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Guess? IP Holder L.P. and Guess? Inc., USA vs Thomas Staub, USA
INDRP Case no. 1812
Arbitrator: Mr. P.K.Agrawal

1 | Page

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AWARD

1. The Parties

The Complainant is Guess? IP Holder L.P. and Guess? Inc., 1444 South Alameda Street, Los Angeles, CA 90021.

The Respondent is Thomas Staub, 2701 Elk Rd Little, Casa Grande, AZ 85022 US.

2. The Domain Name and Registrar

The disputed domain name is <guessindiastore.co.in>. The said domain name is registered with the Registrar – NameCheap, Inc. (IANA ID: 1068). The details of registration of the disputed domain name (as per WHOIS details relevant to the Complaint) are as follows:

- a. Domain ROID: DA2C047ED8F61461682B367EBE390634A-IN
- b. Date of creation: Sept 26, 2023.
- c. Expiry date: Sept 26, 2024.

3. Procedural History

- (a) A Complaint dated 29.01.2024 by the Complainant has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the registrar verification in connection with the domain name at issue. The print outs confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.
- (b) The Exchange appointed the undersigned Mr. P.K.Agrawal, Former Addl. Director General in the Government of India, as the sole Arbitrator in this matter. The Arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.

In accordance with the Policy and the Rules, the copies of complaint with annexures were sent by the National Internet Exchange of India on 31.1.2024 by email. The Arbitrator served the Notice under Rule 5(C) of INDRP Rules of procedure along-with copies of complaint and annexures to the parties through email on 31.1.2024. The Complainant was advised

to serve copies of the domain complaint along with complete set of documents in soft copies as well as in physical via courier or post to the Respondent Registrant at the address provided in the WHOIS details of the domain. The Respondent was given 14 days' time by the Arbitrator through Notice dated 31.1.2024 for reply. The Notice email was served upon the Respondent email id given in WHOIS details, which was delivered. According to the Complainant's email dated 6.2.2024, the Complaint with annexures was sent to the Respondent through email on 6.2.2024 and FedEx Courier on 2.2.2024. The Complainant has submitted courier online tracking details in his email dated 6.2.2024 and stated that the courier delivery person made attempts to deliver the package, but the delivery could not be completed because the recipient's address given on record does not exist. In the above scenario, since the Complainant has already successfully delivered a complete set of the complaint and its exhibits to the Respondent through email, it will be appropriate if the Complaint and its annexures may be regarded to have been served to the Respondents as per Arbitration and Conciliation Act, 1996 and INDRP rules. Since the Respondent has not responded and presented any grounds in his defence, the present proceedings have to be conducted *ex parte* as per the Arbitration and Conciliation Act, 1996 and the .IN Domain Name Dispute Resolution Policy and the Rules of Procedures framed there under.

4. Factual Background

The Complainant in this arbitration proceedings is Guess? IP Holder L.P. and Guess? Inc., 1444 South Alameda Street, Los Angeles, CA 90021.

Complainants, Guess? IP Holder L.P. and Guess? Inc. (collectively "Complainants" or "Guess?"), own the world-famous GUESS brand which they have used for over 40 years in connection with their lines of men's and women's apparel and related goods (including women's handbags and shoes), and retail offering of the same. Guess? IP Holder L.P. is a Delaware limited partnership that is effectively wholly owned by

Guess? Inc. Guess? started in 1981 as a small California jeans company. While jeans remain the foundation of the company's history and success, Guess? designs, markets, and distributes its full collections of women's and men's apparel throughout the United States, India, and worldwide. In the 1980's, the Guess? product line expanded beyond men's and women's jeans to include baby apparel, watches, footwear, eyewear, and perfume. The 1990's saw rapid international expansion, bringing the GUESS brand to Europe, Asia, South America, and the Middle East.

In the mid-1990's, Guess? became a public company and launched its first website at the domain name guess.com. Guess? now operates websites at the domain names guess.com, gbyguess.com, and marciano.com. In 1995, Complainants expanded their retailing business by launching an e-commerce website at guess.com. The e-commerce website displays photographs of Guess?'s famous models and operates as a virtual storefront that sells both Guess?'s products and promotes Complainants' brands. The website also provides fashion information and a mechanism for customer feedback while promoting customer loyalty and enhancing Guess?'s identity through interactive content.

As a result of more than 40 years of use, Complainants have created in their GUESS Mark one of the most famous and distinctive marks in retailing. The GUESS Mark has acquired a valuable goodwill and reputation not only in the United States but throughout the world. Complainants are responsible for the operation of over 1,300 stores located in premier retailing locations in major markets worldwide. In addition to their exceptionally strong common law trademark rights, Guess? owns numerous Trademark Registrations for their GUESS Mark throughout the world. Guess? IP Holder L.P. licenses certain Guess trademarks and corresponding registrations. Guess? Inc. is a licensee of Guess trademarks, and has the right to use such marks.

A table listing some of the relevant registrations in India, and corresponding Certificates of Registration, is given below:

Trademark	Class	Registration No.	Registration Date
GUESS?	25	460982	9/30/1986
GUESS? And design	14,25	2655895	1/7/2014
GUESS	3,9,14,18,25,35	2656546	1/8/2014

Respondent's Identity and Activities

The Respondent's activities are not known. The Respondent has neither responded to the Notices served upon him nor submitted any reply to the complaint.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the

Policy are applicable to this dispute.

In relation to **element (i)**, the Complainant submits that the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

According to the Complainant:

- a. The Domain Name is identical or confusingly similar to Complainants' GUESS Marks. The Domain Name includes the word mark GUESS in its entirety along with a generic top-level suffix. Moreover, the Domain Name includes the use of a geographic term ("India"), which only exacerbates the likelihood of confusion since Complainants do business in India. *See, Hugo Boss Trade Mark Management GmbH & Co. KG, Hugo Boss AG v. Xu Xiaobei*, WIPO D2016-2456 (Jan. 31, 2017) (transferring domain name hugoboss-mexico.com where the Panel found that "The suffix "-mexico" is clearly used to geographically associate the Respondent's Website and/or Disputed Domain Name with Mexico" and that "the mere addition of generic or descriptive terms to a trademark in a domain name does not mitigate the confusing similarity between the mark and the domain name").
- b. The Domain Name also features an additional descriptive word, "store," which is merely descriptive of Complainants' business models (e.g., Complainants' clothing products and accessories are sold at retail stores and online, among other types of retail establishments), and furthers the likelihood of confusion. The resulting Domain Name is identical or confusingly similar to Complainants' GUESS mark. *See Samsung Electronics Co., Ltd. v. EAO Digital Solutions*, WIPO D2012-0693 (May 29, 2012) (finding <samsungtienda.com> confusingly similar to Samsung mark).
- c. The addition of the top-level suffix in the disputed Domain Name should be disregarded because it is a necessary requirement to register and use the dispute Domain Name, and would not be considered a distinctive element of the Domain Name but Internet consumers, which is well established by previous arbitrators. *See Lenovo (Beijing) Ltd. vs. Raj Kumar re <lenovoindia.co.in>*.
- d. Respondent's use of the GUESS Mark in its entirety within the Domain Name, along with the use of GUESS Marks on the website itself in connection with the retail sale of counterfeit and competitive apparel and accessories, seeks to capitalize on the goodwill Guess? has built in that brand and trademark by misdirecting consumers seeking Guess? and its genuine GUESS goods and services instead. Respondent's use of the GUESS Mark within the Domain Name and on the website at the

Domain Name falsely suggests a connection between Respondent and Guess? when none exists.

Accordingly, the Complainant contends that the first condition that Respondent's domain name is identical or confusingly similar to a name, trademark, or service mark in which the Complainant has rights, as per Paragraph 4 (a) of the Policy has been satisfied.

In relation to **element (ii)**, the Complainant contends that the Respondent does not have any right or legitimate interest in <guessindiastore.co.in>.

The Complainant submits:

- a. Respondent should be considered ineligible for rights or legitimate interests in respect of the impugned domain name. Respondent is not commonly known as "guess," or "guessindiastore" or any similar variation thereof, nor could it be because Complainants owned the exclusive right to use the GUESS Marks for over 40 years before Respondent registered the Domain Name. *See Solstice Marketing Corp. v. Marc Salkovitz d/b/a Image Media, LLC*, NAF 040087 (Aug. 31, 2007) (respondent was not commonly known by the disputed domain name because, in part, respondent lacked authorization to use complainant's registered service mark); *American Girl, LLC v. George Rau*, NAF 308206 (Apr. 2, 2010) (respondent was not commonly known by the disputed domain name when respondent was "not licensed or otherwise authorized to use" complainant's mark).
- b. Complainants are not associated with Respondent in any way and have not granted Respondent permission to use the GUESS Marks or any variation of the GUESS Marks within the Domain Name. Respondent uses the Domain Name unlawfully to sell counterfeit GUESS branded goods in direct competition with Complainants. Respondent further unlawfully uses the Domain Name for a website featuring Complainants' copyright protected images. Such use wrongfully capitalizes on the consumer recognition and goodwill associated with Complainants' GUESS Mark, which does not constitute a legitimate interest in the Domain Name. *See Compagnie de Saint Gobain v. Com-Union Corp.*, WIPO D2000-0020 (Mar. 14, 2000) (finding no rights or legitimate interests where the respondent had never applied for a license or sought permission from the complainant to use the mark); *Gorstew Ltd. v. Twinsburg Travel*, NAF 95424 (Sept. 21, 2000) ("The fact that the Respondent is a travel agent and sells Beaches Resorts vacations does not give it any interest or right to register the 'Beaches'

trademark, which it does not own or have a license to use, as a domain name and lead users to believe that the website is sponsored by an entity that owns the Beaches Resorts.”).

- c. Given Complainants’ longstanding use and trademark registrations for the GUESS Mark as well as the high reputation of Guess? and its brand, there is no plausible circumstance in which Respondent *could* legitimately use the Domain Name. *See Telestra Corporation Limited v. Nuclear Marshmallows*, WIPO D2000-0003 (Feb. 18, 2000) (holding that given the numerous trademark registrations and wide reputation for the mark TELESTRA, it was inconceivable to imagine that Respondent’s use was legitimate); *WordPress Fdn. v. Pham Dinh Nhut*, NAF 1603156 (Mar. 12, 2015) (complainant’s extensive and exclusive use of its mark warranted inference that respondent had knowledge of mark prior to registering the domain name).
- d. Respondent’s use of the GUESS Mark within the Domain Name is not a legitimate use, but a deliberate infringement of Complainants’ rights to misdirect traffic from Complainants to Respondent for the Respondent’s own financial gain. The Domain Name resolves to a website entitled “GUESS,” designed to mimic Complainants’ own website, that features counterfeit clothing, apparel, and accessories for sale designed to look like Complainants’ goods, with multiple imitation products featuring the GUESS Marks. Moreover, the website features obvious claims and implications which further associate it with the GUESS Marks (including the header), and illegally reproduces multiple images owned by Complainants. Based on these elements, Internet users are likely to wrongly believe that these Domain Name points to an official website of the Complainants. No conceivable *bona fide* use of the Domain Name exists when the intended use is a deliberate infringement of another’s rights. *See WebMD LLC v. Vittaria.com, Inc.*, WIPO D2009-1247 (Dec. 21, 2009) citing *Madonna Ciccone v. Dan Parisi*, WIPO D2000-0847 (Oct. 12, 2000).
- e. Further, selling unauthorized and illegitimate goods featuring Complainants’ Mark is compelling evidence that Respondent has no rights or legitimate interests in respect of the Domain Name, because there can be no legitimate interest in the sale of counterfeit goods. *Lilly ICOS LLC v. Dan Eccles*, WIPO Case No. D2004-0750. (“...if the goods are counterfeit, that would be powerful evidence that Respondent lacks rights or a legitimate interest in the use of the domain name because there can be no legitimate interest in the sale of counterfeit goods.”)

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Based on the above-mentioned arguments, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, as per Paragraph 4 (b) of the Policy.

Regarding the **element (iii)**, the Complainant contends that the Domain Name has been registered and used in bad faith for the following reasons:

- a. The Domain Name was registered and is being used in bad faith. Respondent uses the Domain Name to offer counterfeit goods under the Complainants' Mark, deriving a profit from the wrongful and illegal use of Complainants' Marks. Respondent is intentionally using, for commercial gain, Complainants' GUESS Marks in the Domain Name and on the associated website by creating a likelihood of confusion with Complainants. The harm is exacerbated as the website at the Domain Name features Complainants' copyright protected images and gives the impression of being Complainants' official website when it is not. Complainants have never given express permission for Respondent to use the GUESS Marks in the Domain Name, and Respondent is not a licensee authorized to use Complainants' GUESS Marks in the Domain Name or in any other manner. Moreover, given the reputation of the GUESS Marks, registration and use in bad faith can be inferred.
- b. Complainants have used the GUESS Mark for more than 40 years before the Domain Name was registered this year, on September 26, 2023. The mere initial interest confusion caused by the similarity between the GUESS Mark and the Domain Name should be sufficient for a finding of bad faith. *See Madonna Ciccone v. Dan Parisi*, WIPO D2000-0847 (initial interest confusion can be the basis for a finding of bad faith).
- c. Further, where a domain name is so obviously connected with a well-known trademark, its very use by someone with no connection to the trademark suggests opportunistic bad faith. *See L'Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter* WIPO D2018-1937 (Oct. 12, 2018). Given the reputation and fame of the GUESS trademark, registration in bad faith can be inferred.
- d. The Domain Name is currently used to direct Internet users to a website entitled "GUESS" which impermissibly features Complainants' own copyright protected images. Respondent's website at the subject Domain Name also offers for sale numerous counterfeit GUESS items that feature the GUESS Marks. When a domain name is used to sell counterfeit goods in competition with those offered under Complainants' Marks and diverts Internet users seeking Complainants' website to a website for Respondent, such use clearly demonstrates bad

faith. See *Dollar Financial Group, Inc. v. Bankshire Corp.* FA 13686 (Forum Jul. 30, 2007) (respondent's use of confusingly similar domain name to complainant's mark, to redirect Internet users to respondent's own commercial website offering goods and services in direct competition with complainant's goods was evidence of bad faith registration and use under Policy); *S. Exposure v. S. Exposure, Inc.*, FA 94864 (Forum Jul. 18, 2000) (finding the respondent acted in bad faith by attracting Internet users to a website that competes with the complainant's business); *Chan Luu Inc. v. Li Yong Ze*, FA 1463461 (Forum Nov. 2, 2012) (use of a confusingly similar domain name to compete with a complainant's business by marketing counterfeit goods is disruptive and demonstrates bad faith registration and use pursuant to the Policy ¶ 4(b)(iii)); *Juicy Couture, Inc. v. Chinasupply*, FA 1222544 (Forum Oct. 13, 2008) (holding that the selling of counterfeit versions of a complainant's products disrupted the complainant's business and is evidence of bad faith registration and use).

- e. Respondent uses the Domain Name to attract, for commercial gain, users to its own website, which is textbook evidence of bad faith registration and use. See *General Electric Co. v. Japan, Inc.*, WIPO D2001-0410 (June 14, 2001) ("The Domain Name is designed to imply that there is an affiliation between Respondent and Complainant or that GE endorses Respondent's activities even though no such affiliation or endorsement exists. ICANN panels have addressed such situations in several instances and have consisten[tly] held that it is bad faith to misrepresent an affiliation with a third party where none exists"). Put another way, Respondent's intentional diversion of customers from Guess? to its website demonstrates Respondent's bad faith registration and use of the Domain Name. *Best Western Int'l, Inc. v. Hasidim*, NAF 96480 (March 12, 2001) citing *Big Dog Holdings, Inc. v. Day*, NAF 93554 (Mar. 9, 2000) (finding bad faith where Respondent was diverting consumers to its own website by using Complainant's trademarks).

In view of the aforesaid, the Complainant submits that the disputed domain name has been registered and is being used in bad faith, and that paragraph 4(c) of the INDRP is satisfied.

B. Respondent

The Respondent has neither responded to the Notice nor submitted his reply.

6. Discussion and Findings

The Rules instruct this arbitrator as to the principles to be used in rendering its decision. It says that, “a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable”.

According to the Policy, the Complainant must prove that:

- (i) The Registrant’s domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Registrant has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The Registrant’s domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name < guessindiastore.co.in > was registered by the Respondent on Sept 26, 2023.

The Complainant is an owner of the registered trademark GUESS for the last many years. The Complainant is also the owner of the similar domain as referred to in the Complaint. This domain name and the trademark have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. In the present case the disputed domain name is <guessindiastore.co.in>. Thus, the disputed domain name is very much similar to the name, activities and the trademark of the Complainant.

The Hon’ble Supreme Court of India has in the case of *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.*, [2004Supp. (2) SCR 465] held that the domain name has acquired the characteristic of being a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser looking for GUESS products would mistake the disputed domain name as of the Complainant.

In the case of *Wal Mart Stores, Inc. v. Richard MacLeod*, (WIPO Case No. D2000-0662) it has been held that “When the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” it is identical or confusingly similar for purposes of the Policy.

Therefore, I hold that the domain name <guessindiastore.co.in> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's 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) the Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) The Registrant is making a legitimate non-commercial 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 Case No. INDRP/776, *Amundi v. GaoGou*, the arbitration panel found that the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4 (II) of the INDRP Policy.

There is no evidence to suggest that the Respondent has been known by "guess," or "guessindiastore" or any similar variation thereof anywhere in the world. The name of the Registrant / Respondent is not GUESS as per WHOIS details. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainant has not consented, licensed, or otherwise permitted the Respondent to use its name or trademark GUESS or to apply for or use the domain name incorporating said trademark / service mark. The domain name bears no relationship with the Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

As has been contended by the Complainant, the Respondent is not making a legitimate, fair or *bona fide* use of the said domain name for

offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name <guessindiastore.co.in> under INDRP Policy, Para-4(ii).

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant has 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 the Registrant has engaged in a pattern of such conduct; or
- (iv) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

In WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe - "Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use."

The circumstances as evident from the foregoing paragraphs lead to the conclusion that the domain name in dispute was registered and used by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the domain name was registered in bad faith and is being used in bad faith, it is clear beyond doubt that the Respondent has violated the provisions of Rule-3 of the Policy. Therefore, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <guessindiastore.co.in> be transferred to the Complainant.

No order to the costs.



Prabodha K. Agrawal
Sole Arbitrator
Dated: 15th Feb, 2024