

ADMINISTRATIVE PANEL DECISION

Lucchese, Inc. v. 布赵春 (Buzhaochun)

Case No. D2022-4749

1. The Parties

The Complainant is Lucchese, Inc., United States of America (“United States”), represented by Holland & Knight, LLP, United States.

The Respondent is 布赵春 (Buzhaochun), China.

2. The Domain Name and Registrar

The disputed domain name <lucchese--boots.com> is registered with Xiamen ChinaSource Internet Service Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 10, 2022. On December 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 13, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on December 13, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in Chinese on December 18, 2022.

On December 13, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On December 21, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.


The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Chinese of the Complaint, and the proceedings commenced on December 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 13, 2023.

The Center appointed Rachel Tan as the sole panelist in this matter on January 23, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.


4. Factual Background

The Complainant is a company from the United States, which offers a wide variety of products for men and women including boots, shoes, apparel, accessories, bags, and travel accessories.

The Complainant is the owner of range of trade marks incorporating the "Lucchese" element in the United States, including United States Trade Mark Registration No. 2951130 for LUCCHESE registered on May 17, 2005 in class 3, and United States Trade Mark Registration No. 4991257 for  registered on July 5, 2016 in classes 18 and 25.

The Complainant is the owner of the domain name <lucchese.com>.

The Respondent is 布赵春 (Buzhaochun), China.

The disputed domain name was registered on October 31, 2022. It resolves to a website in English which displays the Complainant's registered LUCCHESE and  marks. Further, it allegedly offers the same range of products as the Complainant's products and uses identical images from the Complainant's website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name consists of the identical LUCCHESE mark and is confusingly similar to its domain name <lucchese.com>. The addition of the word "boots" to the disputed domain name does not distinguish it from the Complainant's website but instead only makes the connection stronger, suggesting that it is the Complainant's official bootmaker store.

The Complainant further alleges that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to use or register the LUCCHESE mark, as part of a domain name or otherwise, and is not affiliated, connected, or associated with the Respondent. The Complainant does not sponsor or endorse the Respondent in any manner, nor has it authorized the Respondent to sell the Complainant's goods. The disputed domain name was only registered on October 31, 2022 and the Respondent has no history of an association with the Lucchese name, which dates back to 1883. The Respondent is not making any legitimate noncommercial or fair use of the disputed domain name. The purpose of the disputed domain name appears to be luring customers into purchasing the products displayed and/or provide sensitive financial or personal information derived from those purchases, with a false reliance that consumers will get the Complainant's authentic goods.

The Complainant finally claims that the disputed domain name was registered and is being used in bad faith. By using the disputed domain name that features the LUCCHESE mark and identical images of the Complainant's goods taken from the Complaint's website, the Respondent is intentionally attempting to attract, for financial gain, Internet users to the Respondent's website by creating a likelihood of confusion

with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location.

B. Respondent

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

6. Discussion and Findings

6.1 Language of the Proceeding

Initially, the Panel must address the language of the proceeding. Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The panel may choose to write a decision in either language, or request translation of either party's submissions.

In this case, the Registrar has confirmed to the Center that the language of the Registration Agreement as used by the registrant for the disputed domain name is Chinese. Although the Complainant filed an amended Complaint in Chinese, the Complainant has requested that English be adopted as the language of the proceeding for the reasons summarized below:

- (a) the disputed domain name and its content are in English; and
- (b) the disputed domain name is infringing a trade mark of a company from the United States.

It is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

The Panel having considered the circumstances finds that English shall be the language of this proceeding. The reasons are set out below:

- (a) the Complainant is based in the United States;
- (b) the disputed domain name resolves to a website in English;
- (c) the Center notified the Parties in English and Chinese of the Complainant's request for English to be the language of the proceeding, but the Respondent did not protest against this request;
- (d) the Respondent has failed to participate in the proceeding even though the Complainant filed the amended Complaint in Chinese; and
- (e) no foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

6.2 Analysis of the Three Elements

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has adduced evidence to demonstrate its established rights in the LUCCHESI mark.

The Panel notes that the LUCCHESE mark is wholly encompassed within the disputed domain name. The positioning of the LUCCHESE mark makes it instantly recognizable in the disputed domain name. In cases where a domain name incorporates the entirety of a trade mark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is accepted by previous UDRP panels that the addition to the complainant's trade mark of other words or terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element of the Policy. Accordingly, the additional punctuations "--" and the English word "boots" which is directly related to the Complainant's business, do not prevent a finding of confusing similarity between the disputed domain name and the Complainant's LUCCHESE mark. See section 1.8 of the [WIPO Overview 3.0](#).


It is permissible for the Panel to ignore the generic Top-Level Domain, in this case ".com". See section 1.11.1 of the [WIPO Overview 3.0](#). Consequently, the Panel finds that the disputed domain name is confusingly similar to the Complainant's LUCCHESE mark.

Accordingly, the Complainant has satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

In circumstances where the Complainant possesses exclusive rights to the LUCCHESE mark, whereas the Respondent seems to have no trade mark rights, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the burden of production shifts to the Respondent. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not provided evidence of a legitimate noncommercial or fair use of the disputed domain name or reasons to justify the choice of the term "lucchese". There is no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. In addition, the Complainant has not granted the Respondent a license or authorization to use the Complainant's LUCCHESE mark or register the disputed domain name.


The Panel notes that the disputed domain name resolves to a website in English which displays the Complainant's registered LUCCHESE and  marks. It allegedly offers the same range of products as the Complainant's products and uses identical images taken from the Complainant's website. The website does not accurately and prominently disclose a lack of a commercial relationship between the Complainant and the Respondent. Therefore, the facts do not support a claim of fair use under the "Oki Data test". See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Moreover, the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, the Complainant has satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant's LUCCHESE mark is registered well before the registration of the disputed domain name. Through use and advertising, the Complainant's LUCCHESE mark is known throughout the world. Search results using the term "lucchese" on the Internet direct users to the Complainant and their products, which indicates that an exclusive connection between the LUCCHESE mark and the Complainant has been established. As such, the Respondent either knew or should have known of the Complainant's LUCCHESE mark when registering the disputed domain name, see section 3.2.2 of the [WIPO Overview 3.0](#).

The Panel notes that the disputed domain name resolves to a website which displays the Complainant's registered LUCCHESE and  marks, as well as allegedly offers the same range of products as the Complainant's products and uses identical images from the Complainant's website. The Panel is of the view that the Respondent intentionally created a likelihood of confusion with the Complainant's LUCCHESE mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. This demonstrates bad faith use of the disputed domain name, as provided in paragraph 4(b)(iv) of the Policy.

Taking into account these circumstances, the Panel finds that the Respondent must have known of the Complainant before registering the disputed domain name and, considering the Respondent's lack of rights or legitimate interests, and by registering and using the disputed domain name as discussed above, the Panel is led to conclude that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied the third element under paragraph 4(a) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <lucchese--boots.com>, be transferred to the Complainant.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: February 6, 2023