



DECISION

Guess? IP Holder L.P. and Guess? Inc. v. The Web Group

Claim Number: FA1802001770358

PARTIES

Complainant is **Guess? IP Holder L.P.** (“First Complainant”) and **Guess? Inc.** (“Second Complainant”) (collectively, the “Complainants”), represented by **Gary J. Nelson** of **Christie, Parker & Hale, LLP**, California, USA. Respondent is **The Web Group** (“Respondent”), District of Columbia, USA. Respondent is not represented by legal counsel.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <g81.com>, registered with **1API GmbH**.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

David L. Kreider as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on February 2, 2018; the FORUM received payment on February 2, 2018.

On February 6, 2018, 1API GmbH confirmed by e-mail to the FORUM that the <g81.com> domain name is registered with 1API GmbH and that Respondent is

the current registrant of the name. 1API GmbH has verified that Respondent is bound by the 1API GmbH registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "UDRP" or "Policy").

On February 8, 2018, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint. Also, on February 8, 2018, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts. Thereafter, on March 6, 2018, upon the application of Respondent, finding that extenuating circumstances existed warranting an extension, the Forum granted Respondent an extension of time and fixed a revised deadline of March 20, 2018, by which Respondent could file a response to the Complaint, via e-mail, to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@g81.com.

A deficiency letter from the Forum dated March 21, 2018, states that Respondent's Response was received after the deadline to file a response had passed. The letter notes that the Forum does not consider the Response to be in compliance with ICANN Rule #5 (a), requiring the Respondent to submit a response to the Provider "within twenty (20) days of the date of commencement of the administrative proceeding".

On March 28, 2018, pursuant to Complainants' request to have the dispute decided by a single-member Panel, the FORUM appointed David L. Kreider as Panelist.¹

¹ Because Respondent's Response and request for a three (3) member panel was not submitted timely, the Forum informed the Respondent that it could not accept Respondent's request, but would appoint a single-member panel.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

Complainants requests that the domain name be transferred from Respondent to Complainants.

PARTIES' CONTENTIONS

A. Complainants

Complainants describe themselves as owners of the world-famous GUESS brand, which they have used for over 30 years in connection with their lines of men's and women's apparel and related goods. Complainants aver that the Disputed Domain Name, <g81.com>, registered by Respondent, "is unlawfully attracting Internet Users looking for Complainants' G81 branded products to a commercial parking website which hosts pay-for-click advertisements." (Emphasis supplied).

The Complaint further alleges that "Complainants' have also been using their G81 trademark for shirts, T-shirts, jeans and pants beginning at least as early as January 23, 2001"² and that "[] Guess? owns at least one Trademark Registration for their G81 Mark in the United States and has secured additional registrations for the G81 Mark outside the United States." Complainants proffer USPTO trademark registration no. 2,423,778 for the G81 Mark, which reflects

² As will be discussed below, notwithstanding this allegation, Complainants provided no evidence that they offered any products or services in commerce in connection with the G81 Mark "as early as January 23, 2001," or at any time.

that the Mark was registered on January 23, 2001 by the Second Complainant, Guess?, Inc., a Delaware Corporation.

Complainants aver that the Disputed Domain Name is identical or confusingly similar to Complainants' G81 Mark and that Respondent has no legal relationship with Complainants that would entitle Respondent to use Complainants' Mark. Complainants proffer screen captures showing Respondent's use of the Disputed Domain Name to host parking pages populated by pay-per-click advertisements for goods and services offered by companies that compete directly with Complainants, as evidence that Respondent is not making a *bona fide* offering of goods or services with the Disputed Domain Name and, therefore, that the Respondent has no legitimate interest under the circumstances described in ¶ (4)(c)(i) of the Policy.

The Complainants aver that Respondent is using the Disputed Domain Name to display links to various third-party websites that re-direct visitors to websites featuring clothing products and related goods and services offered by entities in direct competition with Complainants. They argue that this satisfies the bad faith prong of the Policy.

Complainants additionally argue that a finding of bad faith is required because, "In response to Complainant's initial correspondence,³ Respondent stated that the cost to purchase the G81.com domain was US\$25,000." (Emphasis supplied). Respondent's offer to sell the Disputed Domain Name for US\$25,000, Claimants urge, far exceeds the Respondent's out-of-pocket costs and provides further evidence of Respondent's bad faith.

³ As the Complaint alleges, it was the Complainants, acting through an agent, who initiated communications with Respondent in August of 2013, with a view to purchasing the Disputed Domain Name for US\$8,000. As will be further explained below, Complainants' thereafter increased their offer to US\$10,000. Respondent acknowledges that Complainants' offered sums far exceeded Respondent's out-of-pocket costs.

Complainants additionally assert the position that Respondent had constructive knowledge of “Complainants’ rights in their G81 Mark due to Complainants’ prior United States trademark registration of the G81 Mark” and that this, without more, is evidence of bad faith registration and use of the domain name pursuant to ¶ (4)(a)(iii) of the Policy.

Finally, Complainants urge that the registration of a confusingly similar domain name that is “obviously connected with a particular trademark owner” by someone with no connection to the trademark owner supports a finding of bad faith pursuant to ¶ (4)(a)(iii) of the Policy.

B. Respondent

Respondent is a domain name speculator who has a large portfolio of several hundred generic 2 and 3-character acronym domain names.

Respondent registered the Disputed Domain Name, <g81.com>, some 14 years ago, on or about June 5, 2004. Prior to its registration by Respondent, the Disputed Domain Name had been registered by another party whose registration had since expired.⁴

Respondent proffers the sworn declaration of its principal, John Gates, wherein Mr. Gates attests that “he [had] never heard of Complainants’ G81 brand prior to [his receiving] notice of the within dispute.”

⁴ As a general proposition, Respondent argues, a purchaser of a previously registered, but expired, domain name should be entitled to purchase with greater confidence than a registrant who selects a previously unregistered name. This is because the deletion of the prior registration is a signal that the prior registrant has abandoned all claims to the domain name. *See, Corbis Corporation v. Zest*, FA 98441 (Nat. Arb. Forum Sept. 12, 2001).

Respondent avers: “At no time did Respondent ever register the Domain Name to target Complainant, or to take advantage of Complainant, or to interfere with Complainant, or to sell [the Disputed Domain Name] to Complainant.” Rather, Respondent alleges, “In or about June 5 of 2004, i.e. the very same day as Respondent registered the Disputed Domain Name, Respondent also registered the following 3 similar domain names wc9.com, g83.com, and g87.com.”

Respondent observes that the mark, G81, is not unique to Complainants, and that third-party trademark registrations for G81 exist in Columbia and in Spain. A Google search conducted by Respondent yielded over 1.5 million results for G81, “virtually none” relating to Complainants.

Significantly, Respondent submitted evidence that it had conducted a search for the term “G81” on Complainants’ official website at GUESS.COM, which yielded the response, “SORRY, WE COULD NOT FIND ANY MATCHES FOR ‘G81’”.

Respondent concedes that Respondent did present the Disputed Domain Name for sale to the general public by way of an automated “for sale” banner, in the ordinary course of Respondent’s business dealing in generic \acronym domain names. In any event, Respondent insists, “at no time was the Domain Name offered to Complainants, or either of them, nor did Respondent make any effort whatsoever to contact or to solicit Complainants. For 14 years since Respondent’s registration and use of the Domain, Complainants have remained silent and never alleged any infringement whatsoever [].”

C. Additional Submissions

On March 22, 2018, and on March 27, 2018, respectively, both the Complainant and the Respondent submitted timely additional submissions, which the Panel has carefully considered in reaching its decision.

FINDINGS

Respondent's Response was Untimely and therefore Deficient

Respondent submitted a detailed, 14-page, single-spaced, Response, dated "March 20, 2018". As is noted above, however, the Forum advises that the Response was submitted after the extended March 20, 2018 deadline for filing required under the Policy and is, thus, untimely. In an email to the Forum on March 22, 2018, Respondent argues that the Response "was in fact filed at 11:20 US Pacific Time on March 20, the due date," and that attempts to email the documents earlier that day "were delayed briefly due to technical issues with Yahoo Mail, our service provider."

The Panel notes a covering email from Respondent's representative bearing the date "Wednesday, March 21, 2018" and the time "1:21 AM" at which the Response was "sent" in the email header. It appears to the Panel that the Forum received the Response on "21/03/2018" at "9:45 PM". It should be noted that it is the date and time of the Forum's receipt of the submission which is controlling. The Forum's Supplemental Rules provide in the "Definitions" section at paragraph 1 (f), that "documents are deemed submitted when received by the Forum's mail server."

The Panel finds that Respondent's Response was submitted untimely and is therefore deficient under the UDRP Rules.

Although the Response is deficient, the Panel will nonetheless exercise its discretion under paragraph 10(b) of the Rules to consider the Response in this decision in order to permit each party "a fair opportunity to present its case." *See, J.W. Spear & Sons PLC v. Fun League Mgmt.*, FA 180628 (Nat. Arb. Forum Oct. 17, 2003); *Victoria's Secret Stores Brand Management, Inc. v. AJ LaFond*, FA 1362225 (Nat. Arb. Forum Jan. 7, 2011).

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Preliminary Issue: Multiple Complainants

In the instant proceedings, there are two Complainants. Paragraph 3(a) of the Rules provides that "[a]ny person or entity may initiate an administrative proceeding by submitting a complaint." The FORUM's Supplemental Rule 1(e) defines "The Party Initiating a Complaint Concerning a Domain Name Registration" as a "single person or entity claiming to have rights in the domain name, or multiple persons or entities who have a sufficient nexus who can each claim to have rights to all domain names listed in the Complaint."

The Panel notes that the Second Complainant, Guess?, Inc., is the named registrant of the USPTO trademark registration of the Mark, yet Complainants' submissions provide no explanation as to the "nexus" or connection, if any exists, between the Second and the First Complainant. The Complaint merely refers to "Complainants", collectively, as the owners of the Mark, without further elucidation.

In view of the Panel's decision to deny relief to Complainants, the issue is largely academic and need not be decided.

Identical and/or Confusingly Similar

The Panel finds that the Disputed Domain Name, which incorporates the Mark in full, is identical to the Complainants' registered G81 Mark. It is axiomatic, moreover, that the addition of the gTLD ".com" does nothing to distinguish the Disputed Domain Name from the Mark and is immaterial in the circumstances.

Complainants have standing to pursue the present administrative proceedings. Complainants have satisfied the requirements of Policy Paragraph 4(a)(i). This conclusion is also expressly conceded by Respondent.

Rights or Legitimate Interests

Numerous panels have held that the registration of two, three, and four-character domain names, even by domain name speculators such as Respondent, can constitute a "legitimate interest" as understood by the Policy. *See, Automóviles de Luarca, S.A. v. NUCOM, DomainName Brokers*, WIPO Case No. D2005-0282.

The Panel finds that the Respondent has set forth a plausible and reasonably well-documented explanation of how it obtained potentially legitimate rights in the Disputed Domain Name, which contains a widely registered and used three-character combination. Respondent has additionally shown that third-party entities also have rights in, or make use of, the same three-character combination trademarked by the Second Complainant. Complainants do not enjoy exclusive or monopoly rights over this common acronym.

Complainants have failed to satisfy the requirements of Policy Paragraph 4(a)(ii).

Registration and Use in Bad Faith

The Panel accepts Respondent's evidence that Respondent was unaware of and did not target the Second Complainant's G81 Mark.

The Panel notes that, upon receiving the Complaint, Respondent sent a number of emails to Complainants, on February 16, 21, 22, 26 and 27 of 2018, explaining that, following extensive inquiries, Respondent had been unable to find any instances of Complainants' use of the G81 Mark anywhere on the Internet or indeed, of any instances of a "G81" product or service being offered by Complainants in commerce, as might be expected to put Respondent on notice of Complainants' Mark.

The March 20, 2018, sworn declaration of Respondent's principal, John Gates, recites at paragraph 10:

"Subsequent to receipt of the Complaint I have attempted to verify actual use of the mark G81 to no avail. The Complaint lacks any such evidence and Complainant's counsel has refused to respond whether there is actual use []. I have found virtually no trace of the mark in connection to the Complainant online. On February 13 I called three local Guess [?] stores inquiring about G81 and was told 'we don't carry any such product'. On the same day I called Guess [?] national call center at 877-444-8377 and was assured they do not carry any G81 brand or related product and in fact the operator had 'never heard of such a thing'".

The Panel found no examples in the Complaint, or in Complainants' exhibits, of any actual use of the G81 Mark by Complainants, as might be expected reasonably to have put Respondent on notice of Complainants' Mark.⁵

As Respondent observes in its Additional Submission, correctly in the Panel's view, "Complainant has not provided a scintilla of evidence for its use of G81 – None!! Yet has purposely attempted to mislead by implying fame []. How can Internet users [be] looking for Complainants' G81 branded products' when no such product[s] exist in the marketplace?!"

As Respondent's Additional Submission makes clear, contrary to the repeated references in the Complaint to "Complainant's well-known G81 Mark"; their "G81 branded products"; their purported "goods or services distributed under the Mark"; and "Complainants' have also been using their G81 trademark for shirts, T-shirts, jeans and pants beginning at least as early as January 23, 2001", Complainants have provided no evidence whatsoever showing any use of the Mark or connection between the G81 Mark and Complainants.

Under all the circumstances, the Panel accepts the Respondent's evidence that Respondent was unaware that its <g81.com> domain name registration would be identical or confusingly similar to the Complainants' Mark. The Panel finds that Respondent lacked actual or constructive notice of Complainants' Mark prior to its receipt of the Complaint. As has been noted, no products or services offered by Complainants using the Mark can be found even by searching Complainants' official website.

⁵ In fact, it was the Respondent who submitted a "specimen" of the Mark as evidence in these proceedings. The specimen, consisting of a cloth tag, about the size of a thumbnail, bearing the Mark, had apparently accompanied the Second Complainant's USPTO filing. The Response recites in this regard, "According to Complainant's Trademark application before the USPTO it's specimen is a miniscule clothing label inside the product and not visible unless sought."

Viewed against these facts, the assertion by Complainants that Respondent's website, "targets Complainants by targeting products sold by Complainants and for which the G81 mark is registered", is both erroneous and misleading.

Complainants additionally argue that bad faith at the time of registration should be inferred, "based on the extraordinarily high asking price of \$25,000 for the domain name". The Panel finds no merit in Complainants' assertions.

It appears from Complainants' exhibits that Complainants themselves made the initial offer in 2013, through an agent, to purchase the Dispute Domain Name for US\$8,000.⁶ Respondent has adduced evidence that Complainants thereafter sought to purchase the Disputed Domain Name anonymously on the Sedo platform for US\$10,000. On or about the same date in 2013, Respondent counter-offered to sell the Disputed Domain Name for the sum of EUR25,000. The Panel notes that these negotiations took place some five (5) years before the present UDRP proceedings in which Complainants complain of alleged infringement.

Reverse Domain Name Hijacking

As noted above, Complainants allege that Respondent's website "targets Complainants by targeting products sold by Complainants and for which the G81 mark is registered", and that "Complainants' have also been using their G81 trademark for shirts, T-shirts, jeans and pants beginning at least as early as

⁶ Complainants' allege that, "Prior to instituting this proceeding, Complainants contacted Respondent seeking to reach an amicable resolution to this dispute." This allegation is misleading. Respondent asserts, and the record shows, that the only contact Complainants had with Respondent was via an intermediary for the purpose of offering to purchase the Disputed Domain Name for US\$8,000, which offer was thereafter raised to US\$10,000. Moreover, these events took place in 2013, some five (5) years before Complainants instituted these proceedings. The Panel accepts that Complainants took no steps whatsoever to communicate with Respondent during the weeks and months leading up to the institution of these UDRP proceedings to discuss an "amicable resolution to this dispute."

January 23, 2001.” Complainants have adduced no exhibits or evidence to support their allegations or identify such G81 branded items.

Upon receiving the Complaint in these UDRP proceedings, Respondent wrote to Complainants on February 16, 2018, asking: “Simply put, how can there be a confusion caused by our registration and use of G81.COM when there is no “G81” product offered by your client in the market to be confused with?!”

Respondent’s emails to Complainants spelled out in detail the nature of Respondent’s business model and the circumstances of Respondent’s registration and use of the Disputed Domain Name, explaining clearly and explicitly the Respondent’s reasons for concluding that Complainants would be unwise to persist in their “frivolous [UDRP] action”. Respondent sent copies of its emails to the Forum, “to be added to the file as pre-Response correspondence”.

Thus, from the outset, Respondent squarely put the question to Complainants, which the Panel now paraphrases as asking: “How can I have intentionally targeted your G81 branded products, when we can find no such products on the market? Tell us which of your products are offered under the G81 mark, which are said to have put us on notice of your rights in the Mark?” From that time forward, Complainants have, in the view of the Panel, “stone-walled” the Respondent, rebuffing this relevant and material question with the reply: “Complainants are neither required nor obligated to show how they use the G81 Mark”.

Respondent’s submissions have shown that despite repeated calls by Respondent for Complainants to specify and identify exactly what products and services Complainants offer in commerce in connection with the G81 Mark, which might have put Respondent on notice of Complainants’ Mark,

Complainants have continuously failed and refused to do so, and have largely ignored and failed to so much as acknowledge Respondent's focused inquiries.

In its Additional Submission, Complainants berate the Respondent as having "fixated on irrelevant issues", and criticize what Complainants refer to as "Respondent[s] attempts to cloud the issues" and for "dedicating the majority of its response to irrelevant purported facts and arguments which have no bearing on the present UDRP proceeding." Complainants conclude: "Respondent's attempts to mislead the Panel should be disregarded, and the subject domain name should be transferred to Complainants."

This Panel finds, quite to the contrary, that Complainants' reliance on the decision of a prior panel in *Wells Fargo Advisors, LLC v. Kenneth Kopp*, Case No. FA1403001548510 (Nat. Arb. Forum Apr. 21, 2014), as purported authority in the present proceeding, is wholly misplaced and is yet another example of *Complainants* attempts to obfuscate the true facts and to mislead this Panel.

Wells Fargo was an action by an affiliate of the Wells Fargo bank concerning the famous trade mark "A.G. EDWARDS", a leading securities broker, investment bank and financial services company, which it owned. In that case, the respondent had registered the domain name <agedwards.biz> for the purpose, the panel in that case found, of directing Internet users to a website titled AG Edwards, offering services competing with the services of the complainant.

The *Wells Fargo* respondent argued that the "A.G. EDWARDS" trade mark had been abandoned by the prior holder and had not been property assigned to the complainant in that case. The learned panel disagreed, finding that the complainant had provided evidence to support its assertions of ownership in and to the "A.G. EDWARDS" mark.

In the present case, the Respondent expressly concedes Complainants' standing to institute a UDRP case based upon Complainants' USPTO registration of the G81 Mark prior in time to the Respondent's registration of the Dispute Domain Name. Unlike *Wells Fargo*, which concerned a famous and well-recognized mark that is uniquely associated with the A.G. Edwards investment bank and securities brokerage firm, Respondent here asserts that the G81 mark is neither famous nor is it solely associated with Complainants -- and, indeed, that Respondent's diligent search disclosed virtually no connection between G81 and any of Complainants' products or services, such as could be expected reasonably to put Respondent on notice of Complainants' duly registered G81 Mark.

The Panel accepts Respondent's evidence that Complainants initiated these UDRP proceedings with full knowledge that "there simply cannot be a case made for 'actual knowledge of the mark G81' when the mark is not in fact in use."

The Panel finds that Complainants acted in bad faith in alleging the intentional targeting of "Complainants' G81 branded products", knowing full well that no such products had been marketed by Complainants.

The Complaint provides no evidence of bad faith registration or use of the Disputed Domain Name directed towards or "targeting" Complainants, or either of them. The Panel finds that Complainants knew or should have known that they would be unable to prove that Respondent lacks rights or legitimate interests in the <g81.com> domain name and that Respondent registered and is using the disputed domain name in bad faith. Moreover, the Panel finds that Complainants have sought to use the UDRP as a Plan "B" option to attempt, wrongfully, to

wrest the Disputed Domain Name from Respondent after the commercial negotiations Complainants commenced had broken off some five (5) years ago.⁷

Based on the facts above described, the Panel finds that reverse domain name hijacking has occurred. *See NetDepositVerkaik v. Crownonlinemedia.com*, D2001-1502 (WIPO Mar. 19, 2002) (“To establish reverse domain name hijacking, Respondent must show knowledge on the part of the complainant of the Respondent’s right or legitimate interest in the Domain Name and evidence of harassment or similar conduct by the Complainant in the fact of such knowledge.”); *see also Labrada Bodybuilding Nutrition, Inc. v. Glisson*, FA 250232 (FORUM May 28, 2004) (finding that complainant engaged in reverse domain name hijacking where it used “the Policy as a tool to simply wrest the disputed domain name in spite of its knowledge that the Complainant was not entitled to that name and hence had no colorable claim under the Policy”).

DECISION

Having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the <g81.com> domain name **REMAIN WITH** Respondent. Because Complainants brought this Complaint in bad faith, the Panel finds **REVERSE DOMAIN NAME HIJACKING BY COMPLAINANTS**.

David L. Kreider, Panelist

Dated: March 31, 2018

⁷ It remains an open question why Complainants chose to delay taking action for five (5) years, knowing full well of the existence of the Disputed Domain Name and of Respondent’s purported infringing conduct, before instituting these UDRP proceedings.