

ADMINISTRATIVE PANEL DECISION

Lulu Guinness Limited v. Yong Xiong
Case No. D2024-2773

1. The Parties

The Complainant is Lulu Guinness Limited, United Kingdom, represented by Fieldfisher LLP, United Kingdom.

The Respondent is Yong Xiong, China.

2. The Domain Name and Registrar

The disputed domain name <newluluguin.com> (the “Disputed Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 8, 2024. On July 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 11, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 of the Complaint, and the proceedings commenced on July 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 9, 2024.

The Center appointed Douglas M. Isenberg as the sole panelist in this matter on August 23, 2024. 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 states that it is “a British retail company founded in 1989 by Lulu Guinness OBE and is famous for handbags and accessories”; that it “operates multinationally, selling its creations online at “www.luluguinness.com” and shipping to 130 countries”; that it “has developed a reputation as an iconic British fashion designer with many museums, including London’s Victoria & Albert Museum, housing them as part of their permanent collections”; and that its “handbags and accessories have been worn by many public figures including Her Royal Highness Queen Camilla, Kate Moss, Dita von Teese, Helena Bonham Carter, Katy Perry, Rachel Weisz, Keira Knightley, Sienna Miller and Alexa Chung.”

The Complainant also states, and provides evidence to support, that it is the owner of at least 10 trademark registrations for the mark LULU GUINNESS (the “LULU GUINNESS Trademark”) in the United States of America (“United States”), the United Kingdom, the European Union, Australia, China, and Japan, including the following:

- United Kingdom Trade Mark No. UK00902354074 (registered October 10, 2003) for use in connection with, inter alia, handbags.
- United States Reg. No. 3145799 (registered September 19, 2006) for use in connection with “[r]etail store services, retail mail order services and on-line retail store services featuring clothing and fashion accessories”
- European Union Trade Mark No. 002354074 (registered October 10, 2003) for use in connection with, inter alia, handbags.

The Disputed Domain Name was created on September 9, 2022. According to the Complaint, and as supported by an annex provided by the Complainant, the Disputed Domain Name is used in connection with a website that includes a header with the LULU GUINNESS Trademark; offers for sale bags and accessories; and describes itself as “Cheap Lulu Guinness Store.”

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainant contends that:

- The Disputed Domain Name is confusingly similar to the LULU GUINNESS Trademark because, inter alia, the Disputed Domain Name “reproduces a dominant feature of the complainant’s highly distinctive and well-known trademark ‘LULU GUINNESS’”; “[t]he element ‘new’ is descriptive and non-distinctive”; and “[t]he broader context of the Respondent’s website also supports a finding of confusing similarity.”
- The Respondent has no rights or legitimate interests in the Disputed Domain Name because, inter alia, “[t]he Respondent’s name, Yong Xiong, does not bear any resemblance to ‘LULU GUINNESS’ or ‘luluguin’”; “the Respondent appears to be using the [Disputed] Domain Name to conduct unauthorised activities,” either by selling counterfeit products or selling genuine products without consent; and “Complainant has also never licensed or otherwise authorized the Respondent to register any domain name resembling its trademark.”
- The Disputed Domain Name was registered and is being used in bad faith because, inter alia, “Respondent’s website explicitly asserts itself to be associated with the Complainant’s LULU

GUINNESS brand”; the Respondent is “presenting the website as if it is an official Lulu Guinness website, which it is not”; and the Respondent “set out to conceal the true origin of its operation and present itself as a legitimate American business when it in fact is not,” as evidenced by the fact that the address on the website “is not linked to any real commercial premises when inputted into Google Maps.”

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that “at least a dominant feature of the relevant mark is recognizable in the domain name.” [WIPO Overview 3.0](#), section 1.7. Plus, “panels have [...] taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears prima facie that the respondent seeks to target a trademark through the disputed domain name.” [WIPO Overview 3.0](#), section 1.15. Given that the Respondent’s website uses the LULU GUINNESS Trademark and purports to offer for sale goods associated with the LULU GUINNESS Trademark, it is obvious that the Respondent seeks to target the LULU GUINNESS Trademark.

Although the addition of other terms (here, “new”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Disputed Domain Name and the LULU GUINNESS Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a 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 domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent 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 such as those enumerated in the Policy or otherwise.

Further, as set forth in section 2.13 of [WIPO Overview 3.0](#): "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent." Complainant has alleged (and provided evidence in support thereof) that the Respondent has created a website prominently displaying the LULU GUINNESS Trademark, displaying a picture of the Complainant's founder, and using copyrighted images from the Complainant's website – a clear attempt to pass itself off as the Complainant.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. In this case, the Complainant has specifically argued that bad faith exists pursuant to paragraph 4(b)(iv) of the Policy: "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

As set forth in section 3.1.4 of [WIPO Overview 3.0](#), using a Disputed Domain Name "for per se illegitimate activity such as the sale of counterfeit goods [...] is manifestly considered evidence of bad faith." In this case, it is unclear whether the Respondent is selling counterfeit goods; whether it is not actually shipping any goods at all; or whether it is somehow offering the Complainant's legitimate goods for sale without the Complainant's consent. In any event, the Respondent did not respond to the Complaint, and it is clear that the Respondent's commercial website falsely purports to be a website of the Complainant. Therefore, the Panel finds that the Respondent has created a likelihood of confusion as provided in paragraph 4(b)(iv) of the Policy.

The Panel finds that the Complainant has established the third element 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 <newluluguin.com> be transferred to the Complainant.

/Douglas M. Isenberg/

Douglas M. Isenberg

Sole Panelist

Date: September 5, 2024