

## **DISPUTE RESOLUTION SERVICE**

**D00021910**

### **Decision of Independent Expert**

NG Brand

and

DUAN ZuoChun

#### **1. The Parties**

Lead Complainant: NG Brand  
1, Quai Voltaire  
Paris  
75007  
France

Respondent: DUAN ZuoChun  
19 - 20 Great Sutton Street  
London  
EC1V 0NB  
United Kingdom

I refer herein to the Parties as the “Complainant” and the “Respondent” respectively.

#### **2. The Domain Name:**

nicolas-ghesquiere.uk

#### **3. Procedural History**

- 3.1. I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need to be disclosed because

they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

- 3.2. This dispute is governed by the Nominet Dispute Resolution Service Policy version 4 (the “DRS Policy”). I refer also below to the Dispute Resolution Service – Experts’ Overview, version 3, dated December 2016 (the “DRS Experts’ Overview”). Both the DRS Policy and the DRS Experts’ Overview are available for download from the Nominet website. I adopt definitions from the DRS Policy and the DRS Experts’ Overview in this decision.
- 3.3. The Complaint was received by Nominet on 30 September 2019. On 1 October 2019 the Complaint was validated, and notification was sent to the Parties. No Response was received. A Response reminder was sent on 18 October 2019, but again, no Response was received. Notification that no Response had been received was sent to the Parties on 28 October 2019.
- 3.4. In those circumstances, the Complainant was entitled to pay either for a summary decision or for a reasoned decision. In the event, it chose the latter, and payment was received on 30 October 2019.

#### **4. Factual Background**

- 4.1. Since there is no Response, the facts set out in the Complaint are not in dispute. There are no obviously incredible factual allegations in the Complaint. In those circumstances, I can take the facts in the Complaint as true. I set out below those facts which I consider to be relevant.
- 4.2. The Complainant operates in the field of design, manufacture and distribution of women’s fashion and fashion accessories. Nicolas Ghesquière is the chairman of the Complainant.
- 4.3. M. Gesquière is a fashion designer, whose name is the subject of the following three registered trade marks, each of which is owned by the Complainant and which covers, for example, items of clothing and advertising, exhibition and promotional services in relation to clothing (the “NG Trade Marks”).
  - i. French trademark no. 4447083 “NICOLAS GHESQUIÈRE”, registered on 24 August 2018;<sup>1</sup>
  - ii. European Union trade mark no. 017969592 “NICOLAS GHESQUIÈRE”, registered on 21 March 2019;

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<sup>1</sup> The Register notes that this trade mark was applied for by “*Monsieur Nicolas Ghesquière, Acting in the name and on behalf of “NG Brand”, Company in the process of being incorporated.*” I am prepared to accept that statement as indicative that the Complainant is the owner of the trade mark.

- iii. International Registration no. 1460858 “NICOLAS GHESQUIÈRE”, registered on 17 October 2018.
- 4.4. M. Ghesquière was the creative director of a French fashion house known as ‘Balenciaga’ from 1997 until 2012, and has been the creative director of the fashion house ‘Louis Vuitton’ since 2013.
- 4.5. The Complainant has annexed a report (in French) which includes an extract from a ‘Whols’ lookup for the Domain Name indicating that the Domain Name was registered on 3 May 2019.
- 4.6. At the time of the Complaint (i.e. on 30 September 2019) the Domain Name was not being used for the sale or advertising of any product or service. The Domain Name resolved to a website which advertised the Domain Name for sale and invited offers in that regard.
- 4.7. There does not appear to have been any relationship or contact between the parties. The Complainant does not know who the Respondent is.

## **5. Parties’ Contentions**

- 5.1. The Complainant says that the sign NICOLAS GHESQUIÈRE enjoys a high reputation in the fashion industry, and that the three NG Trade Marks have been well known worldwide for many years. In particular, it says (with my emphasis) that *“the international renown of the trademark NICOLAS GHESQUIÈRE in the field of fashion is indisputable.”*
- 5.2. The Complainant asserts that the Domain Name is in material terms identical to the NG Trade Marks, in particular because the “.uk” suffix will be ignored by consumers.
- 5.3. The Complainant then makes six submissions as to why the Domain Name is an abusive registration.
  - i. First, the Complainant asserts that the Domain Name *“constitutes an infringement”* of the NG Trade Marks.
  - ii. Second, that when registering the Domain Name the Respondent *“could not have ignored”* that it was reproducing the sign NICOLAS GHESQUIÈRE that was the subject of the NG Trade Marks and that was internationally known.
  - iii. Third, that the Respondent deliberately concealed its identity and knowingly sought to monopolize the Domain Name that is identical to the NG Trade Marks in a completely illegitimate manner.

- iv. Fourth, that the Respondent does not make actual use of the Domain Name, but rather is offering it for sale through a bidding system. In this regard, the Respondent expressly relies upon “*Section 3(a)(i)A of the Policy.*” Here the Respondent is citing from an older version of the DRS Policy, which ceased to be in force on 30 September 2016. It would be sensible for complainants to check for updates to the DRS Policy when filing complaints. The equivalent section in the current DRS Policy is section 5.1.1.1, and I will proceed accordingly.
  - v. Fifth, that the Respondent has no legitimate interest in the Domain Name since the Respondent does not own any rights to the NICOLAS GHESQUIÈRE sign, and has no right to use that sign, especially in relation to fashion goods and services.
  - vi. Sixth, that it is obvious that the Domain Name was registered in bad faith.
- 5.4. The Complainant relies on two prior decisions. The first is a Nominet expert decision (DRS 02581) relating to the sign LOUIS VUITTON. I discuss this below. The second is a decision of the “*Administrative Commission, WIPO Arbitration and Mediation Center*”, apparently in relation to the signs ARMANI and GIORGIO ARMANI. The Complainant has not explained why this decision, which is based on the application of a set of rules different to the DRS Policy, is relevant. I do not discuss it further.
- 5.5. The Complainant requests transfer of the Domain Name.
- 5.6. As I have indicated above in paragraph 3.3, the Respondent did not provide a response.

## **6. Discussions and Findings**

- 6.1. Under Section 2 of the DRS Policy the Complainant must prove:
- i. that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
  - ii. that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 6.2. There are thus three elements to be proven: (i) Rights; (ii) identity or similarity; and (iii) Abusive Registration.
- 6.3. I should add that, whilst it is the Complainant’s case to prove, the fact that the Respondent has not responded to the Complaint means that, if the Complaint sets out on its face a convincing case, then it is likely to succeed (see the DRS Experts’ Guide, section 4.1). In other words, if the Complaint

raises a case that requires an answer, adverse inferences may be drawn from the Respondent's failure to provide such an answer.

(i) Rights

6.4. Section 1 of the DRS Policy defines Rights as meaning *"rights enforceable by the Complainant, whether under English law or otherwise..."*. The NG Trade Marks are undoubtedly rights enforceable by the Complainant. A European Union trade mark is enforceable under English law, and it is reasonable to infer that the French and International Registrations are enforceable elsewhere. The Complaint satisfies the first element.

(ii) Identity or similarity

6.5. Section 2.3 of the DRS Experts' Guide states *"...a name or mark will ordinarily be regarded as identical to the domain name if, at the third level, and ignoring the presence of hyphens and the absence of spaces and ampersands, they are the same."*

6.6. The Domain Name is nicolas-ghesquière.uk. But for the hyphen and the ".uk" element, that is the same as the name NICOLAS GHESQUIÈRE that is the subject of each of the NG Trade Marks.

6.7. I agree with the Complainant that the Domain Name is identical to the name in respect of which the Complainant has Rights. The second element is satisfied.

(iii) Abusive Registration

6.8. An Abusive Registration is defined in Section 1 of the DRS Policy. It includes a Domain Name which was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

6.9. The question of whether a domain name is an Abusive Registration is a multi-factorial assessment. A non-exhaustive list of factors which may indicate an Abusive Registration is set out in section 5.1 of the DRS Policy. For present purposes, the following are relevant.

*5.1.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name.*

5.1.6 *The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.*

6.10. Section 8.4 of the DRS Policy is also relevant:

8.4 *Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on the merits.*

6.11. I should add that, although it is nowhere to be found expressly in the DRS Policy, the overriding view of Nominet Experts is that, because the system of registration of domain names is a 'first come first served system' in which as a general rule any person is entitled to register any available domain name, in order to show that a domain name amounts to an Abusive Registration a complainant generally needs to show on the balance of probabilities that the respondent was aware of the complainant and/or its rights in a name or mark identical or similar to the domain name at the time it was registered (see, for example, EQUEST.co.uk – DRS 20412).

6.12. That general rule is subject to another exception, again not to be found in the DRS Policy, that there are circumstances where a finding of an Abusive Registration may be made, not on the basis of a respondent's actual knowledge, but instead on the basis that a respondent should have been aware of a complainant's Rights, for example where a respondent is in effect wilfully blind, or fails to make any proper enquiries. However, there is no general obligation on registrants to carry out trade mark searches (see again EQUEST.co.uk – DRS 20412).

6.13. I now turn to the Complainant's six submissions.

6.14. The Complainant's first submission is that the Domain Name "*constitutes an infringement*" of the NG Trade Marks.

6.15. The first point to observe is that, since disputes are decided by reference to the DRS Policy and not to the law, it does not necessarily follow that a domain name that amounts to an infringement of a registered trade mark will necessarily also be an Abusive Registration. It will depend on the circumstances.

6.16. In any event, under the harmonised law of trade marks within the European Union, in circumstances where an alleged infringer is using a sign that is identical or similar to a registered trade mark, a finding of infringement can only result from the alleged infringer using the sign in relation to goods or services identical or similar to those for which the trade mark is registered, or

using the sign in a way that takes unfair advantage of or is detrimental to the registered trade mark. In this case, the Complainant has positively asserted that the Respondent is not using the Domain Name in relation to any goods or services, and has made no submissions on unfair advantage or detriment.

6.17. I therefore reject the Complainant's first submission.

6.18. The second submission is that when registering the Domain Name the Respondent "*could not have ignored*" that NICOLAS GHESQUIÈRE was the name of a renowned fashion designer. Considering that submission requires analysing the Complainant's evidence of reputation, as to which I make three observations.

- i. First, the majority of the evidence is in French, without translations. That is generally unhelpful.
- ii. Second, a great deal of the evidence discusses M. Ghesquière's position steering the creative helm at Louis Vuitton. But that is evidence of his reputation *as a creative director*. On the other hand, the Rights on which the Complainant relies are trade mark registrations which cover the use of a name in relation to *goods and services*, not in relation to positions or offices. I do not find that Mr Ghesquière's reputation as a director is helpful to the Complainant's case based on registered trade mark rights.
- iii. However, notwithstanding those two criticisms, there are several references to the renown of NICOLAS GHESQUIÈRE as a badge of origin in relation to clothing and clothing promotions. For example:
  - In 2012 'purseblog' described M. Ghesquière as "*a man widely considered to be among the most talented (if not the most talented) designers in the entire industry.*"
  - In the British Fashion Awards 2014, M. Ghesquière won 'International Designer'.
  - He was described by i-d.vice.com in September 2014 as "*one of the most important and directional fashion designers working today...where Ghesquiere leads others will follow, and today his influence is felt on catwalks around the world.*"

6.19. Therefore, I agree with the Complainant that the name NICOLAS GHESQUIERE is well known internationally *in the field of fashion*. However, the evidence does not suggest, and the Complainant does not submit, that the name is known more widely. Whilst Louis Vuitton might be a household name, Nicolas Ghesquière is not. The Complainant has adduced no evidence to suggest that the Respondent was in or acquainted with the field of fashion, and accordingly I do not think that the Respondent, as a matter of course, would have known of NICOLAS GHESQUIÈRE.

- 6.20. That then begs the question as to whether the Respondent made itself aware of NICOLAS GHESQUIÈRE at the time of registration, or whether the Respondent might have registered a Domain Name including the name NICOLAS GHESQUIÈRE *accidentally*. It seems quite unlikely that the Respondent could have chosen the name accidentally, but I do not know whether NICOLAS GHESQUIÈRE is a common name. Ordinarily, a diligent Complainant would adduce evidence indicating, for example, that the name was rare or unique, or that there were no other individuals or businesses trading under the name. But the Complainant has not done so, and without such evidence to assist me, it is not straightforward to conclude that the Respondent *'could not have ignored'* M. Ghesquière.
- 6.21. However, it seems to me that when registering the Domain Name, the Respondent's duty to make "*proper enquiries*" (see the EQUEST.co.uk decision, referred to in paragraph 6.12 above) ought at least to have caused it to perform some cursory searches of the Internet for the name NICOLAS GHESQUIÈRE. From the evidence I have seen, that ought to have led to discovering the well-known fashion designer and his reputation for clothing and fashion shows. The Respondent has not suggested it did not do such searches, or suggested that it did do these searches but did not find any reference to the Complainant or to its Rights.
- 6.22. On the balance of probabilities, I believe the Respondent knew (or at least ought to have known) of M. Ghesquière at the time of registering the Domain Name, and I accept the Complainant's second submission.
- 6.23. The Complainant's third submission is that the Respondent deliberately concealed its identity and knowingly sought to monopolize the Domain Name in a completely illegitimate manner. I do not accept this bare assertion. Nominet appears to have the contact details, including a name and address, for the Respondent. There is no evidence that this is a false identity. I reject the Complainant's third submission.
- 6.24. The Complainant's fourth submission relies upon Section 5.1.1.1 – namely that the Respondent does not make actual use of the Domain Name, but merely offers it for sale through a bidding system. The evidence indeed establishes that this is the only use the Respondent makes of the Domain Name, but the difficulty for the Complainant is that, as Section 8.4 of the DRS Policy makes clear, such use is not in and of itself objectionable. Moreover, section 5.1.1.1 requires that the purpose of the registration is to sell the Domain Name to the Complainant or to a competitor of the Complainant, as to which there is no evidence.
- 6.25. The Complainant relied on the LOUIS VUITTON case (DRS 02581). In that case, the Expert rejected submissions that the Respondent registered the Domain Name as a blocking registration or for the purpose of unfairly



disrupting the business of the complainant, on the basis that there was no evidence of that intention. Here, similarly, there is no evidence that the purpose of the Respondent's registration went beyond what Section 8.4 of the DRS Policy suggests is lawful.

- 6.26. However, the evidence demonstrates that the Complainant has a monopoly right in the name NICOLAS GHESQUIÈRE, such that it could prevent any third party at least in the European Union from using the Domain Name for commercial purposes in the field of fashion. Further, the reputation in the name NICOLAS GHESQUIÈRE is such that the Complainant's rights will extend to preventing the use of that name in areas beyond the field of fashion. Accordingly, it is difficult to see who, other than the Complainant, could legitimately use the Domain Name, and therefore *to whom*, other than the Complainant, the Respondent could reasonably intend to sell it. The Respondent has not identified any such person. In my judgment, the Complainant's fourth submission points towards an Abusive Registration.
- 6.27. By the Complainant's fifth submission, it asserts that the Respondent has no legitimate interest in the Domain Name. To me, this is the Respondent's most powerful submission. Although the Complainant does not expressly rely on Section 5.1.6 of the DRS Policy, it seems to me that this fifth submission engages it. That is because, against the background of my conclusions that the Domain Name is an exact match for the name NICOLAS GHESQUIÈRE (subject to the hyphen, which as I have explained above is not material), and that the name has a reputation, Section 5.1.6 of the DRS Policy calls for the Respondent to provide a reasonable justification for registering the Domain Name. It has not done so. In my opinion, the Respondent had no apparent legitimate interest for registered the Domain Name. This also points towards an Abusive Registration.
- 6.28. Taking into account the Complainant's second, fourth and fifth submissions, I find that the Domain Name is an Abusive Registration.
- 6.29. Finally, the Complainant's sixth submission is that it is obvious that the Domain Name was registered in bad faith. The Complaint (and in particular the second, fourth and fifth submissions) requires an explanation from the Respondent as to its purpose for registering the Domain Name. If the Respondent had filed a Response that did not provide such an explanation, I would have concluded that the Domain Name was registered in bad faith. The Respondent cannot be in any better position for having ignored the Complaint. I therefore agree with the Complainant's sixth submission. The Respondent was acting in bad faith when it registered the Domain Name.

## **7. Decision**

- 7.1. The Complainant has Rights in the name NICOLAS GHESQUIÈRE, which is identical to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration.
- 7.2. The Complainant requests, and I direct, that the Domain Name be transferred to the Complainant.

**CHRISTOPHER HALL**  
**20 November 2019**