

ADMINISTRATIVE PANEL DECISION

Lucchese, Inc. v. jing yu
Case No. D2023-0078

1. The Parties

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

The Respondent is jing yu, China.

2. The Domain Name and Registrar

The disputed domain name <luccheseus.com> 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 January 6, 2023. On January 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 9, 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 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 January 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 3, 2023.

The Center appointed Alfred Meijboom as the sole panelist in this matter on February 13, 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 commercializes and offers in the ordinary course of business a wide variety of products for men and women that includes boots, shoes, apparel, accessories, bags and travel accessories.

The Complainant owns several United States federal trademark registration for the word mark LUCCHESE, including:

- trademark with registration number 0916764 of July 20, 1971 for boots;
- trademark with registration number 1796383 of October 5, 1993 for billfolds and men's belts;
- trademark with registration number 1835901 of May 10, 1994 for briefcases and luggage and hats, jackets, jeans and shirts; and
- trademark with registration number 2951130 of May 17, 2005 for cologne and aftershave (the "LUCCHESE trademark")

The disputed domain name was registered on November 11, 2022. The disputed domain name resolves to a website that uses the Complainant's LUCCHESE trademark, offer the same range of products as the Complainant's products with discounts of about 80% off the Complainant's authentic products, and uses similar and, in some cases, identical product images from the Complainant's website (the "Respondent's Website").

5. Parties' Contentions

A. Complainant

The Complainant claims that the disputed domain name is confusingly similar to the LUCCHESE Trademark. According to the Complainant, the addition of the letters "us" to the LUCCHESE Trademark does not distinguish it from the Complainant's website but instead only makes the connection stronger, due to the fact that the main trade channels, consumers and commercial business of the Complainant is located in the United States, represented by the letters "us".

The Complainant further alleges that the Respondent has no legitimate interest in the disputed domain name because the Complainant has not authorized the Respondent to use or register the LUCCHESE Trademark as part of a domain name or otherwise, and the Complainant is not affiliated, connected, or associated with the Respondent. According to the Complainant, the Complainant does not sponsor or endorse the Respondent in any manner, nor has it authorized the Respondent to sell the Complainant's goods. And the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name as the purpose of the Respondent's Website appears to be to lure 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, when in fact they will not.

The Complainant alleges that the disputed domain name was registered and is being used in bad faith because, by using the disputed domain name, 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 LUCCHESE Trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website or location. According to the Complainant the Respondent fraudulently affiliates itself with the Complainant by explicitly referring to the "Lucchese" name in connection with an identical class of goods as sold under the LUCCHESE Trademark and because the Respondent's Website features the identical images of the Complainant's goods, taken from the Complainant's website. The Complainant alleges that the Respondent has no valid reason for registering the disputed domain name which is identical to the Complainant's LUCCHESE Trademark other than to confuse consumers and draw them to the Respondent's Website, which does not appear to offer any legitimate and authentic products. The Complainant alleges that it has been using the LUCCHESE Trademark since 1883, which is now famous, and that it is well settled that the registration and use of a domain name that is confusingly similar to a well-known mark is indicative

of opportunistic bad faith. Finally the Complainant alleges that the Respondent's Website provides an email address that does not match the disputed domain name and is false information which is also indicative of the Respondent's bad faith.

B. Respondent

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

6. Discussion and Findings

The Respondent did not file a Response. However, as set out in section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), the consensus view of UDRP panels is that the respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still establish each of the three elements required by paragraph 4(a) of the Policy. Although the Panel may draw appropriate inferences from the Respondent's default, paragraph 4 of the Policy requires the Complainant to support its assertions with actual evidence in order to succeed in this proceeding. Paragraph 14(b) of the Rules provides that, in the absence of exceptional circumstances, the panel shall draw such inferences as it considers appropriate from a failure of a party to comply with a provision or requirement of the Rules. The Panel finds that in this case there are no such exceptional circumstances.

Under the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 and is being used in bad faith.

A. Identical or Confusingly Similar

It is well established that the generic Top-Level Domain ("gTLD") ".com" should typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy.

The Panel finds that the disputed domain name is confusingly similar to the LUCCHESE Trademark. The disputed domain name incorporates the LUCCHESE Trademark in its entirety, and merely adds the letters "us", which does not prevent a finding of confusing similarity between the disputed domain name and the LUCCHESE Trademark under the Policy (see e.g., *Syngenta Participations AG v. Who Is Agent / Rogerio Biasotto*, WIPO Case No. [D2015-0253](#); and *Philip Morris USA Inc. v. Domain Admin / Whois Privacy Corp.*, WIPO Case No. [D2016-0910](#)).

Consequently, the first element of paragraph 4(a) of the Policy is met.

B. Rights or Legitimate Interests

The Complainant must show a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which the Respondent may rebut (e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel takes note of the Complainant's various allegations and more specifically that no authorization has been given by the Complainant to the Respondent to use the LUCCHESE Trademark or to register the disputed domain name, and the disputed domain name resolving to the Respondent's Website that intentionally created confusion as to the source, sponsorship, affiliation, or endorsement of the Respondent's

Website. The Panel is satisfied that the Respondent designed and launched the Respondent's Website with the intention to mislead Internet users into believing that the Respondent's Website is authorized by the Complainant to offer the Complainant's authentic goods for substantially discounted prices, which does not constitute a *bona fide* offering of goods or services.

The allegations of the Complainant remain unchallenged. There is no evidence before the Panel to show that the Respondent has rights or legitimate interests in the disputed domain name. The Panel therefore finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of the disputed domain name in bad faith as the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the LUCCHESE Trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website or location or of a product or service offered on the Respondent's Website or location.

The Panel is satisfied that the Respondent must have had the LUCCHESE Trademark in mind when it registered the disputed domain name, as the Complainant secured registration for the LUCCHESE Trademark many decades before the registration of the disputed domain name, and the Respondent started using the disputed domain name to imitate the Complainant's website and target customers of the Complainant's products immediately upon registration of the disputed domain name.

Further, the Panel considers the Respondent's Website offering the Complainant's products and creating an intentional association with the Complainant and the LUCCHESE Trademark, as clear evidence of the Respondent's use of the disputed domain name to the detriment of the Complainant and the LUCCHESE Trademark, and accordingly as use in bad faith.

Consequently, the third and last element of paragraph 4(a) of the Policy is also met.

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 <luccheseus.com> be transferred to the Complainant.

/Alfred Meijboom/

Alfred Meijboom

Sole Panelist

Date: February 22, 2023