

ADMINISTRATIVE PANEL DECISION

Guccio Gucci S.p.A. v. Ha Duc Manh, QUACH DINH VIET DUC, Lai Tien Thanh, and NGUYEN THI XOAN
Case No. D2024-2876

1. The Parties

The Complainant is Guccio Gucci S.p.A., Italy, represented by Studio Barbero S.p.A., Italy.

The Respondents are Ha Duc Manh, Viet Nam; QUACH DINH VIET DUC, Viet Nam; Lai Tien Thanh, Viet Nam; and NGUYEN THI XOAN, Viet Nam.

2. The Domain Names and Registrar

The disputed domain names <gucci-offical.com>, <guccioffice.asia>, <gucci-official.asia>, and <gucci-official.website> are registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 15, 2024. On July 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 17, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondents and contact information in the Complaint.

The Center sent an email communication to the Complainant on July 19, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amendment to the Complaint on July 19, 2024.

The Center verified that the Complaint together with the amendment to 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 Respondents of the Complaint, and the proceedings commenced on July 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 18, 2024. Two Respondents sent four email communications to the Center on August 7, August 8, and August 20, 2024, respectively.

The Center appointed Marilena Comanescu 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, an Italian Public Limited company founded in 1921 in Florence, Italy, is currently part of the international conglomerate company Kering, one of the leading groups worldwide in apparel and accessories.

The Complainant owns worldwide trademark registrations for or including the mark GUCCI, such as the following:

- the International trademark registration number 429833 for the GUCCI (word), registered on March 30, 1977, covering goods in International Classes 3, 14, 18, and 25;
- the International trademark registration number 1184004 for the GUCCI (word), registered on May 6, 2013, designating, inter alia, Viet Nam, covering services in International Class 35; and
- the Viet Nam trademark registration number 4-0017537-000 for the GUCCI (stylized), filed on December 9, 1994, and registered on August 9, 1995, covering goods in International Classes 3, 14, 18, and 25.

The Complainant's GUCCI mark was ranked at position 31 in the 2020 World's Most Valuable Brands list provided by Forbes, with a brand value of USD 22.6 billion, and it was also listed at position 34, according to the Interbrand "Best Global Brands" ranking in 2023.

The Complainant owns numerous domain names including GUCCI, the main one being the domain name <gucci.com>, registered on June 5, 1996.

The disputed domain names were registered as follows:

- on December 5, 2023, was registered <gucci-official.website>;
- on October 26, 2023, was registered <guccioffice.asia>;
- on February 22, 2024, was registered <gucci-offical.com>; and
- on June 8, 2024, was registered <gucci-official.asia>.

At the time of filing the Complaint and based on the record, the disputed domain names <gucci-offical.com>, <guccioffice.asia>, and <gucci-official.website> have been directed to static pages publishing a notice in Vietnamese reading: "Your domain has been successfully pointed! Please publish Landing Page with the above domain to use the service. Thank you." The disputed domain name <gucci-official.asia>, redirected to a webpage stating: "Your destinate url doesn't exist/Your domain not in redirect or frame record/Your destinate url having wrong format concerned".

According to evidence in the Complaint, the disputed domain names <gucci-official.website>, <guccioffice.asia>, and <gucci-official.asia> have been used to create internal webpages based on the

disputed domain names, where the GUCCI trademark and the Complainant's company details were published without authorization and purported GUCCI products were offered for sale at discounted prices. The copyright lines of the websites under these disputed domain names claimed copyright protection and no information about the name and identity of the entity operating the websites was provided. Moreover, Internet users were invited to provide personal information to finalize the online purchase.

According to evidence in the Complaint, the disputed domain name <gucci-offical.com> was used to send email communications to users who made orders on the websites under the disputed domain names. Such emails featured, in the body of the email, the Complainant's trademark and links to the Complainant's official website. At the time of filing the Complaint, mail exchange ("MX") records are still configured on the disputed domain name <gucci-offical.com>.

The Complainant sent several Cease-and-Desist letters to the Respondents and to the hosting provider between June 24, 2024 and July 12, 2024, in relation to the disputed domain names. The Respondents did not respond. The content on part of the disputed domain names has been deactivated by the hosting provider.

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 names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to its internationally well-known trademark GUCCI as they incorporate the trademark with additional non-distinctive elements; that the Respondents have no rights or legitimate interests in the disputed domain names; that the Respondents registered and are using the disputed domain names in bad faith in order to impersonate the Complainant either: by creating internal webpages where the Complainant's trademark and GUCCI product images were published, along with the Complainant's contact details, and purported GUCCI products – probably counterfeit – were offered for sale at highly discounted prices; or using the email address corresponding to the disputed domain name <gucci-offical.com> to send misleading email communication as part of a scheme to trick recipients into believing that they made orders on the Complainant's official website; the bad faith use of the Policy includes not only positive action but also passive holding; the Respondents failed to reply to its Cease-and-Desist letters and subsequent reminders and this can also be evidence of bad faith.

B. Respondents

The Respondents did not formally reply to the Complainant's contentions.

Two Respondents sent four email communications to the Center on August 7, August 8, and August 20, 2024 stating basically that they are willing to transfer the disputed domain names to the Complainant.

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondents have no rights or legitimate interests in the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes that the disputed domain names (i) are registered with the same Registrar; (ii) share the same name servers and the same registrant country; (iii) were created in a similar manner, reproducing the Complainant's trademark GUCCI followed by additional terms, "official" (including the misspelling "offical"), respectively "office"; (iv) were used to impersonate the Complainant: either resolving to similar commercial websites featuring the Complainant's information details, GUCCI trademark, official images, and offering for sale purported GUCCI products at discounted prices (the disputed domain names <guccioffice.asia>, <gucci-official.asia>, and <gucci-official.website>), or as email address to confirm the commercial orders made by the Internet users on the websites under the disputed domain names (the disputed domain name <gucci-offical.com>); (v) their registrants have numerous similarities such as shield companies, registrant city, province, postal code, a pattern of irregularities, in particular inaccurate postal addresses; and, (vi) the Respondents have not objected to the consolidation claims made by the Complainant.

In its email communication of August 20, 2024, the Respondent, QUACH DINH VIET DUC, claims it has control only over the disputed domain name <gucci-official.website>. However, given the similarities above mentioned, the Panel concludes that it is most likely than not that the disputed domain name registrants are the same entity or mere alter egos of each other, or at least under common control.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

B. 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 names. See section 1.7 of the [WIPO Overview 3.0](#).

Based on the available record, the Panel finds 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 the mark is recognizable within the disputed domain names. Accordingly, each of the disputed domain names is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, “offical”, “official”, “office”, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark 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.

C. 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 record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

In the email communications sent to the Center, the Respondent basically acknowledged the Complainant’s rights in GUCCI mark, and consequently, the Respondent’s lack of rights in the disputed domain names.

According to the evidence in the Complaint, the Respondent has used the disputed domain names <guccioffice.asia>, <gucci-official.asia>, and <gucci-official.website> in connection with websites promoting and offering for sale goods identical to those of the Complainant with significant price reductions, reproducing the Complainant’s trademark and product images, without providing any disclaimer or information about the registrant of the disputed domain names or the registrant’s relationship (in fact the lack thereof) with the trademark holder.

According to the evidence in the Complaint, the Respondent has used the disputed domain name <gucci-official.com> to send emails confirming the orders made by the Internet users on the websites under the disputed domain names, inserting in such emails the Complainant’s trademark and official website.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Further, the composition of the disputed domain names combine the Complainant’s well-known trademark with dictionary non-distinctive terms suggesting an affiliation with the Complainant. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

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

D. 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 the present case, the Panel notes that the disputed domain names were registered in bad faith, with knowledge of the Complainant and its trademark particularly because the Complainant's trademark predates the registration of the disputed domain names by more than 40 years and is highly distinctive and well-known worldwide. Furthermore, the use of some of the disputed domain names supports such finding.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain <guccioffice.asia>, <gucci-official.asia>, and <gucci-official.website> incorporate the Complainant's trademark with additional dictionary terms, and the websites operated under the disputed domain names display the Complainant's trademark, product images, claim copyright protection, have no disclaimer and no information about the entity operating the websites under the disputed domain names, indeed in this Panel's view, the Respondent has intended to attract Internet users accessing the websites corresponding to the disputed domain names who may be confused and believe that the websites are held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain.

According to the evidence provided in the Complaint and unrefuted by the Respondent, the disputed domain name <gucci-offical.com> was used to send misleading email confirmations of purchases made on the websites under the disputed domain names, using, as well, the Complainant's trademark and official website. Panels have held that the use of a domain name for illegal activity (e.g., impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

At the time of filing the Complaint, the disputed domain names direct towards inactive/static pages. It should also be noted that the absence of content in the disputed domain names does not prevent a finding of bad faith under the Policy considering the circumstances of this case. [WIPO Overview 3.0](#), section 3.3.

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

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 names, <gucci-offical.com>, <guccioffice.asia>, <gucci-official.asia>, and <gucci-official.website>, be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: September 6, 2024