trunks, beauty cases, jewellery, accessories and other luxury items. Following a period of international expansion in the late 1970's, the PRADA brand has become a widely recognized global brand in the fashion and luxury goods industries.

Prada today operates in 70 countries with approximately 13.988 employees. In the People's Republic of China, where the Respondent resides, the Complainant is present through a directly controlled company, PRADA Fashion Commerce (Shanghai) Co., Ltd., and retail stores located in major metropolitan areas, including Beijing, Chengdu, Dalian, Guangzhou, Hangzhou, Harbin, Qingdao, Shanghai, Shenyang, Shenzhen, Tianjin, Wenzhou and Xian.

The Complainant is the owner of numerous trade mark registrations for PRADA, including among them Italian Trademark Registration No. 362017000069322 (filed on 27 July 1977, registered on 8 July 1978), United Kingdom Registration No. 00001338825 (registered on 27 December 1989), and an international registration for PRADA BEAUTY under the Madrid Protocol (filed on 14 January 2004, registered on 2 September 2004). To protect and promote its PRADA mark on the Internet, the Complainant has registered over 260 domain names incorporating the word PRADA, under various top-level domains (TLDs), including, inter alia, <prada.com>, which it registered on 9 June 1997.

The Respondent registered the Domain Name on 30 March 2020. The Domain Name resolves to a parking page displaying commercial links related to the Complainant's field of activity which direct Internet users to the products of the Complainant's competitors.

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

#### Complaint

The Complaint alleges that the Complainant has Rights in respect of its PRADA name or mark through its ownership of numerous trademark registrations for the mark. The Domain Name consists of the Complainant's mark and the descriptive word "beauty", which does nothing to distinguish the Domain Name from the mark.

The Complainant avers that the Domain Name constitutes an Abusive Registration in the hands of the Respondent, as the Respondent has been redirecting visitors to the Domain Name since the registration to a website where Internet users can find sponsored links related to third-party online stores offering for sale the products of the Complainant's competitors. Accordingly, the Respondent is using the Domain Name in a way which is likely to confuse Internet users into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, which is not the case.

### Response

The Respondent did not file a response.

## **6. Discussions and Findings**

Paragraph 2 of the Policy requires the Complainant prove on the balance of probabilities it has Rights in respect of a name or mark which is identical or similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### Complainant's Rights

I am satisfied that the Complainant has established that it has a very well known international reputation, including in the UK and in China where the Respondent resides, in the name PRADA and has registered trade marks for PRADA and PRADA BEAUTY.

The Domain Name incorporates entirely and is the same as the Complainant's PRADA mark. The combination with the generic term "beauty", along with the TLD ".uk", which is directly referable to the Complainant's field of activity within the fashion and luxury goods industry, does not distinguish or differentiate the Domain Name from the Complainant's mark.

Accordingly, I find that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

### Abusive Registration

It is quite clear that the Domain Name was chosen because of its association with the Complainant and its products. The Domain Name incorporates entirely the Complainant's PRADA mark in combination with the generic term "beauty", which is directly referable to the Complainant's field of activity within the fashion and luxury goods industry.

Based on the unrefuted evidence of record, including screen shots of the

Respondent's website to which the Domain Name resolves, I find that the Domain Name is an Abusive Registration. The Respondent is using the Domain Name to obtain click-through revenues via a parking website operated by the third-party, which directs Internet users to sellers of products competitive with those of the Complainant. The Respondent's conduct has "taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights". In DRS 00248 (Seiko-shop.co.uk); DRS 07991 (toshiba-laptop-battery.co.uk) the appeals panel "regarded it as indicative of unfairness that the names [in which the Complainant had rights] were being used to sell products competitive with those of the complainant". See also paragraph 3.3 of Nominet Experts' Overview. ("In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods. ").

## 7. Decision

I find that the Complainant has Rights in a mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. I therefore direct that the Domain Name be transferred to the Complainant.

**Signed**

A handwritten signature in blue ink, appearing to be 'Mark Smith', written over a horizontal line.

**Dated**

9 February 2021