

ADMINISTRATIVE PANEL DECISION

Guccio Gucci S.p.A. v. Fabian
Case No. D2023-4532

1. The Parties

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

The Respondent is Fabian, Hong Kong, China

2. The Domain Name and Registrar

The disputed domain name <gucciancora.com> is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 31, 2023. On October 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 1, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 2, 2023, 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 amendment to the Complaint on November 6, 2023.

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 Respondent of the Complaint, and the proceedings commenced on November 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 5, 2023.

The Center appointed Marina Perraki as the sole panelist in this matter on December 7, 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

Complainant is an Italian Public Limited Company, part of Kering, one of the leading groups worldwide in apparel and accessories. The Gucci Fashion House was founded in 1921 by Guccio Gucci. The brand rapidly achieved success. During the 1960s, Complainant introduced products cherished by some of the most iconic figures of the time: Jackie Kennedy, Liz Taylor, Peter Sellers and Samuel Beckett. During the 1970s and years following, Complainant opened stores in Tokyo and Hong Kong, China. In 1995, Complainant converted into an entirely publicly-owned company and was elected as the “European Company of the year” by the European Business Press Federation. The GUCCI trademark has been regularly used by Complainant for more than 100 years in connection with products in the high-fashion and leather industry, enjoying a worldwide reputation and goodwill.

Complainant is the owner of national and international trademark registrations for GUCCI worldwide, including the following:

- Italian Trademark Registration No. 362016000132789 for GUCCI (word mark), filed on December 30, 2016, and registered on September 6, 2017, in all classes, last renewal of the Italian trademark originally filed on January 13, 1977, and registered on March 30, 1977, with registration number 302066; and
- International Trademark Registration No. 429833 for GUCCI (word mark), registered on March 30, 1977, in classes 3, 14, 18, and 25; and
- International Trademark Registration No. 457952 for GUCCI (word mark), registered on December 16, 1980, in all classes, designating *inter alia*, China.

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 and at which Complainant operates its official website and to which most of Complainant’s registered domain names are redirected. Complainant maintains a website also at “www.gucci.cn/zh”.

The new Creative Director of Complainant presented his SS24 collection at the Milan Fashion Week in September 2023. On September 14, 2023, he had published on his Instagram account an image with the word “ANCORA” (meaning “still” or “again” in Italian) with the hashtag #gucciancora, thus disclosing the name of the collection that would have been presented on September 22, 2023.

The Gucci Ancora campaign was widely advertised through national and international media, fashion magazines and newspapers and on Complainant’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 Domain Name was registered on September 15, 2023, namely the day after Complainant’s Creative Director published a post on his Instagram account with the hashtag #gucciancora. The Domain Name leads to an inactive website.

Complainant instructed a web agency to contact Respondent. The web agency sent an email, on September 18, 2023, to the Registrar’s email address, requesting to forward it to Respondent. The same communication was addressed to Respondent via the Registrar’s online form available at the link published on the official Whois database (https://www.dynadot.com/domain/contact_request?domain=gucciancora.com). On September 25, 2023, the web agency received the following reply from Respondent: “This domain name is reserved for our own use and is not for sale. If you let me consider the asking price, its market price is 30k USD.”

On October 2, 2023, Complainant’s representative sent a Cease-and-Desist letter to Respondent, requesting it to transfer the Domain Name to Complainant. On October 8, 2023, Respondent, signing as “Kevin”, answered to the formal communication sent by the Complainant’s representative denying to have infringed Complainant’s rights and indicating that he was available to “solve this matter amicably to prevent potential unnecessary problems in the future” and requesting to indicate if Complainant was “willing to resolve this

issue through friendly negotiation". On October 9, 2023, Complainant's representative replied to Respondent reiterating the request to transfer the Domain Name to Complainant free of any charge. On October 10, 2023, Respondent replied to Complainant's representative indicating as follows: "[...] We have rejected the offer of \$ 3,000 from other buyer in the past few days. As I indicated in my prior email, in the spirit of compromise and the hopes of a quick, expedient resolution of this matter, we hope you to the offer is \$ 2,000 in exchange for it. After all, I've received such an offer and I hope you can understand. Please note that this letter is for settlement negotiation purposes only."

5. Parties' Contentions

A. Complainant

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

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements, which Complainant must satisfy with respect to the Domain Name:

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

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.

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 entirety of the mark is reproduced within the Domain Name. Accordingly, the Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "ancora" ("again" or "still" in Italian), 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 mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The generic Top-Level Domain ("gTLD") ".com" is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

Based on the available record, 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.

On the contrary, the Domain Name leads to an inactive website, and there is no reasonable explanation as to the registration and holding of the Domain Name that could lead the Panel to a conclusion different to Respondent targeting Complainant through the Domain Name.

Furthermore, as Complainant has demonstrated, Respondent attempted to sell the Domain Name to Complainant for amounts that exceed his out-of-pocket expenses. In this regard, the Panel notes that Respondent’s email communication of October 10, 2023, provided by Complainant, stated that “this letter is for settlement negotiation purposes only.” To the extent that Respondent may have intended this communication to be “without prejudice”, the Panel follows the panel’s approach in *HSBC Holding plc v. Chaudry Cheema*, WIPO Case No. [D2006-0295](#), where the panel stated that “It does not appear to be a bona fide attempt by the Respondent to enter into settlement discussions; still less is there any indication that the Complainant agreed that any correspondence should be upon a without prejudice basis.” In the Panel’s opinion, the opposite would be equivalent to allowing a respondent acting in bad faith to prejudice a complainant by merely adding unilaterally the words “without prejudice” to a communication in what could be considered as an attempt at extortion. In any case, even if the Panel was to consider this communication as being done on a without prejudice basis, and the Panel would have decided not to consider it, the Panel would have reached the same conclusion in the present proceeding noting Respondent’s opportunistic registration after Complainant’s announcement coupled with the composition of the Domain Name, irrespective of the Respondent’s offer to sell the Domain Name.

The above, along with the fact that the Domain Name was registered with a privacy shield service at the time of filing of the Complaint, speaks against any rights or legitimate interests held by Respondent (*Ann Summers Limited v. Domains By Proxy, LLC / Mingchun Chen*, WIPO Case No. [D2018-0625](#); *Carrefour v. WhoisGuard, Inc., WhoisGuard Protected / Robert Jurek, Katrin Kafut, Purchasing clerk, Starship Tapes & Records*, WIPO Case No. [D2017-2533](#)).

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Based on the available record, 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.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith.

Because Complainant's mark had been widely used and registered by Complainant before the Domain Name registration and noting the worldwide notoriety of the GUCCI trademark, it is clear that Respondent had Complainant's mark in mind when registering the Domain Name (*Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

Furthermore, the Domain Name was registered one day after Complainant's Creative Director published on his Instagram account an image with the word "ANCORA" (meaning "still" or "again" in Italian) with the hashtag #gucciancora, disclosing the name of the collection that would have been presented on September 22, 2023. This further indicates that Respondent knew of Complainant and chose the Domain Name with knowledge of Complainant, its industry, and the similarity with a name disclosed by Complainant's Creative Director incorporating the GUCCI trademark with the word "ANCORA" (*Safepay Malta Limited v. ICS Inc*, WIPO Case No. [D2015-0403](#)).

As regards bad faith use, the Domain Name leads to an inactive website. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Further to the Panel's analysis under the second element, the Panel takes further into account that Respondent offered to sell the Domain Name to Complainant for amounts that exceeded his out-of-pocket expenses. However, the Panel notes that the same conclusion of registration and holding in bad faith would have been reached even if the Panel would have not considered these communications.

Last, the Panel considers the apparent concealment of the Domain Name holder's identity through use of a privacy shield at the time of filing the complaint, to be further indicative of bad faith in the circumstances of this case (*BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#)).

Based on the available record, 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 <gucciancora.com> be transferred to the Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: December 21, 2023