

ADMINISTRATIVE PANEL DECISION

Guccio Gucci S.p.A. v. 王天义 (Wang Tian Yi)
Case No. DCN2023-0040

1. The Parties

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

The Respondent is 王天义 (Wang Tian Yi), China.

2. The Domain Name and Registrar

The disputed domain name <gucci-official.com.cn> is registered with 阿里云计算有限公司 (万网) (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on June 19, 2023. On June 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 21, 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 China ccTLD Dispute Resolution Policy (the "Policy"), the China ccTLD Dispute Resolution Policy Rules (the "Rules"), and the WIPO Supplemental Rules for China ccTLD Dispute Resolution Policy and China ccTLD Dispute Resolution Policy Rules (the "WIPO Supplemental Rules").

In accordance with the Rules, Articles 5 and 6, and Articles 14 to 16, and the WIPO Supplemental Rules, Paragraph 4(d), the Center formally notified the Respondent in English and Chinese of the Complaint, and the proceedings commenced on June 27, 2023. In accordance with the Rules, Articles 17 and 49, the due date for Response was July 17, 2023. The Respondent did not submit a response. The Center then notified the Respondent's default on July 18, 2023.

The Center appointed Joseph Simone as the sole panelist in this matter on August 4, 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, Article 29.

4. Factual Background

The Complainant, Guccio Gucci S.p.A., is an Italian public limited company which belongs to the international Kering group (previously Pinault-Printemps- Redoute, PPR), one of the world's leading fashion conglomerates.

The Complainant has an extensive global portfolio of registrations containing the term GUCCI, including the following:

- International Trade Mark registration No. 429833 for GUCCI in Classes 3, 14, 18 and 25, designating a number of jurisdictions, registered on March 30, 1977;
- International Trade Mark registration No. 457952 for GUCCI in Classes 1 to 42, designating a number of jurisdictions including China, registered on December 16, 1980;
- China Trade Mark registration No. 177032 for GUCCI in Class 18, registered on May 15, 1983; and
- China Trade Mark registration No. 1046977 for GUCCI in Class 25, registered on July 7, 1997.

The disputed domain name was registered on July 18, 2022.

The evidence provided by the Complainant indicates that at the time of filing of the Complaint, the disputed domain name resolved to an inactive page. At the time of this decision, the disputed domain name continues to resolve to an inactive page.

5. Parties' Contentions

A. Complainant

The Complainant asserts that it has prior rights in the GUCCI trade mark and that it has acquired a strong reputation in its field of business. The Complainant further notes that the disputed domain name registered by the Respondent is confusingly similar to the Complainant's GUCCI trade mark.

The Complainant asserts that it has not authorized the Respondent to use its GUCCI mark, and there is no evidence to suggest that the Respondent has used or undertaken any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

The Complainant further asserts that, considering the evidence, it is implausible that the Respondent registered the disputed domain name in good faith, and that any use of the disputed domain name must be in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

Article 6 of the Policy provides that "[t]he language of the domain name dispute resolution proceedings shall be Chinese, unless otherwise agreed by the parties or determined by the Panel."

Article 8 of the Rules further provides that “[u]nless otherwise agreed by the Parties or determined in exceptional cases by the Panel, the language of the domain name dispute resolution proceedings shall be Chinese. [...]”

Hence, the default language of the proceeding should in principle be Chinese.

However, the Complainant filed the Complaint in English, and requested that English be the language of the proceeding, mainly arguing as follows:

- The Complainant communicates in English and would be prejudiced, in terms of translation expenses and delay to the proceeding, should it be required to translate the Complaint and participate in these proceedings in Chinese;
- The Respondent communicated in English with a web agency entrusted by the Complainant regarding the Respondent’s intention about the disputed domain name prior to the filing of the Complaint; and
- The disputed domain name is registered in Latin characters and contains the English word “official”.

The Respondent was notified in both Chinese and English of the commencement of the proceeding including an invitation to comment on the language of the proceeding, however, the Respondent did not comment on the language of the proceeding or submit any response in either Chinese or English.

Considering the circumstances of the case, the Panel has determined that the language of the proceeding shall be English, and the Panel has therefore issued this decision in English. The Panel further finds that such determination should not cause any prejudice to either Party and should ensure that the proceeding takes place with due expedition.

6.2. Substantive Issues: Three Elements

A. Identical or Confusingly Similar to the Complainant’s Name or Mark in Which the Complainant Has rights or interests

The Panel acknowledges that the Complainant has established rights in the GUCCI trade mark.

Disregarding the country code Top-Level Domain “.cn” and the Second-Level Domain “.com”, the disputed domain name incorporates the Complainant’s mark GUCCI in its entirety. The additional hyphen and the term “official” do not prevent a finding of confusing similarity.

Accordingly, the Complainant has satisfied the condition under Article 8(a) of the Policy.

B. Rights or Legitimate Interests

Under Article 10 of the Policy, a respondent may establish its rights to and legitimate interests in the disputed domain name by demonstrating any of the following before receiving the complaint:

- (a) the respondent uses of the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services;
- (b) the respondent has been commonly known by the disputed domain name, even if it has acquired no trade mark or service mark rights;
- (c) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent of or commercial gain to misleadingly divert consumers.

The Complainant asserts that it has not authorized the Respondent to use its trade marks and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. In fact, the disputed domain name resolves to an inactive website.

Thus, the Complainant has established its *prima facie* case with satisfactory evidence.

The Respondent did not file a response and has therefore failed to assert factors or put forth evidence to establish that he enjoys rights or legitimate interests in the disputed domain name. As such, the Respondent has failed to rebut the Complainant's *prima facie* showing of the Respondent's lack of rights or legitimate interests in the disputed domain name, and none of the circumstances of Article 10 of the Policy is applicable in this case.

Therefore, the Respondent has not shown that prior to the notice of the dispute, he used or has demonstrated preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. There is also no evidence showing that the Respondent has been commonly known by the disputed domain name or that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

Furthermore, given the composition of the disputed domain name <gucci-official.com.cn>, which combines the Complainant's mark with the term "official", the disputed domain name carries a clear risk of implied affiliation, contrary to the fact, which cannot constitute fair use.

Accordingly, the Complainant has satisfied the condition under Article 8(b) of the Policy.

C. Registered or Used in Bad Faith

Article 9 of the Policy provides certain examples of circumstances which, may be evidence of the registration or use of the disputed domain name in bad faith, namely:

- (a) the purpose for registering or acquiring the disputed domain name is to sell, rent, or otherwise transfer the disputed domain name registration to the complainant who is the owner of the name or mark or to a competitor of that complainant, and to obtain unjustified benefits;
- (b) the respondent registers the disputed domain name in order to prevent owners of the names or marks from reflecting the names or marks in corresponding domain names;
- (c) the respondent has registered or acquired the disputed domain name for the purpose of damaging the complainant's reputation, disrupting the complainant's normal business or creating confusion with the complainant's name or mark so as to mislead the public; and
- (d) other circumstances that can prove bad faith.

For reasons discussed under this and the preceding heading, the Panel believes that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name.

When the Respondent registered the disputed domain name, the GUCCI trade marks were already widely known and directly associated with the Complainant's activities. Panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith.

Given the extensive prior use and fame of the Complainant's marks, in the Panel's view, the Respondent should have been aware of the Complainant's marks when registering the disputed domain name and ultimately, given the composition of the disputed domain name, it is clear that the Respondent was aware of

the Complainant and intentionally targeted the Complainant when registering the disputed domain name and that inclusion of the word “official” will substantially increase the risk of confusion.

The Panel also finds that the current passive holding of the disputed domain name does not change the Panel’s finding of the Respondent’s bad faith, particularly considering the fame of the Complainant’s GUCCI marks and the implausibility of any good faith use that the disputed domain name may be put.

Consequently, the Complainant has satisfied the condition under Article 8(c) of the Policy.

7. Decision

For the foregoing reasons, in accordance with Articles 14 of the Policy and 40 of the Rules, the Panel orders that the disputed domain name <gucci-official.com.cn> be transferred to the Complainant.

/Joseph Simone/

Joseph Simone

Sole Panelist

Date: August 18, 2023