

## ADMINISTRATIVE PANEL DECISION

Lucchese, Inc. v. 秀英 阳  
Case No. D2022-3085

### 1. The Parties

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

The Respondent is 秀英 阳, China.

### 2. The Domain Name and Registrar

The disputed domain name <lucchesestore.com> (the “Disputed Domain Name”) 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 August 24, 2022. On August 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 25, 2022, 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 August 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 16, 2022.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on September 22, 2022. 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, Lucchese Inc, is a Texas-based, American manufacturer and retailer of luxury level western-inspired footwear and cowboy boots, founded in 1883.

The Complainant holds various registered trade marks consisting of, or including, the term “lucchese”, including the following:

- LUCCHESE, U.S. trade mark registered under No. 2951130 on May 17, 2005 in class 3; and
- Below U.S. stylized trade mark registered under No. 4991257 on July 5, 2016 in classes 18 and 25:

**LUCCHESE**  
BOOTMAKER

The Complainant uses these trade marks in the ordinary course of business, commercializing and offering boots, shoes, apparel, accessories, bags and travel accessories, including via its website available through the domain name <lucchese.com>.

The Disputed Domain Name was registered on July 25, 2022 and resolves to a website which appears to sell products of the Complainant.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant considers the Disputed Domain Name to be confusingly similar to a trade mark in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant, the Respondent is not authorized to use the Complainant's trade mark. Also, according to the Complainant, there is no evidence of *bona fide* or fair use of the Disputed Domain Name, or that the Respondent is commonly known by the Disputed Domain Name.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, the Respondent had direct knowledge of the Complainant's marks and the commercial value thereof, as evidenced by the Respondent's misappropriation and unauthorized use of the Complainant's registered trade marks on the website linked to the Disputed Domain Name. The Complainant contends that selling unauthorized and potentially counterfeit goods through a website featuring the Complainant's registered trade marks and copyright-protected materials amount to unlawful activities which are manifestly bad faith.

##### B. Respondent

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

#### 6. Discussion and Findings

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

The onus is on the Complainant to make out his case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. The standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The Disputed Domain Name is identical or confusingly similar to a trade mark 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 and is being used in bad faith.

The Panel will therefore deal with each of these requirements.

#### **A. Identical or Confusingly Similar**

To prove this element, the Complainant must first establish that there is a trade mark or service mark in which it has rights. The Complainant has clearly established that there is a trade mark in which it has rights. The Complainant's LUCCHESE trade mark has been registered and used in connection to its footwear and clothing business.

The Disputed Domain Name matches the Complainant's LUCCHESE trade mark except for the addition of the term "store". Where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Additionally, it is well established that generic Top-Level Domains ("gTLDs"), here ".com", may be disregarded when considering whether a disputed domain name is confusingly similar to a trade mark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Name to be identical to the Complainant's LUCCHESE trade mark.

#### **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel observes that the Respondent does not appear to be commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trade mark or service mark rights (there being no Response or evidence of any such rights). According to the information confirmed by the Registrar, the Respondent is named "秀英 阳" (Xiuying Yang). There are no indications that a connection between the Complainant and the Respondent exists or existed.

The Disputed Domain Name matches the Complainant's LUCCHESE trade mark except for the addition of the term "store". The Panel finds that using the Complainant's trade mark in this way signals an intention on the part of the Respondent to confuse users seeking or expecting the Complainant's online store (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Disputed Domain Name appears to refer to a website purporting to sell the Complainant's products at discounted prices without disclosing the relationship between the Complainant and the Respondent, and including both the word and stylized mark of the Complainant as shown above under section 4. Moreover, the Complainant indicates that on the website linked to the Disputed Domain Name, the Respondent lists a U.S. contact address which does not exist according to Google Maps and which does not match the Respondent's Chinese address given in the Whois records. The Panel finds that the above elements are indications of illegal activity using the Disputed Domain Name. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 2.13 of the [WIPO Overview 3.0](#)).

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

### **C. Registered and Used in Bad Faith**

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In the present case, the Panel finds that it is inconceivable that the Respondent was unaware of the Complainant and its trade mark rights when it registered the Disputed Domain Name. The Disputed Domain Name matches the Complainant's distinctive trade mark in its entirety with the addition of the term "store", and the website linked to the Disputed Domain Name even includes a copy of the Complainant's word and stylized trade marks displayed in a similar way as on the Complainant's official website. In the Panel's view, the Respondent's awareness of the Complainant's trade mark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#), where it was held that the respondent acted in bad faith when registering the disputed domain name, because widespread and long-standing advertising and marketing of goods and services under the trade marks in question, the inclusion of the entire trade mark in the domain name, and the similarity of products implied by addition of a telecommunications services suffix suggested knowledge of the complainant's rights in the trade marks).

The Respondent uses the Disputed Domain Name to resolve to a website, which appears to offer the Complainant's products at discounted prices. As mentioned above, this website includes a copy of the Complainant's word and stylized trade marks displayed in the exact same way as on the Complainant's official website. The Respondent's website features identical images of Complainant's goods, as used by the Complainant on its official website. The Respondent's website claims being the official website of

Lucchese, when it is not. In the Panel's view, this indicates that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trade mark (see section 3.1.4 of the [WIPO Overview 3.0](#)).

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is established that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last 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 <lucchesestore.com> be transferred to the Complainant.

*/Flip Jan Claude Petillion/*

**Flip Jan Claude Petillion**

Sole Panelist

Date: October 3, 2022