

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. hui pan
Case No. D2023-1054

1. The Parties

The Complainant is Bulgari S.p.A., Italy, represented by SafeNames Ltd., United Kingdom.

The Respondent is hui pan, China.

2. The Domain Name and Registrar

The disputed domain name <bvlgaristore.com> 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 March 9, 2023. On March 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 9, 2023, 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 March 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 11, 2023.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on April 18, 2023. 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 is Bulgari S.p.A., an Italian company founded in 1884 operating in the luxury goods and hotel markets and known for its high-end jewellery including but not limited to watches, rings, necklaces and fragrance products, having more than 230 retail locations worldwide.

The Complainant's trademark is both written as BVLGARI in the classic Latin alphabet and BULGARI in the modern alphabet.

The Complainant owns numerous trademark registrations in many different jurisdictions around the world for BULGARI and BVLGARI, including the following registrations:

- United States of America trademark No. 1184684 for BULGARI, registered on January 5, 1982.
- United States of America trademark No. 1694380 for BVLGARI, registered on June 16, 1992.

The Complainant has a strong web presence and registered the domain name <bulgari.com> on February 17, 1998, which corresponds to its official website.

The disputed domain name was registered on September 9, 2022 and resolves to a website that purports to sell the Complainant's jewellery and goods offerings at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name encompasses its BVLGARI trademark in its entirety with the addition of the term "store_". Further, the Complainant says that its trademark is the dominant and only distinctive element in the disputed domain name and that the term "store_" is not sufficient to alleviate the likelihood of confusion between the Complainant's trademark and the disputed domain name.

The Complainant alleges that the Respondent does not have any trademark rights regarding the terms BVLGARI or BULGARI neither has received any license from the Complainant to use domain names featuring the trademarks BVLGARI or BULGARI.

According to the Complainant, it is clear from the composition of the disputed domain name that the Respondent has capitalised on the goodwill of the Complainant's trademark to attract Internet users to its own website for the purpose of deriving commercial gain, which does not constitute fair use.

Furthermore, the Complainant mentions that the addition of the term "store" will likely create confusion for Internet users seeking the Complainant's offerings as it suggests that the disputed domain name is affiliated with the Complainant's online store. Also, the Complainant submits that the Respondent is likely using the disputed domain name to carry out fraudulent activity, in passing off as the Complainant and collecting personal information from its users and that this behavior can never confer rights or legitimate interests.

The Complainant informs that its trademark registrations predate the creation date of the disputed domain name by more than 40 years and that on November 2, 2022 sent a cease and desist notice to the Respondent and did not receive any response, which demonstrates the Respondent's bad faith. Also, the Complainant explains that the choice of the term 'store' exacerbates the finding of bad faith as it misleads Internet visitors into thinking that the disputed domain name is linked with the Complainant's online shop offerings.

The Complainant says that the Respondent is engaged in a pattern of bad faith behaviour since its email address has been used to register other domain names that specifically targets famous brands in the clothing and retail industries, suggesting that it is likely selling fake products.

Finally, the Complainant requests the transference of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

As per paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

A. Identical or Confusingly Similar

The evidence demonstrates that the Complainant is the owner of several trademark registrations for BULGARI and BVULGARI, which is undoubtedly considered as a well-known trademark.

The disputed domain name incorporates the Complainant's trademark BVLGARI in its entirety. The addition of the term "store" does not avoid a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

It is the general view among UDRP panels that the addition of other terms (whether merely descriptive, geographical, pejorative, meaningless, or otherwise) to a trademark in a domain name is normally insufficient in itself to avoid a finding of confusing similarity under the first element of the UDRP. See section 1.8 of the [WIPO Overview 3.0](#).

As numerous prior UDRP panels have recognized, the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that a domain name is identical or confusingly similar to the complainant's mark. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that paragraph 4(a)(i) of the Policy has been proved by the Complainant, *i.e.*, the disputed domain name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

The Respondent has not submitted a response to the Complaint.

There is no evidence that the Respondent has any authorization to use the Complainant's trademark or to register domain names containing the Complainant's trademark BVLGARI.

There is no evidence that the Respondent is commonly known by the disputed domain name.

There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name or that before any notice of the dispute the Respondent has made use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Instead, the Complainant showed evidence that the disputed domain name was being used to mislead Internet users, by offering products for sale under the

BVLGARI trademark, aiming to profit.

Moreover, the construction of the disputed domain name itself is such to carry a risk of implied affiliation that cannot constitute fair use.

The Panel finds that the use of the disputed domain name, which incorporates the famous Complainant's trademark, does not correspond to a *bona fide* use of the disputed domain name under the Policy.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(ii) of the Policy has been satisfied, *i.e.*, the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The distinctive, widely wellknown and highly reputed trademarks BULGARI and BVULGARI are registered by the Complainant in several jurisdictions and have been used for a long time. Also, the Complainant uses and registered the domain name <bulgari.com>. All these registrations predate the registration date of the disputed domain name. Therefore, a domain name that reproduces/imitates such a mark is already suggestive of the registrant's bad faith.

In addition, the Panel notes that the disputed domain name includes the term "store", which in this case may serve as an additional evidence of the registration of the disputed domain name in bad faith since it gives the idea that the disputed domain name refers to an authorized store of the Complainant, also considering that the Complainant demonstrated that the disputed domain name resolves to an online store offering likely counterfeit products.

Therefore, this Panel finds that the Respondent has intentionally attempted to cause confusion with the Complainant's trademark by misleading Internet users to believe that its website belongs to or is associated with the Complainant.

Moreover, the Respondent has chosen not to respond to the Complainant's cease & desist letter nor the allegations in this Complaint. In light of the circumstances of this case and according to the panel's decision in *The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. [D2009-0610](#), "[...] the failure of the Respondent to respond to the Complaint further supports an inference of bad faith".

This Panel finds that the Respondent's attempt of taking undue advantage of the trademarks BULGARI/BVLGARI for commercial gain as described in paragraph 4(b)(iv) of the Policy has been demonstrated.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(iii) of the Policy has been satisfied, *i.e.*, the disputed domain name has been registered and is being used in bad faith.

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, <bvlgaristore.com> be transferred to the Complainant.

/Mario Soerensen Garcia/

Mario Soerensen Garcia

Sole Panelist

Date: May 2, 2023