

**DISPUTE RESOLUTION SERVICE**

**D00014950**

**Decision of Independent Expert**

Salvatore Ferragamo S.p.A.

and

Jose PlazaRuiz

**1. The Parties:**

Complainant: Salvatore Ferragamo S.p.A.  
Via Dei Tornabuoni 2  
Florence  
FI  
50100  
Italy

Respondent: Jose PlazaRuiz  
Avenida de los Prunos 5  
spain  
Al Jawf  
28042  
Saudi Arabia

**2. The Domain Names:**

ferragamoonline.co.uk  
ferragamosale.co.uk

**3. Procedural History:**

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 a

such a nature as to call in to question my independence in the eyes of one or both of the parties.

27 October 2014 16:43 Dispute received  
28 October 2014 11:16 Complaint validated  
28 October 2014 11:25 Notification of complaint sent to parties  
14 November 2014 01:30 Response reminder sent  
15 November 2014 01:30 Response reminder sent  
19 November 2014 08:41 No Response Received  
19 November 2014 08:42 Notification of no response sent to parties  
27 November 2014 12:30 Expert decision payment received

#### **4. Factual Background**

The Complainant manufactures, markets and sells luxury shoes, handbags and accessories. The Complainant's products are sold globally, including in the United Kingdom.

The Complainant has used the FERRAGAMO trade mark since at least 1927 with respect to shoes and 1968 with respect to handbags. It owns a large portfolio of trade mark registrations for the FERRAGAMO and SALVATORE FERRAGAMO marks across the world. The following trade mark registrations are of particular relevance to the United Kingdom:

UK national registration No. 1001070 covering goods in class 18, filed on November 2, 1972 for the word mark SALVATORE FERRAGAMO;

UK national registration No. 1001071 covering goods in class 25, filed on November 2, 1972 for the word mark SALVATORE FERRAGAMO;

Community Trade Mark registration No.103259 covering goods in class 3, 6, 9, 14, 16, 18, 24, 25, 26, 28, 33, 35, 42 from April 20, 1998 for the word mark FERRAGAMO;

The Complainant enjoys a high profile in the luxury fashion industry. Its founder, Salvatore Ferragamo, originally achieved recognition by creating hand-made shoes for the film industry. He achieved a reputation as the "shoemaker to the stars", creating shoes for, among others, Gloria Swanson, Lillian Gish, Joan Crawford, Clara Bow, Greta Garbo, Sophia Loren, Susan Hayward, Marilyn Monroe and Audrey Hepburn.

Over the years the Complainant has received significant recognition. For example, the Los Angeles County Museum of Art in 1992 presented a retrospective exhibition of the life and work of this "Shoemaker of Dreams", entitled, "Salvatore Ferragamo: The Art of the Shoe", which presented over two hundred examples of his work. Similarly, an exhibition at the Solomon R. Guggenheim Museum in New York City, "The Italian Metamorphosis, 1943-1968", featured shoes designed by Salvatore Ferragamo.

The Complainant markets its products and its FERRAGAMO brand extensively. In each of 2011 and 2012, it spent an average of Euro 40 million on advertising and promotion.

The Complainant owns registrations for several domain names comprising the marks “Ferragamo” and “Salvatore Ferragamo”. These include “salvatoreferragamo.com”, “salvatoreferragamo.co.uk” and “ferragamo.net”. These domain names resolve to the Complainant’s website at [www.ferragamo.com](http://www.ferragamo.com) on which the Complainant promotes and sells its products which bear the trademarks “FERRAGAMO” and “SALVATORE FERRAGAMO”.

The Respondent registered [ferragamoonline.co.uk](http://ferragamoonline.co.uk) on 16 August 2014 and [ferragamosale.co.uk](http://ferragamosale.co.uk) on 12 June 2014. The Domain Names have been used as the address for websites offering goods for sale under the FERRAGAMO mark (the Respondent’s Websites).

## **5. Parties’ Contentions**

### *The Complainant*

The Complainant asserts Rights in the FERRAGAMO mark which predate the Respondent’s registration of the Domain Names. It relies on its trade mark registrations and its registration and use of its domain names. It also submits that the FERRAGAMO mark is inherently distinctive and that the distinctive character of the FERRAGAMO mark among the fashion industry and the public has been enhanced through the high profile use that has been made of it.

The Complainant asserts that the Domain Names are confusingly similar to its FERRAGAMO mark on the following grounds:

1. The Domain Names differentiate from the Complainant’s mark only through the use of the generic terms “online” and “sale”. It is well established that in cases where the distinctive and prominent element of a disputed domain name is the Complainant’s mark and the only variation is the addition of a generic word or sign, such variation does not negate the confusing similarity between the disputed domain name and the mark. The suffixes “sale” and “online”, which describe an activity and a way to get in touch with its customers that the Complainant offers through its website and other online platforms, should be considered insufficient to dispel user confusion from inevitably occurring.
2. The Respondent has no legitimate reason for registration of the Domain Names. It is not affiliated in any way with the Complainant and, to the best of the Complainant’s knowledge, does not own any trademark applications or registrations for “Ferragamoonline”, “Ferragamosale” or any similar marks in connection with any goods or services. Furthermore, the

Respondent is not commonly known by the Domain Names and does not make any legitimate commercial use of the FERRAGAMA O mark.

The Complainant submits that the Domain Names are Abusive Registrations under the DRS Policy on the following three grounds:

1. They were primarily registered to disturb the Complainant's business.

The Complainant has annexed to the Complaint a signed declaration from its Trademarks and Patents Specialist dated 27 October 2014 stating that, having analysed the products offered for sale on the Respondent's Websites, she is of the view that the products are illegitimate copies and that they bear counterfeit trademarks.

2. The Respondent registered the Domain Names to take unfair advantage of the reputation of the Complainant's FERRAGAMO mark and to confuse people into thinking that the websites operated under the Domain Names are affiliated to the Complainant. The Complainant annexes to the Complaint webpages from the Respondent's Websites which give an account of the Complainant's history, refer to one of the Complainant's UK flagship stores and incorporate links to official social networks profiles of the Complainant.
3. The Respondent is acting in bad faith. He owns several other domain names including well known trade marks belonging to third parties, such as christianlouboutindiscount.com and valentionshoessale.com. The Complainant submits that these domain names were registered with the aim of selling counterfeit goods or to be sold back to the legitimate trademark owner.

### *The Respondent*

The Respondent has made no submissions.

## **6. Discussions and Findings**

Under Paragraph 2 of the Nominet Dispute Resolution Service Policy (the Policy) In order for the Complainant to succeed it must establish on the balance of probabilities, both:

that it has Rights in respect of a name or 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 as defined in Paragraph 1 of the Policy.

### Rights

Rights are defined in Paragraph 1 of the Policy as follows;

*"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 has established that it owns registered Rights in the FERRAGAMO mark through its trade mark registrations, in particular Community Trade Mark 103259 for the FERRAGAMO word mark. The Complainant has also established that it owns unregistered Rights in the goodwill that has been generated through the long standing and extensive use and promotion of the FERRAGAMO mark. These Rights pre-existed the registration of the Domain Names earlier this year.

The next issue is to consider whether the marks in which the Complainant owns Rights are identical or similar to the Domain Names.

The Expert agrees with the Complainant's submission that the addition of the generic terms "online" and "for sale" to the Domain Names does nothing to detract from the impact of the FERRAGAMO mark. It is the FERRAGAMO mark which draws and holds the user's attention.

The Expert finds that the Domain Names are confusingly similar to the Complainant's FERRAGAMO mark.

It follows that the Complainant has established on the balance of probabilities that it has Rights in respect of names or marks which are identical or similar to the Domain Names. The first element of the criteria under the Policy has been satisfied.

### Abusive Registration

An Abusive Registration is defined in Paragraph 1 of the Policy as follows:

"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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights".

The Complainant submits that the Domain Names are Abusive Registrations because they were primarily registered to unfairly disrupt the Complainant's business and their use takes unfair advantage of the Complainant's Rights.

#### *Unfair Disruption*

The Complainant contends that the Respondent is offering counterfeit goods for sale on the Respondent's Websites. This submission is supported by a declaration from its in-house Trademarks and Patents Specialist which opines that, having analysed the products offered for sale on the Respondent's Websites, she is of the view that the products are illegitimate copies and that they bear counterfeit trademarks.

In relation to the evidential weight to be attached to the declaration, it is unclear whether the specialist has examined physical articles or whether she has restricted herself to analysis of the photographs on the Respondent's Websites. But the Expert is mindful that the Respondent has not challenged the opinion that the goods it is offering for sale are not genuine. It is a serious allegation to have made and one would expect a party in the position of the Respondent to refute it if were inaccurate.

The Expert therefore accepts for the purposes of this Decision that on the balance of probabilities the goods, or some of them, which are being offered for sale on the Respondent's Websites are counterfeit.

The Expert's findings that the Domain Names are being used to sell illegitimate copies of goods under the Complainant's trade marks gives rise to a strong inference that the Domain Names were intended to take unfair advantage of the Complainant and to unfairly disrupt the Complainant's business. The Expert accepts the Complainant's submission on this point.

#### *Unfair Advantage*

There is also no doubt in the Expert's mind that the Respondent's use of the Domain Names takes unfair advantage of the Complainant's Rights. In addition to the fact that the Respondent's Websites are offering copies of the Complainant's products under the Complainant's trade marks, the Respondent's Websites have been designed to give the impression that they are authorised websites. As the Complainant points out, there is a section giving an account of the Complainant's corporate history, there are links to the Complainant's social media addresses and there are references to one of its flagship stores. The Expert also notes from the screenshots produced by the Complainant and annexed to the Complaint, that the Respondent has asserted copyright in the websites in the following terms

“Copyright © 2014 Ferragamo Official Online Store” for Ferragamoonline.co.uk and “Copyright © 2014 Ferragamo Shop” for ferragamosale.co.uk. These features combine to create a strong impression that the Respondent’s Websites are operated by or linked to the Complainant. This is a seriously misleading impression.

The Expert finds that the content of the Respondent’s Websites are likely to confuse users into believing that the websites and products on offer under the Complainant’s marks are affiliated with or connected to the Complainant. Such confusion will result in lost sales to the Complainant and/or a loss of reputation. This takes unfair advantage of the Complainant’s Rights and causes unfair detriment to them.

It follows that the Complainant has established on the balance of probabilities that the Respondent’s registration of and use of the Domain Names constitute Abusive Registrations. The second element of the criteria under the Policy has also been satisfied.

#### *Pattern of Registrations*

In relation to the other domain name registrations owned by the Complainant, the Expert has noted the Complainant’s submissions but is of the view that as they stand they do not discharge the burden on the Complainant to establish a pattern of abusive registrations on the balance of probabilities. The Expert would require more information about how the Respondent has used the other domain names before making a positive finding on that point.

## **7. Decision**

The Domain Names in the hands of the Respondent are Abusive Registrations. The Expert directs that the Domain Names be transferred to the Complainant.

**Signed Sallie Spilsbury**

**Dated 16 December 2014**