

ADMINISTRATIVE PANEL DECISION

Guccio Gucci S.p.A. v. MJWebs Pty Limited
Case No. DAU2023-0029

1. The Parties

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

The Respondent is MJWebs Pty Limited, Australia.

2. The Domain Name and Registrar

The disputed domain name <gucci.au> is registered with Tucows (Australia) Pty Ltd trading as OpenSRS (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 23, 2023. On June 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 23, 2023, 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 .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 6, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was July 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 29, 2023.

The Center appointed Rebecca Slater as the sole panelist in this matter on August 3, 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 Guccio Gucci S.p.A., an Italian public limited company founded in 1921 and

headquartered in Florence, Italy. The Complainant is a luxury fashion house. The Complainant has stores all around the world, including in Australia. Consumers can also buy the Complainant's products online.

The Complainant is the owner of Australian Trade Mark Registrations No. 265546, 265544 and 265543 for GUCCI (word mark) in classes 25, 28 and 14 respectively (all registered February 2, 1973) (the "Trade Mark"). The Complainant also holds European Union and International trade mark registrations for the GUCCI word mark.

The Respondent is MJWebs Pty Limited. The Respondent did not file a Response, and consequently little information is known about the Respondent.

The Respondent registered the disputed domain name on October 3, 2022. The website at the disputed domain name initially hosted a landing page. It currently states that the disputed domain name is available for purchase. Offers can be submitted by completing a form that opens when clicking on the link "Make Offer".

5. Parties' Contentions

A. Complainant

The Complainant makes the following submissions.

The disputed domain name is identical to the Complainant's well-known Trade Mark. The disputed domain name consists of the Trade Mark plus the Australian country code Top-Level Domain extension ".au", which should be disregarded in the assessment of whether the disputed domain name is identical or confusingly similar. As such, the disputed domain name contains the entire Trade Mark without alteration.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant instructed a web agency to contact the Respondent to ascertain the Respondent's intentions in relation to the disputed domain name. The Respondent confirmed the disputed domain name was available and requested USD 6,500 or a six month instalment plan totaling USD 8,000. The Complainant then instructed its representative to send a cease and desist letter to the Respondent. The Respondent's representative responded, denying any infringement of the Complainant's rights and advising that the disputed domain name would be available for transfer for USD 15,000. All the figures above are in excess of the Respondent's out-of-pocket costs in relation to the disputed domain name.

The Trade Mark has been extensively used since 1921 to market the Complainant's products, including in Australia. The well-known character of the Trade Mark has been recognised in prior UDRP decisions. The Respondent would have been aware of the existence of the Complainant and the Trade Mark when the Respondent registered the disputed domain name.

The Respondent acted in opportunistic bad faith in registering the disputed domain name, for the purpose of taking commercial advantage of the Trade Mark.

The Respondent has:

- intentionally attempted to attract Internet users to its website for commercial gain (*i.e.* the sale of the disputed domain name), by creating a likelihood of confusion with the Trade Mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website;
- registered the disputed domain name to prevent the Complainant (as the owner of the Trade Mark) from reflecting the Trade Mark in a corresponding domain name; and

- registered the disputed domain name with the purpose of selling it for valuable consideration in excess of the Respondent's out-of-pocket costs.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered or subsequently used in bad faith.

The onus of proving these elements is on the Complainant even though the Respondent has not filed a response.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that the Panel deems applicable.

A. Procedural Issues

The Respondent's failure to file a response does not automatically result in a decision in favour of the Complainant (see section 4.3 of the Overview of Panel Views on Selected auDRP Questions, Second Edition ("auDRP Overview 2.0")). However, the Panel may draw appropriate inferences from the Respondent's default.

B. Identical or Confusingly Similar

The disputed domain name is identical to the Trade Mark in which the Complainant has rights. Generally, and as is appropriate in this case, the first level suffix (*i.e.* ".au") is disregarded (see section 1.11 of the auDRP Overview 2.0).

The Complainant succeeds on the first element of the Policy.

C. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy provides that the Complainant must establish that the Respondent has no rights or legitimate interests in the disputed domain name. Paragraph 4(c) non-exhaustively lists circumstances that can demonstrate the Respondent's rights or legitimate interests in the disputed domain name.

In the Panel's view, the following establish a *prime facie* case against the Respondent:

- the Complainant has not licensed or otherwise authorised the Respondent to use the Trade Mark;
- there is no evidence to suggest that the Respondent might be commonly known by the disputed domain name; and

- the Respondent has not been making a *bona fide* use of the disputed domain name. The disputed domain name currently resolves to a website that states the domain name is available for purchase. (Paragraph 4(c)(i) of the Policy expressly states that “an offering of domain names that you have acquired for the purposes of selling, renting or otherwise transferring” is not a *bona fide* offering for this purpose.)

The Respondent has not provided any evidence to demonstrate its rights or legitimate interests in the disputed domain name.

Under these circumstances, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The second element of the Policy is satisfied.

D. Registered or Subsequently Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the disputed domain name has been registered or subsequently used in bad faith.

The Panel accepts that the Trade Mark is well-known. The Complainant has provided evidence of the reputation of both the Complainant and the Trade Mark. Previous panels have recognised the goodwill and well-known reputation in the Trade Mark (see e.g. *Guccio Gucci S.p.A., v. Bravia Stoli*, WIPO Case No. [D2009-1170](#); *Guccio Gucci SpA v. Zhou Guodong*, WIPO Case No. [D2010-1695](#) and *Guccio Gucci S.p.A. v. D T*, WIPO Case No. [DTV2011-0006](#)).

The Complainant has had registered rights in the Trade Mark since 1973. The Respondent registered the disputed domain name in 2022. As the disputed domain name is identical to the Trade Mark (and the Trade Mark is not a generic or descriptive term), the Panel finds that the Respondent was almost certainly aware of the Complainant and the Trade Mark at the time the disputed domain name was registered. The fact that the Respondent registered the disputed domain name on the date that “.au” names were released from priority hold supports this finding of awareness.

The website at the disputed domain name currently states that the domain name is available for sale. The Complainant submits that the Respondent and its representatives have offered to transfer the disputed domain name for USD 6,500, USD 8,000 (in instalments) and USD 15,000.

Registering or acquiring a domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to another person for valuable consideration in excess of the out-of-pocket expenses directly related to the domain name may be evidence of bad faith (see paragraph 4(b)(i) of the Policy). Out-of-pocket costs include the costs of obtaining, registering, and maintaining a domain name. This issue of “excessive” out-of-pocket costs is considered on a case-by-case basis.

In this Panel’s experience, the amounts listed above would exceed the Respondent’s out-of-pocket costs directly associated with the disputed domain name. In circumstances where there is (and has been) no active website associated with the disputed domain name, the disputed domain name is identical to a well-known Trade Mark, and the Respondent did not file a Response, the Panel finds that the Respondent’s offer to sell the disputed domain name for an amount in excess of its out-of-pocket costs is evidence of registration and use of the disputed domain name bad faith in accordance with paragraph 4(b)(i) of the Policy.

The Complainant succeeds on the third element of the Policy.

7. Decision

For all 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, <gucci.au>, be transferred to the Complainant.

/Rebecca Slater/

Rebecca Slater

Sole Panelist

Date: August 14, 2023