

## ADMINISTRATIVE PANEL DECISION

Guccio Gucci S.p.A. v. Bui Xuan Tuan, Bui Xuan Tuan; Phan Tan Tai, Phan Tan Tai; Dong Duc Manh, Dong Duc Manh; Ha Duc Manh, Ha Duc Manh; Nguyen Minh Duong, Nguyen Minh Duong, tuan bui, âsdasd  
Case No. D2024-4367

### 1. The Parties

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

The Respondents are Bui Xuan Tuan, Bui Xuan Tuan; Phan Tan Tai, Phan Tan Tai; Dong Duc Manh, Dong Duc Manh; Ha Duc Manh, Ha Duc Manh; Nguyen Minh Duong, Nguyen Minh Duong, Viet Nam and tuan bui, âsdasd, United States of America ("United States").

### 2. The Domain Names and Registrars

The disputed domain names <gucciae.com>, <gucci-ae.website>, <gucciasia.online>, <guccicontact.com>, <guccihandbags.shop>, <gucciluxury.host>, <gucciofficials.asia>, <gucciofficial.website>, <gucciph.website>, <guccistoreasia.website>, <gucci-uae.website> and <gucciuae.website> are registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

The disputed domain name <guccistore.life> is registered with NameSilo, LLC (the "Registrar").

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 23, 2024. On October 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 24 and 25, 2024, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (GMO-Z.com RUNSYSTEM, GMO-Z.com RUNSYSTEM JSC and Domain Administrator, See PrivacyGuardian.org) and contact information in the Complaint.

The Center sent an email communication to the Complainant on October 25, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, 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 amended Complaint on October 29, 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 November 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 26, 2024.

The Center appointed Mihaela Maravela as the sole panelist in this matter on November 29, 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**

According to information in the Complaint, the Complainant is an Italian public limited company which belongs to the international conglomerate company Kering, one of the leading groups worldwide in apparel and accessories. The Gucci Fashion House was founded in 1921 by Guccio Gucci, who opened a leather goods company and a small luggage store in Florence. The brand rapidly achieved great success, attracting a sophisticated international clientele fascinated by the equestrian inspired collection of bags, trunks, gloves, shoes and belts. The Complainant was ranked 31st in the 2020 World’s Most Valuable Brands list provided by Forbes, with a brand value of USD 22.6 billion and was in 34th place according to the Interbrand “Best Global Brands” ranking in 2023.

The Complainant owns many registered trademarks for GUCCI including the International Trademark Registration No. 429833 for GUCCI (word mark), registered on March 30, 1977, in classes 3, 14, 18 and 25, or the International Trademark Registration No. 1184004 for GUCCI (word mark), registered on May 6, 2013, in class 35, designating, amongst others, Viet Nam. The Complainant has registered the domain name <gucci.com> since June 5, 1996, which it uses as its official website to promote its brand and offer for sale its GUCCI products.

The Respondents are identified as different individuals (i.e., Bui Xuan Tuan, Bui Xuan Tuan; Phan Tan Tai, Phan Tan Tai; Dong Duc Manh, Dong Duc Manh; Ha Duc Manh, Ha Duc Manh; Nguyen Minh Duong, Nguyen Minh Duong and tuan bui, âsdasd), with contact addresses in Viet Nam and United States.

The disputed domain names were registered between October 30, 2023 to October 9, 2024. At the date of the Complaint, the disputed domain names, except for <guccicontact.com>, have been actively used by the Respondents, to create internal webpages based on the disputed domain names, where the Complainant’s GUCCI trademarks and the Complainant’s company details were published without authorization and purported GUCCI products were offered for sale at discounted prices. Moreover, Internet users were invited to provide their personal information to finalize the purchase. The disputed domain name <guccicontact.com> was used to create an email address from which misleading e-mail communications were sent to users who made orders on the Respondents’ websites. At the date of this Decision, the disputed domain names no longer resolve to an active website. In case of most of the disputed domain names the message “This site can’t be reached” is displayed, and in other cases the disputed domain names resolve to landing pages.

The Complainant has sent cease-and-desist letters to the Respondents, but despite certain acknowledgements of infringement in certain cases, the Respondents failed to transfer the disputed domain names to the Complainant.

## 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 the trademark GUCCI in which the Complainant has rights, as the disputed domain names incorporate the whole of the Complainant's GUCCI trademark. The fact that the disputed domain names differ from the Complainant's trademark by the addition of the nondistinctive elements "official", "officials", "ae" (abbreviation of Arab Emirates), "uae" (abbreviation of United Arab Emirates), "storeasia" (misspelling of "store asia"), "handbags", "luxury", "ph" (Philippines), "asia", "store", "contact" and of a hyphen does not affect the confusing similarity.

Regarding the second element, the Complainant argues that the Respondents are not licensees, authorized agents of the Complainant or in any other way authorized to use the Complainant's trademark GUCCI. As regards the use, the Complainant submits that all the disputed domain names, except <guccicontact.com>, have been redirected since their registration to a static page 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!", or to a blank page with the indication "Your destinate url doesn't exist/Your domain not in redirect or frame record/Your destinate url having wrong format concerned". The disputed domain name <guccicontact.com> has not been redirected to an active page.

Notwithstanding the apparent lack of use of the disputed domain names, all of them, but <guccicontact.com>, have been actively used by the Respondents to create internal webpages based on the disputed domain names, where the Complainant's GUCCI trademarks and the Complainant's company details were published without authorization and purported GUCCI products were offered for sale at discounted prices. Moreover, users were invited to provide their personal information to finalize the purchase. Moreover, the copyright lines read "©2016 – 2022 Guccio Gucci S.p.A. – All right reserved", thus enhancing the impression to be visiting official GUCCI websites operated by the Complainant or one of its affiliated entities, which is not the case. Furthermore, no information about the name and identity of the real entity operating the websites has been provided. In addition, as the prices at which products have been offered for sale on the Respondents' webpages are much cheaper than the prices applied to the GUCCI products sold by the Complainant, this suggests that the products offered by the Respondents might be counterfeit. The Complainant also ascertained that the Respondents' resale of discounted GUCCI products was promoted through several Facebook profiles, where direct links to the above referenced webpages based on the disputed domain names were provided. After the Complainant's take down activities, almost all the unauthorized Facebook accounts have been deactivated.

With respect to such use, the Complainant submits that the lack of information about the real entity operating the Respondents' websites and the Respondents' publication of images and text apt to suggest that the websites were operated by the Complainant supports the conclusion that the Respondents might have indeed engaged in the sale of counterfeit goods and wilfully omitted the indication of their actual contact details on their websites to avoid being identified and prosecuted for their illegal conduct. The Complainant submits that, irrespectively of the nature of the products offered for sale on the Respondents' websites, no fair use could be possibly invoked in the present case by the Respondents, since they have undoubtedly failed to accurately and prominently disclose their (lack of) relationship with the trademark holder, thus generating a clear likelihood of confusion amongst Internet users.

The Complainant also submits that the disputed domain name <guccicontact.com> was used to create an email address from which misleading e-mail communications were sent to users who made orders on the Respondents' websites. In said communications, GUCCI was indicated as sender name and the subject read "Thank you for your order with Gucci". The emails featured the Complainant's trademarks in the body of the email, also indicating that "Each of the items you have chosen has been made with all the Gucci know-

how”, and included a link to the Respondent’s website at “www.gucciuae.website/order-checking” – based on the disputed domain name <gucciuae.website>, displaying a fake order status related to a purported purchase on the Complainant’s official website. With respect to such use, the Complainant argues that the Respondents’ use of such disputed domain name is part of a fraud scheme aimed at deceiving recipients into believing that they are actually dealing with the Complainant, in order to obtain payments and personal information from users misled as to the source of the email communications.

Regarding the third element, the Complainant submits that considering that the trademark GUCCI is well-known and used since as early as 1921, it is inconceivable that the Respondents were unaware of the existence of such trademark, with which the disputed domain names are confusingly similar. In view of the use of the disputed domain names as described above, the Respondents registered the disputed domain names with the clear intention to target the Complainant’s trademark.

## **B. Respondents**

The Respondents did not reply to the Complainant’s contentions.

## **6. Discussion and Findings**

### **6.1. 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 submits that (i) all the disputed domain names, apart from <guccistore.life>, have been registered via the same Registrar “GMO INTERNET, INC.” and share the same name servers (ns-a1.tenten.vn, ns-a2.tenten.vn, ns-a3.tenten.vn); (ii) all the disputed domain names, apart from <guccistore.life> share the same Registrant Country, i.e. Viet Nam, but the registrant email address for <guccistore.life> is the same as the one indicated for <gucciofficials.asia> and <guccistoreasia.website>, whose registrant is located in Viet Nam and both mentioned disputed domain names include “bui tuan” in the registrant names; (iii) all the registrant email addresses are based on Gmail.com and share other commonalities as well; (iv) the disputed domain names were registered in a short period of time, from October 30, 2023 to October 9, 2024, and some of them have been registered on the same day; (v) the close similarity amongst the disputed domain names, which all incorporate the trademark GUCCI in its entirety as prefix with the addition of geographical indicators (“ae”, “uae”, “asia”, “ph”) and/or the generic or descriptive terms “official” (misspelled as “officials” in one case), “contact”, “store” (misspelled as “stroe” in one case), “luxury” and “handbags”; (vi) the twelve disputed domain names <gucciofficials.asia>, <gucciae.com>, <gucciuae.website>, <gucciofficial.website>, <guccistoreasia.website>, <guccihandbags.shop>, <gucciluxury.host>, <gucciph.website>, <gucciasia.online>, <gucciae.website>, <guccistore.life>, and <gucci-uae.website> have been used for the same purpose, namely to create internal webpages where the Complainant’s trademarks and company information were displayed and purported counterfeit GUCCI products were offered for sale at discounted prices; (vii) all of the disputed domain names, apart from <guccicontact.com> and <gucciph.website>, were linked to Facebook accounts where the mentioned unauthorized internal webpages, used by the Respondents to offer for sale prima facie counterfeit GUCCI products, were promoted; (viii) the disputed domain name <guccicontact.com> has been used to send communications from an email address impersonating the Complainant and promoting the sale of counterfeit GUCCI products on a website based on the disputed domain name <gucciuae.website>. For these reasons, 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 names’ 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 takes note of and agrees with the unrebutted statements of the Complainant and also notes that the consolidation of the disputed domain names is justified as, inter alia: (i) the disputed domain names are similar in construction, as detailed above; (ii) most of the websites to which the disputed domain names resolved were similar, as described above; (iii) currently the websites at the disputed domain names are inactive.

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.

## **6.2. Substantive issues**

No response has been received from the Respondent in this case. However, given that the Complaint was sent to the relevant addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2 of the [WIPO Overview 3.0](#).

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are 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 names, and (iii) the disputed domain names have been registered and are 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 3.0](#), section 1.7.

The Complainant has shown rights in respect of the trademark GUCCI for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The 13 disputed domain names wholly incorporate the GUCCI trademark of the Complainant. The disputed domain names also incorporate other terms or elements, namely geographic terms ("ae", "uae", "asia", "ph") and/or the descriptive terms "official" (misspelled as "officials" in one case), "contact", "store" (misspelled as "store" in one case), "luxury", and "handbags".

Although the addition of the above terms or letters may bear on assessment of the second and third elements, the Panel finds the addition of such terms or letters does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy, because the GUCCI trademark remains clearly recognizable in each of them. [WIPO Overview 3.0](#), sections 1.7 and 1.8. Also, use of hyphens does not prevent the confusing similarity between the disputed domain names and the Complainant's trademark.

It is the settled view of panels applying the Policy that the generic Top-Level Domains (“gTLDs”) (here “.com”, “.website”, “.online”, “.shop”, “.host”, “.asia”, and “.life”) may be disregarded under the first element test. See [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel finds that all 13 disputed domain names are confusingly similar to the Complainant’s GUCCI trademark for the purposes of the Policy. 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 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 Complainant submits that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant’s trademark GUCCI.

There is no evidence that the Respondent is using the disputed domain names in connection with a bona fide offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain names within the meaning of paragraphs 4(c)(i) and (iii) of the Policy.

Rather, according to the un rebutted evidence put forward by the Complainant, most of the disputed domain names (12 disputed domain names) have been used to divert users to internal webpages of the correspondent websites, where the Complainant’s trademarks and GUCCI product images were published, along with the Complainant’s contact details, and purported GUCCI products – probably counterfeit – were offered for sale at discounted prices, which shows in the Panel’s view, the Respondent’s intention to divert consumers for commercial gain to such websites, by taking unfair advantage of the goodwill and reputation of the Complainant’s rights. Further, one of the disputed domain names was used to send misleading email communications from e-mail address based on the said disputed domain name, which also according to the Panel does not give rise to any rights or legitimate interests in the disputed domain names considering the circumstances of this case.

At the date of the Decision, the disputed domain names no longer resolve to an active website, rather they resolve to landing pages or the message “This site can’t be reached” or “destinate URL does not exist” is displayed. In the Panel’s view, none of the above indicate that the disputed domain names are being used in connection with a bona fide offering of goods or services for the purposes of the Policy or that the Respondent is making a legitimate noncommercial or fair use of any of the disputed domain names.

Also, there is no evidence that the Respondent is commonly known by the disputed domain names within the meaning of paragraph 4(c)(ii) of the Policy. The Respondent's names are Bui Xuan Tuan, Bui Xuan Tuan; Phan Tan Tai, Phan Tan Tai; Dong Duc Manh, Dong Duc Manh; Ha Duc Manh, Ha Duc Manh; Nguyen Minh Duong, Nguyen Minh Duong and tuan bui, âsdasd. None of the mentioned names resemble a disputed domain name.

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.

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.

According to the unrebutted assertions of the Complainant, its GUCCI trademark was widely used in commerce well before the registration of the disputed domain names. The Complainant's mark is unique, a coined term; it has no meaning except for its association with the Complainant. The disputed domain names are confusingly similar with the Complainant's trademark. The disputed domain names wholly incorporate the GUCCI trademark as their initial element. The Respondent provided no explanations for why he registered the disputed domain names. Under these circumstances it is reasonable to infer that the Respondent has registered the disputed domain names with the Complainant in mind.

As regards the use, the majority of the disputed domain names have been used to divert users to internal webpages of the correspondent websites, where Complainant's trademarks and GUCCI product images were published, along with Complainant's contact details, and purported GUCCI products – probably counterfeit – were offered for sale at discounted prices. Such use indicates that the Respondents' purpose in registering and using the disputed domain names was to intentionally attempt to attract Internet users seeking the Complainant's branded products to the corresponding websites for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the websites and the goods offered and promoted on said websites, according to paragraph 4(b)(iv) of the Policy. The fact that the use of many of these disputed domain names has now changed and that they no longer resolve to active websites does not alter the above conclusion; rather, it may be further indication of bad faith. As to the use of the disputed domain name <guccicontact.com> to send misleading email communications from e-mail address based on the said disputed domain name, such use is also in bad faith. See section 3.4 of the [WIPO Overview 3.0](#): “[p]anel has held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft [...] Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers”.

Moreover, the Respondent has not formally participated in these proceedings and has failed to rebut the Complainant's contentions or provide any evidence of actual or contemplated good-faith use.

Therefore, the Panel finds that all 13 disputed domain names have been registered and are being used in bad faith. The Panel finds that the Complainant has established the third element of the Policy.

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 <gucciae.com>, <gucci-ae.website>, <gucciasia.online>, <guccicontact.com>, <guccihandbags.shop>, <gucciluxury.host>, <gucciofficials.asia>, <gucciofficial.website>, <gucciph.website>, <guccistore.life>, <guccistoreasia.website>, <gucci-uae.website>, and <gucciuae.website> be transferred to the Complainant.

/Mihaela Maravela/

**Mihaela Maravela**

Sole Panelist

Date: December 13, 2024