



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1100341
Complainant:	Guess?, Inc
Respondent:	Julija Perkovic

1. The Parties and Contested Domain Name

Complainant is Guess?, Inc, of 1444 South Alameda Street, Los Angeles, California 90021, United States of America..

Respondent is Julija Perkovic, of Ostrogovieva 7 ZAGREB, hrvatska 10000, Hrvatska, Croatia.

The domain name at issue is <guess-nakit.info>, registered by Respondent with GoDaddy.com Inc, of 14455 N. Hayden Rd.Suite 219 Scottsdale, AZ 85260, United States of America.

2. Procedural History

Complainant filed a Complaint on March 23, 2011 with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC) (the “Centre”), concerning domain name <guess-nakit.info> (the “Disputed Domain Name”) and naming Domains by Proxy, Inc. as Respondent.

On March 24, 2011, the Centre sent an e-mail to GoDaddy.com Inc requesting a registrar verification of the Disputed Domain Name. GoDaddy.com Inc e-mailed a response on March 27, 2011, stating that Respondent, Domains by Proxy, Inc., is not the registrant of the domain name. The registrant of the domain name is Julija Perkovic.

The Centre forwarded this information to Complainant on April 12, 2011 and explained that Complainant needed to file an amendment to its Complaint so as to mention the correct name of Respondent. Complainant submitted a revised Complaint, dated April 13, 2011 naming Julija Perkovic as Respondent.

The Centre sent an e-mail to Respondent on April 14, 2011, stating that a Complaint had been filed against her concerning the disputed domain name.

Respondent did not submit a response to the Complaint.

3. Factual background

For Complainant

Complainant is a leading supplier of fashion items for men, women, and children, including clothing, eye ware, handbags, belts, watches, footwear and jewelry.

Complainant was first established in 1981. Complainant's products are sold in 84 countries around the world, and Complainant operates 1,210 retail outlets worldwide. In the year ending 31 January, 2009, Complainant spent US\$ 5.1 million in the promotion of the GUESS brand.

Complainant is the holder of the mark GUESS in numerous countries around the world, including notably in Croatia where Respondent is located. Through extensive use and promotion, the GUESS trademark has gained substantial goodwill and reputation around the world.

For Respondent

Respondent has failed to file a response in this matter.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. **The Disputed Domain Name is identical and/or confusingly similar to the trade or service marks in which Complainant has rights.** The Disputed Domain Name, which incorporates the term "Guess" in its entirety, is identical or confusingly similar to Complainant's trade mark, and the addition of the word "nakit" is insufficient to distinguish it from the GUESS trademark. "Guess" is the distinctive and prominent element of the Disputed Domain Name, and the addition of a generic term does not negate the confusing similarity between the Disputed Domain Name and the GUESS mark.
- ii. **Respondent has no right or legitimate interest in respect of the Disputed Domain Name.** Complainant alleges notably that the Disputed Domain Name does not correspond to Respondent's own name. In addition, taking into account the fact that the trademark GUESS is well known, it is unlikely that Respondent registered the domain name guess-nakit.info without the trademark GUESS in mind. The Disputed Domain Name has also been registered using a privacy shield, which further demonstrates that the registrant does not have legitimate interest in the Disputed Domain Name. Finally, until recently, Respondent had used the Disputed Domain Name to operate a website which featured blog entries advertising counterfeited copies of the goods of famous brands, including GUESS.
- iii. **The Disputed Domain Name has been registered and is being used by Respondent in Bad Faith.** Respondent's registration and use of the Disputed Domain Name was in bad faith because it was done solely to misappropriate

Complainant's GUESS mark in order to attract, for financial gain, Internet users to its website by creating a likelihood of confusion with Complainant's GUESS mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website and the products offered on the website. In addition, Respondent appeared to be operating the website www.guess-nakit.info as a business to advertise counterfeited goods of many famous brands to Internet users who are likely to assume that Respondent's website is somehow associated with the complainant's business.

B. Respondent

Respondent has failed to file a response. Therefore, Respondent is in default.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy (the "Policy") provides, at Paragraph 4(a), that each of these three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name must be 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. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

According to Paragraph 4(a)(i) of the Policy, it must be established that Complainant has rights in the trade or service mark to which the Disputed Domain Name is identical or confusingly similar. Complainant has established its rights to the GUESS mark by evidence of its registered trademark portfolio.

The Panel notices that the Disputed Domain Name contains the element "guess" in first position. This element is identical to the trademark GUESS held by Complainant. The Panel is of the opinion that the addition of "nakit" to the term "guess" in the Disputed Domain Name does nothing to distinguish it from Complainant's GUESS mark. The Panel agrees with previous UDRP panels that the incorporation of a well-known trademark in its entirety as a dominant part of a domain name is "confusingly similar to this trademark regardless of whether the additional elements express endorsement, are pejorative or are of a more neutral kind..." (*Oakley, Inc. v. Joel Wong/BlueHost.com- INC*, WIPO Case n^o D2010-0100).

Finally, the Panel also notes that it is well established that, in making an enquiry as to whether a domain name is identical or confusingly similar to a trade mark, the domain extension, in this case <.info>, should not be taken into account (*"It has also long been held that minor features such as suffixes like the gTLD suffix ".com" cannot negate identity between a domain name and a trademark where it otherwise exists, as it does*

in the present case.” *Chickeeduck International Limited, Chickeeduck Distribution Limited and Chickeeduck Retail (Hong Kong) Limited/Swanbourne Inc*, ADNDRC Case n°HK – 1100328).

Therefore, the Panel concludes that the Disputed Domain Name is confusingly similar to Complainant’s GUESS trademark.

B) Rights and Legitimate Interests

According to the Policy, Paragraph 4(c), “[a]ny of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

In order for the Panel to assume that Respondent lacks legitimate interest in the Disputed Domain Name, due to the absence of evidence to the contrary from Respondent, Complainant must first present prima facie evidence that Respondent lacks rights or legitimate interests. The Panel agrees with a previous UDRP panel that the burden of proof shifts to Respondent once Complainant has shown prima facie evidence that Respondent lacks rights or legitimate interests (*Cummins Inc. v. DG Lanshan Mechanical Electrical Equipment Co., Ltd.*, ADNDRC Case n° HK-1000286).

Complainant has presented prima facie evidence that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Notably, the domain name guess-nakit.info does not reflect or correspond to Respondent's own name. In addition, the fact that Respondent used a privacy service when registering the Disputed Domain Name in order to hide her identity further demonstrates that the registrant does not have a legitimate interest in the disputed domain name.

Further proof that Respondent lacks rights or a legitimate interest is the fact that Complainant did not authorize or license Respondent to use the GUESS trade mark (see *RIO TINTO LONDON LIMITED v. li cheng*, ADNDRC Case n° CN-0900272). Last, but not least, Complainant has managed to demonstrate that Respondent had used, at some point, the Disputed Domain Name to operate a website where similar goods (rings) to those designated by Complainant’s trademark registration could have been offered for sale. Evidence provided by Respondent in this matter is not highly significant (notably, the document provided by Complainant is not in English and not translated), which implies

that it cannot be given too much weight. Nevertheless, it was not challenged by Respondent.

The Panel deems that Complainant has presented prima facie evidence that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Therefore, the burden of proof shifts to Respondent. However, the latter did not present any evidence demonstrating that she has legitimate interest in the disputed domain name.

Therefore, the Panel accepts Complainant's contention that Respondent does not have any legitimate interest in the Disputed Domain Name.

C) Bad Faith

Finally, Paragraph 4(b) of the Policy states, “[f]or the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

Evidence shows that Complainant's trademark GUESS is well known thanks to extensive use, promotion and advertisement. Therefore, it cannot be denied that the public has come to recognize and associate the trademark GUESS as originating from Complainant and no one else. In addition, “guess” does not seem to be a Croatian word.

It is likely that Respondent was aware of the existence of Complainant and its trademark when the Disputed Domain Name was registered.

In the absence of any evidence provided by Respondent legitimizing her registration of the disputed domain name and explaining in a convincing manner the choice of this particular name, the Panel cannot conclude otherwise than by stating that the registration of the Disputed Domain Name was made in bad faith (see *Inter Ikea System B.V., Delft, the Netherlands/Isaac Goldstein, Hong Kong*, Case No. HK-1000320).

Furthermore, based on evidence provided in the complaint, the Panel admits that it is possible that Respondent used the domain name guess-nakit.info for the purpose of financial gains by offering competing goods to those of Complainant for sale. Such use of the Disputed Domain Name can be explained by Respondent's will to attract Internet traffic by capitalizing on Complainant's trademark GUESS. This type of use of the Disputed Domain Name constitutes sufficient evidence of the bad faith of Respondent under paragraph 4(b)(iv) of the Policy. (see *Inter Ikea System B.V., Delft, the Netherlands/Isaac Goldstein, Hong Kong*, aforementioned). Respondent has not provided any reply contradicting this reasoning.

On this basis, the Panel deems that it is likely that Respondent registered and used the Disputed Domain Name by intentionally attempting to attract users, for commercial gain, to her website by creating a likelihood of confusion with Complainant's trademark GUESS as the source, sponsorship, affiliation or endorsement of Respondent's website.

6. Decision

Based on the foregoing findings, and in accordance with Paragraph 4(a) of the Policy, the Panel holds that the Disputed Domain Name is confusingly similar to Complainant's trademark GUESS; that Respondent has no rights or legitimate interests in the Disputed Domain Name; and that Respondent registered and used the Disputed Domain Name in bad faith.

The Panel orders that the domain name <guess-nakit.info> be transferred to Complainant.

Nathalie Dreyfus
Panelist

Dated: June 1st, 2011