

ADMINISTRATIVE PANEL DECISION

Guccio Gucci S.p.A. v. libin
Case No. D2024-3827

1. The Parties

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

The Respondent is libin, United States of America.

2. The Domain Names and Registrar

The disputed domain names <gucciancora.live>, <gucciancora.online>, and <gucciancora.shop> are registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 19, 2024. On September 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 21, 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 Respondent (“Redacted for Privacy, Super Privacy Service LTD c/o”) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 23, 2024, 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 on September 24, 2024.

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 of the Complaint, and the proceedings commenced on September 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 18, 2024. In light of an administrative oversight, the due date was then extended until October 24, 2024, but no response was received.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on November 7, 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.

As the registration of the disputed domain names expired on September 23, 2024 the Complainant provided payment of a one year renewal fee to ensure they remain registered during this process.

4. Factual Background

The Complainant is an Italian Public Limited Company which belongs to the international conglomerate company Kering, a leading group worldwide in apparel and accessories.

The Complainant has many trademark registrations around the world including Italian Trademark Registration No. 362016000132789 for GUCCI filed on December 30, 2016, and registered on September 6, 2017, in class 42; the Italian trademark originally filed on January 13, 1977, and registered on March 30, 1977, with registration number 302066; International Trademark Registration No. 429833 for GUCCI, registered on March 30, 1977, in classes 3, 14, 18, and 25; International Trademark Registration No. 457952 for GUCCI registered on December 16, 1980, in virtually all classes; European Union Trademark Registration No. 000121988 for GUCCI, filed on April 1, 1996, and registered on November 24, 1998, in virtually all classes; United States Trademark Registration No. 5119544 for GUCCI, filed on July 26, 2016 and registered on January 10, 2017, in international classes 24 and 25; and United States Trademark Registration No. 4563132 for GUCCI filed on October 31, 2013 and registered on July 8, 2014, and duly renewed, in international class 18.

The disputed domain names were registered on September 23, 2023

The Complainant is the owner of a number of domain names identical to or similar to the trademark GUCCI, including the domain name <gucci.com>, registered on June 5, 1996, which directs to its official website.

The disputed domain names now resolve to error pages, but previously resolved to parking pages with click through links. The Complainant sent several cease-and-desist letters. The Respondent made numerous offers to transfer the disputed domain names for consideration from the Complainant (first EUR 3,800 for <gucciancora.shop>, then 18,000 for all three, then 12,000), which the latter rejected.

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.

In September 2023, the Complainant launched a campaign to promote the collection created by its new Creative Director Sabato De Sarno under the name "Gucci Ancora", first presented on September 22, 2023, during Milan Fashion Week. The Complainant asserts that its "Gucci Ancora" campaign has been widely advertised through national and international media, fashion magazines and newspapers and on Gucci's official social media accounts, as well as on the Gucci Art Wall and on monuments and billboards in the most famous cities worldwide. The Complainant also contends that in light of its substantial investments in advertising, marketing and sales, its consistent use of the logo GUCCI for decades, and its large client base across all product groups, GUCCI is indisputably a well-known trademark worldwide.

The Complainant asserts that the disputed domain names were registered by the Respondent without the Complainant's authorization, on September 23, 2023 – i.e. the day after the Complainant's first presentation of the "Gucci Ancora" collection, during the Milan Fashion Week.

The Complainant points out that the disputed domain names were originally redirected to webpages where they were offered for sale, without specifying the requested consideration. On February 20, 2024, the disputed domain names were redirected to webpages where they were offered for sale for a consideration of USD 5,800.

On February 28, 2024, the Complainant says that the domain name <gucciancora.online> resolved to a parking page featuring sponsored links. The domain names <gucciancora.shop> and <gucciancora.live> were subsequently also redirected to parking pages with commercial links, respectively on May 7, 2024 and on September 11, 2024. The Complainant contends that, by definition, a “sponsored link” is generating revenues for the registrar and/or for the domain name holder. The Complainant says that at the time of the drafting of the present Complaint, the disputed domain names were pointing to error pages of the platform “dan.com”.

The Complainant contacted the Respondent by way of a web agency, and there were a number of subsequent communications between the parties. The Respondent asked for a sum of money for the transfer, initially of one of the disputed domain names and subsequently for all of them. The Complainant did not accept any of these requests. The Complainant then sent a cease-and-desist letter and the final offer that followed from the Respondent was to transfer all three disputed domain names for 5,000 Euros. In further correspondence with the Complainant, the Respondent asserted that he had rights in the disputed domain names, that his actions did not amount to an infringement of the Complainant’s intellectual property rights and denying any risk of confusion between the disputed domain names and the Complainant’s trademark.

The Complainant asserts that the Respondent, despite denying that he in any way infringed the Complainant’s rights, also indicated that he was available “to reach an amicable resolution with Gucci regarding the use of the domain name”. As the Respondent was offering the disputed domain names for sale by listing them on the domain marketplace “dan.com” for a consideration of USD 5,800, on February 20, 2024, the Complainant’s representative also sent an email to “dan.com”, requesting delisting from their platform. A representative of “dan.com” then opted to comply with the Complainant’s request, by proceeding with the delisting of the disputed domain names.

Further the Complainant contends that the disputed domain names entirely incorporate the Complainant’s registered trademark GUCCI, with the mere addition of the dictionary term “ancora” (“again” or “still” in Italian), which it says does not amount to a distinguishing feature. What is required is that the trademark be recognizable in the disputed domain name, the Complainant contends, which is the case here. The addition of the term “ancora” is also likely to may induce users to believe that the disputed domain names are owned and used by the Complainant to promote the campaign “Gucci Ancora”.

The Complainant points out that the Respondent is not a licensee nor an authorized agent of the Complainant or in any other way authorized to use the Complainant’s trademark GUCCI. There is also no evidence that he is commonly known in a manner corresponding to the disputed domain names as an individual, business, or other organization. The Complainant says there is no evidence of use in connection with a bona fide offering of goods or services, and that the disputed domain names are currently pointing to error pages on the platform “dan.com”. Such passive use is to be considered neither as a bona fide offering of goods or services nor as a legitimate noncommercial or fair use of the disputed domain names. The Complainant contends there is a high risk of implied affiliation with the Complainant.

In addition to the above, the Complainant contends that the Respondent’s offer to sell the disputed domain names for amounts exceeding out-of-pocket costs directly related to them clearly shows that the Respondent had no intention to use them in connection with a bona fide offering of goods or services or for a legitimate noncommercial or fair use. The disputed domain names have also been redirected to webpages displaying sponsored links, which generate revenue, via the pay-per-click system, to the domain holder and/or to the Registrar.

Further, the Complainant contends that in light of the fact that the trademark GUCCI is well-known and used since as early as 1921, it is inconceivable that the Respondent was unaware of the existence of the

Complainant or the Complainant's GUCCI trademark. The Complainant contends that the misappropriation of a well-known trademark as a domain name by itself constitutes bad faith registration. Furthermore, the Respondent registered the disputed domain names on September 23, 2023, one day after the Complainant first presented to the public its collection "Gucci Ancora", during the Milan Fashion Week.

As for bad faith use, the disputed domain names were at one point redirected to websites where they were offered for sale for USD 8,500. Moreover, the Respondent requested consideration well over out-of-pocket costs. The disputed domain names were at one point also redirected to pay-per-click pages with sponsored links leading to third-party commercial websites. Therefore, the Respondent intentionally attempted to attract Internet users to its websites for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation and endorsement of its websites.

As a result of delisting, the disputed domain names now resolve to error pages, but the Complainant points out that such passive use also constitutes bad faith use, as clearly decided in many Panel decisions. In conclusion, the Complainant says that in view of i) the clear confusing similarity of the domain names with the Complainant's allegedly well-known trademark, ii) the Respondent's lack of any legitimate interests in the disputed domain names, iii) the Respondent's concealing of its identity in the public Whois records, and iv) the implausibility of any good faith use to which the domain names could be put, the Respondent's passive holding should not prevent a finding of bad faith use.

B. Respondent

The Respondent did not reply to the Complainant's contentions advanced in the Complaint. However, in correspondence with the agent of the Complainant the Respondent maintained that its registration of the disputed domain names did not amount to an infringement of the Complainant's intellectual property rights and denied any risk of confusion between the disputed domain names and the Complainant's GUCCI trademark. The Respondent indicated that its "registration and use of the domain name is based on good faith and legitimate purpose. The domain name was not registered for the purpose of infringing on Gucci's trademark rights or other interests, but rather for the needs and planning of personal or business activities." Moreover, the Respondent also stated that "the domain name is not confusingly similar to Gucci's trademarks and is not likely to cause confusion among the public" and that "use of the domain name does not involve any products or services related to Gucci".

6. Discussion and Findings

The multiple disputed domain names were all registered on the same day by the same person, Libin of the United States, who provided the same contact details for all the disputed domain names.

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 the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the term "ancora", itself part of the Complainant's branding, does not have any impact on this conclusion.

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 names (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 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.

The Respondent has variously used the disputed domain names to resolve to parking pages with paid hyperlinks, to a for sale site, and to error pages. The Respondent has offered the disputed domain names for sale to the Complainant. The Respondent has no authorization from the Complainant nor any demonstrated prior rights by registration in the disputed domain names or in the terms GUCCI or GUCCI ENCORA. The Respondent has made no use of the disputed domain names that could result in the recognition of rights or legitimate interests on his part.

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 the present case, the Panel notes that the Respondent registered the disputed domain names including the terms “GUCCI” and “ANCORA” the day after the initial public launch of the Gucci Ancora campaign by the Complainant. In any case, the GUCCI trademark of the Complainant is highly recognizable and world famous, and it is inconceivable that the disputed domain names could have been registered without knowledge of those marks and the related campaign, the Complainant’s business or its exclusive rights.

This is further confirmed by the Respondent’s subsequent deliberate actions which were all aimed at extracting a financial advantage from the unauthorized registration of disputed domain names that include the Complainant’s proprietary marks. Requesting payment well beyond out-of-pocket expenses from the Complainant constitutes clear bad faith, as does redirection to pages with pay per click links, and also passive holding (error pages) of a mark with such an extensive reputation. Further the Respondent used a privacy service to disguise its identity and made manifestly spurious arguments in its favour in correspondence with the Complainant. The Respondent was given ample opportunity to transfer the disputed domain names to the Complainant before the initiation of the present process.

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 names <gucciancora.live>, <gucciancora.online>, and <gucciancora.shop> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: November 21, 2024