

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. Yanyan Shao

Case No. D2023-1424

1. The Parties

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

The Respondent is Yanyan Shao, China.

2. The Domain Name and Registrar

The disputed domain name <bvlgarishopmall.com> (the “Disputed Domain Name”) is registered with Hong Kong Juming Network Technology Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 3, 2023. On April 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 6, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 6, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 6, 2023.

The Center verified that the Complaint together with the amended 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 April 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 1, 2023. Apart from the automatic messages received from the email address on one of the websites associated with the disputed domain name, the Respondent did not submit any response. On May 2, 2023, the Center informed the Parties that it would proceed to appoint the panel.

The Center appointed Mariya Koval as the sole panelist in this matter on May 19, 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 an Italian company founded in 1884. The Complainant operates in the luxury goods and hotel markets, and is particularly known for its high-end jewelry including but not limited to watches, rings, necklaces and fragrance products. In the 1970s the Complainant opened its first international locations in New York City, Paris, Geneva and Monte Carlo. Currently, the Complainant has more than 230 retail locations worldwide. The “Bulgari/Bulgari” name derives from the founder’s name, “Voulgaris”.

The Complainant’s BVLGARI trademark (the “BVLGARI Trademark”) is written as both BVLGARI (in the classic Latin alphabet) and BULGARI (in the modern Latin alphabet). The Complainant, its affiliates, subsidiaries and associated companies own registrations for the BVLGARI Trademark within numerous jurisdictions. These include, among others, United States of America (“United States”) Trademark Registration No. 1184684 for BULGARI (registered on January 5, 1982), International Trademark Registration No. 452694 for BULGARI (registered on May 15, 1980), and International Trademark No. 494237 for BVLGARI (registered on July 5, 1985), three of which are currently registered in the name of the Complainant.

The Complainant registered the domain name <bulgari.com> on February 17, 1998, and has had a strong web presence since that date. The Complainant’s official website enables users to access all product lines: jewelry, fragrances, leather goods, accessories, watches and the bridal collection. Internet users are also able to locate the Complainant’s stores and authorized retailers worldwide. The Complainant is also active on social media platforms such as Facebook, Twitter, Instagram and Pinterest.

The BVLGARI Trademark is also well advertised globally, with promotional videos, billboards and other sources of marketing material, which has further promoted the brand’s global recognition for high-end jewelry and accessories. The products under the BVLGARI Trademark have been used by many celebrities at high-profile events such as the Oscars and Premieres.

The Disputed Domain Name was registered on September 23, 2022. As at the date of this Decision, the Disputed Domain Name resolves to an inactive website. However, according to the evidence presented by the Complainant (Annexes 9 and 10 to the Complaint), the Disputed Domain Name previously resolved to different websites containing various contents, including an advertisement page for a website construction company, news articles and links, and information webpages for alleged companies. The Disputed Domain Name was also listed for sale on third party websites.

The Complainant sent a cease and desist letter to the Respondent on November 2, 2022, but no response was received from the Respondent.

5. Parties’ Contentions

A. Complainant

The Complainant asserts that it has spent substantial amount of time, money and effort in promoting, marketing and using the BVLGARI Trademark to identify and distinguish its services domestically and internationally. Consequently, the BVLGARI Trademark has acquired distinctiveness in the market worldwide and have customers who rely on the brand’s name and quality. The Complainant also asserts that the terms Bulgari and Bvlgari are often used synonymously, although traditionally Bulgari is used in relation to the company name (Bulgari S.p.A.), whilst Bvlgari relates to the trademark.

The Complainant claims that the Disputed Domain Name is confusingly similar to the Complainant’s BVLGARI Trademark in view that the Disputed Domain Name encompasses the BVLGARI Trademark in its

entirety with the addition of the terms “shop” and “mall”. The Complainant’s BVLGARI Trademark is the dominant and only distinctive element in the Disputed Domain Name; the addition of the terms “shop” and “mall” is not sufficient to alleviate the likelihood of confusion between the Complainant’s BVLGARI Trademark and the Disputed Domain Name.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. To the best of the Complainant’s knowledge, the Respondent does not have any rights to the BVLGARI Trademark. Neither has the Respondent received any license from the Complainant to use domain names featuring the BVLGARI Trademark. The Respondent has not used, nor prepared to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services. The Disputed Domain Name has been used to display various contents since the Respondent’s registration, none of which represents a *bona fide* offering of goods or services. Instead, the Respondent has deliberately registered the Disputed Domain Name which is confusingly similar to the distinctive BVLGARI Trademark. The Respondent has used the Disputed Domain Name in two ways: firstly, the Disputed Domain Name has been used to resolve to unrelated contents, including an advertisement page for a website construction company, unrelated news articles and links, and information webpages for alleged companies; secondly, the Disputed Domain Name has been listed for sale. Such use of the Disputed Domain Name suggests that the Respondent intends to generate undue profit based on the Disputed Domain Name’s value as it comprises the Complainant’s BVLGARI Trademark.

To the best of the Complainant’s knowledge, the Respondent is not commonly known by the distinctive BVLGARI Trademark. Therefore, there is no plausible reason for the registration and use of the Disputed Domain Name, other than the motive of taking advantage of the goodwill and reputation of the BVLGARI Trademark.

Furthermore, whilst the words “shop” and “mall” are common terms to describe the retail industry, when used with the Complainant’s BVLGARI Trademark, the Respondent capitalizes on the Complainant’s renown in order to create the false impression that he or she is affiliated with the Complainant.

The Complainant also claims that the Respondent registered and is using the Disputed Domain Name in bad faith. The Complainant’s BVLGARI Trademark registrations predate the registration date of the Disputed Domain Name by at least 43 years. In addition, substantial goodwill has accrued since the Complainant’s establishment in 1884; the BVLGARI/BULGARI mark has become synonymous with high-end and stylistically unique luxury accessories, as well as the hotel industry since its operations from 2001.

The Complainant emphasizes that the Respondent is using the Complainant’s BVLGARI Trademark with the addition of the terms “shop” and “mall” to attract Internet users to the Disputed Domain Name in an attempt to confuse and mislead Internet users seeking or expecting the Complainant’s online shop offerings. Further, the Respondent has used the Disputed Domain Name to direct Internet traffic to land on several unrelated contents including the advertisement of an alleged website construction company; news articles and links; and information on various companies. Although there is no explicit commercial activity, the Complainant submits that Internet users, who inevitably land on the Respondent’s content expecting the Complainant’s offerings, may inevitably engage with the Respondent’s own business advertisements.

B. Respondent

Apart from the automatic messages received from the email address on one of the websites associated with the Disputed Domain Name, the Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which 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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has properly asserted its rights in the BVLGARI Trademark due to the long use and registrations worldwide.

The Disputed Domain Name reproduces the Complainant's registered BVLGARI Trademark in its entirety with the addition of the terms "shop" and "mall", as well as the generic Top-Level domain ("gTLD") ".com". According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. Also, according to section 1.8 of the [WIPO Overview 3.0](#) where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements. The Panel finds that in view of the fact that in this case, the Disputed Domain Name incorporates the entirety of the Complainant's BVLGARI Trademark, the addition of the terms "shop" and "mall" does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Trademark.

It is also well established that the gTLD, in this case ".com", does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar to the Complainant's trademark because the gTLD is viewed as a standard registration requirement.

In light of the above, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's BVLGARI Trademark and that the Complainant has established the first condition of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant has used its BVLGARI Trademark for more than 100 years, which is long before the Respondent registered the Disputed Domain Name in 2022. The Complainant's BVLGARI Trademark is well known throughout the world.

The Panel considers that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. There is no evidence that the Respondent appears to own any BVLGARI Trademark, nor is the Respondent commonly known by the Disputed Domain Name. Furthermore, the Panel concludes that in view of the global fame of the BVLGARI Trademark it is highly unlikely that anybody could legitimately adopt and use the Disputed Domain Name without creating confusion with the Complainant.

Also, taking into consideration the reputation of the Complainant's BVLGARI Trademark, it is impossible to assume that the Respondent was unaware of the Complainant's brand and business at the time of registration of the Disputed Domain Name.

In accordance with the [WIPO Overview 3.0](#), section 2.5.1, even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The addition of the terms "shop" and "mall", which relate to the places for retail business, to the Complainant's

BVLGARI Trademark in the Disputed Domain Name, is further evidence, that the Respondent was very well aware of the Complainant's BVLGARI Trademark and business at the time of registration of the Disputed Domain Name and has done so for the purpose of creating a clear impression that the Disputed Domain Name is connected with the Complainant's BVLGARI Trademark.

The Panel also finds that no license or authorization of any other kind has been given by the Complainant to the Respondent to use the BVLGARI Trademark. The Disputed Domain Name previously resolved to different websites containing various contents, including an advertisement webpage for a company providing website construction services, news articles and links, and information webpages for alleged companies. Moreover, the Disputed Domain Name was offered for sale on third party websites. Such use of the Disputed Domain Name gives no grounds for considering its use in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

Furthermore, in this case, the Respondent, having a chance to invoke any circumstances for demonstration of his or her rights or legitimate interests in the Disputed Domain Name, did not reply to the cease and desist letter sent by the Complainant, nor to the Complaint, and consequently has not rebutted the Complainant's *prima facie* case.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant obtained the registration of the BVLGARI Trademark more than 40 years earlier than the Respondent registered the Disputed Domain Name in 2022. Having considered that the Complainant's BVLGARI Trademark is globally well known, and that the Complainant has spent huge amount of efforts to promote its BVLGARI Trademark, the Panel finds that the Respondent was aware of the reputation of the BVLGARI Trademark when registering the confusingly similar Disputed Domain Name that completely incorporates the Complainant's trademark with the addition of the terms "shop" and "mall" relating to the retail business operated by the Complainant. The Panel considers it is obvious bad faith that the Respondent deliberately chose the Disputed Domain Name to create a likelihood of confusion with the Complainant's BVLGARI Trademark so as to create a false association or affiliation with the Complainant.

The Panel finds that, taking into consideration all circumstances of this case, the Disputed Domain Name has been registered and used in bad faith, with the Respondent's awareness of the Complainant's BVLGARI Trademark and with the Respondent's intention to benefit from the likelihood of confusion between the Disputed Domain Name and the Complainant's trademark.

The Disputed Domain Name previously resolved to different websites containing various contents, including an advertisement webpage for a company providing website construction services, news articles and links, and information webpages for alleged companies. The Panel finds that the Respondent's attempt to attract Internet users to visit various websites, by registering and using a domain name that is confusingly similar to the Complainant's BVLGARI Trademark, constitutes bad faith. Further, the Disputed Domain Name was also listed for sale on third party websites.

In addition, according to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is of the opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the Complainant's well-known BVLGARI Trademark, intended to disrupt the Complainant's business and confuse Internet users seeking for or expecting the Complainant. In view of the absence of any evidence to the contrary and that the Respondent did not file any response to claim otherwise, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

In view of the foregoing, the Panel finds that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, 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 <bvlgarishopmall.com> be transferred to the Complainant.

/Mariya Koval/

Mariya Koval

Sole Panelist

Date: June 2, 2023