

## **ADMINISTRATIVE PANEL DECISION**

Bulgari S.p.A. v. Zhoua, Guan Wei  
Case No. D2023-0880

### **1. The Parties**

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

The Respondent is Zhoua, Guan Wei, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <bulgari-men-spa.com> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 27, 2023. On February 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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, See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 9, 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 March 9, 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 March 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 3, 2023.

The Center appointed Delia-Mihaela Belciu as the sole panelist in this matter on April 11, 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 by Sotirios Voulgaris. The Complainant operates in the luxury goods and hotel markets, and is particularly known for its jewellery, including but not limited to watches, rings, necklaces, and fragrance products.

The BULGARI name derives from the founder's name, "Voulgaris". The Complainant's trademark is written as BVLGARI in the classic Latin alphabet and BULGARI in the modern alphabet. The Complainant submits that the terms BULGARI and BVLGARI are often used synonymously, but the term BULGARI is used in relation to the company name, whilst the term BVLGARI relates to the brand name.

The Complainant also operates several hotels since 2001, as a result of a joint venture. The Complainant's hotels can be found in major locations across the globe such as Shanghai, London, Beijing, Milan, Bali, Dubai, and Paris, and has resorts scheduled to open in the future such as in Rome, Tokyo, and Ranfushi.

The Complainant's BVLGARI/BULGARI hotel services include The Bulgari Spa, a luxury experience available to customers utilising the Complainant's accommodation(s). The Complainant submits that its spa at the BULGARI Hotel in London is an award-winning 2000m and one of the largest and most exclusive spas in central London. Further, the Complainant submits that the spa at the BULGARI Hotel in Shanghai is described by CEO of GOCO Hospitality as "truly raising the standard of luxury spa offerings in China".

The Complainant is the owner of several BULGARI and BVLGARI trademark registrations, including:

- the European Union Trade mark Registration for BVLGARI No. 007138101 registered on June 3, 2009, for services in classes 35, 36, 41, and 43;
- the Italian Trademark Registration for BVLGARI No. 000984147, registered for goods on November 18, 2005, for goods and services in classes 25, 34, 38, and 41;
- the International Trademark Registration for BVLGARI No. 494237 registered on July 5, 1985, for goods and services in classes 3, 8, 11, 14, 16, 18, 20, 21, 25, and 34;
- the Canadian Trademark Registration for BVLGARI No. TMA312178, registered on March 14, 1986, for goods in classes 14, 21, and 26;
- the Mexican Trademark Registration for BULGARI No. 503494, registered on September 12, 1995, for goods in class 25;
- the International Trademark Registration for BULGARI No. 452694, registered on May 5, 1980, for goods and services in classes 11, 14, 20, and 21;
- the Australian Trademark Registration for BULGARI No. 338663, registered on October 5, 1979, for goods in class 14.

The Complainant is also the owner of the domain name corresponding to its official website, "www.bulgari.com", since February 17, 1998.

The disputed domain name was registered by the Respondent on July 27, 2022, and resolves to a website that purports to offer the sale of various massage treatments, including those of an erotic nature. It also links Internet users to several social media platforms that display pornographic content.

On October 5, 2022, the Complainant sent to the Respondent a cease-and-desist letter demanding the Respondent, among others, to transfer the disputed domain name to the Complainant (the "Letter"). The Respondent did not respond to the Letter.

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's BULGARI mark. To this end, such underlines that it owns registered trademarks for BULGARI/BVLGARI and that there is a goodwill and recognition attained under the name BULGARI/BVLGARI, which is a distinct identifier associated with the Complainant's goods and services.

The Complainant further asserts that previous panels have recognized the value of the BULGARI/BVLGARI trademarks and their association with the Complainant.

In the Complainant's view, the disputed domain name is confusingly similar to the Complainant's BULGARI mark as such encompasses the BULGARI mark in its entirety with the addition of the terms "men" and "spa" separated by hyphens. The Complainant further contends that the BULGARI mark is the dominant and the only distinctive element in the disputed domain name and that the addition of the terms "men" and "spa" are not sufficient to alleviate the likelihood of confusion between the Complainant's BULGARI mark and the disputed domain name. On the contrary, in his view, the additions only reinforce the connection with the Complainant.

In respect of the generic Top-Level Domain ("gTLD") ".com", which forms part of the disputed domain name, the Complainant requests that the Panel disregard it under the first element as it is a standard registration requirement.

For these reasons, the Complainant concludes that the disputed domain name is confusingly similar to its BULGARI mark.

The Complainant further contends that the Respondent does not have any rights or legitimate interests in the disputed domain name for a number of reasons.

First, the Complainant asserts that to the best of his knowledge, the Respondent does not have any trademark rights to the term BULGARI. Further, the Complainant contends that there is also no evidence that the Respondent retains any unregistered trademarks to the term BULGARI.

The Complainant contends that the Respondent has not received any license from the Complainant to use domain names featuring the BULGARI trademark.

Secondly, the Complainant asserts that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services. According to the submission made by the Complainant, the disputed domain name resolves to a website that purports to offer the sale of various massage treatments, including those of an erotic nature. The Complainant further asserts that the disputed domain name also links Internet users to several social media platforms that display extensive pornographic content.

In the Complainant's view, the use of the BULGARI-contained disputed domain name to direct users to the Respondent's own business and social media accounts is not a *bona fide* offering of goods or services. On the contrary, in his view, the Respondent is exploiting and misrepresenting the Complainant's BULGARI mark and BULGARI SPA offerings for its own commercial gain and that the Respondent is clearly attempting to attract and mislead Internet users based on the value of the Complainant's BULGARI mark.

Thirdly, the Complainant contends that, to the best of his knowledge, the Respondent is not commonly known by the distinctive terms BVLGARI/BULGARI. Therefore, in the Complainant's view, 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 attached to the BVLGARI/BULGARI mark. The Complainant also asserts that the mere ownership of the disputed domain name does not confer a right or legitimate interest on the Respondent.

Fourthly, the Complainant contends that its BVLGARI/BULGARI trademarks are distinctive terms used to represent the Complainant's goods and services and that there is no generic or common usage for the terms BVLGARI/BULGARI. The Complainant further contends that the Respondent has intended to use the disputed domain name in order to target him.

Lastly, the Complainant asserts that the Respondent has registered the disputed domain name which comprises of the Complainant's BULGARI mark in combination with the terms "men" and "spa" to create further confusion for Internet users as to the disputed domain name's affiliation with the Complainant, given the Complainant's spa services.

In the Complainant's view, such an act in itself demonstrates an intention to misleadingly divert Internet users as the Respondent has used the disputed domain name to direct users to its own business and social media platforms, which consist of adult content. Such use in the Complainant's view, is neither legitimate nor fair, and instead amounts to tarnishment of the Complainant's BULGARI mark. The Complainant further contends that, the Respondent intends to capitalise on the Complainant by giving Internet users the false impression that the Complainant is associated with the Respondent's adult-themed offerings.

For these reasons, the Complainant concludes that such has presented a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant further contend that the disputed domain name was registered and is being used in bad faith.

To this end, the Complainant argues that his trademark registrations predate the creation date of the disputed domain name by at least 42 years. In addition, he contends that substantial goodwill has accrued since the Complainant's establishment in 1884; the BVLGARI/BULGARI name has become synonymous with high-end and stylistically unique luxury accessories, as well as the hotel (and spa) industries since its operations from 2001.

Further, the Complainant asserts that when searching "Bulgari" on popular Internet search engines such as Google, the Complainant's brand and services as the first result. Moreover, any average Internet user has access to BVLGARI/BULGARI trademark registrations, as they can be found on public trademark databases.

The Complainant further sustains that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith as previous Panels have found.

The Complainant alleges that the domain name replicates the BULGARI trademark in its entirety and that the additional terms in the disputed domain name do not dispel the likelihood of confusion, as they relate to the Complainant's spa offerings.

The Complainant further contends that such has demonstrated its strong reputation in the brand BULGARI and the circumstances of this case indicate that the Respondent is intentionally using the commercial value and goodwill of the Complainant's BULGARI mark to attract and direct Internet users to its own business offerings. Bad faith is particularly apparent in this case, in the Complainant's view, as the Respondent presumably attracts commercial gain through the advertisements on the landing site of the disputed domain name, namely the Respondent's erotic massage offerings.

The Complainant further alleges that directing unsuspecting Internet users to explicit content on the main landing site as well as the Respondent's social media platforms where the domain name does not relate to such content, is bad faith use and that such use tarnishes the BULGARI mark.

Finally, the Complainant argues that a cease and desist letter was sent to the Respondent on October 5, 2022, without for the Respondent to provide any response.

For all these reasons, the Complainant concludes that, the disputed domain name was registered and is being used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

In order for the Complainant to succeed, such must prove, according to paragraph 4(a) of the Policy, that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

In case all three element above have been fulfilled, the Panel is able to grant the remedy requested by the Complainant. Thus, the Panel will deal with each of the requirements in turn.

### **A. Identical or Confusingly Similar**

According to paragraph 4(a)(i) of the Policy, the Complainant has to show that the disputed domain name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights. With respect to the requirement of having rights pursuant to paragraph 4(a)(i) of the Policy, the Complainant owns several BULGARI/BVLGARI registered trademarks, in several jurisdictions. Consequently, the Panel finds that this requirement is fulfilled.

With regard to the assessment of identity or confusing similarity of the disputed domain name with the BULGARI trademarks, it is generally accepted that this involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (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 the disputed domain name is confusingly similar to the BULGARI trademarks as such incorporates the BULGARI mark in its entirety, and the addition of the terms "men" and "spa" separated by hyphens which correspond in fact to one of businesses of the Complainant does not prevent a finding of confusing similarity. The BULGARI mark remains clearly recognizable within the disputed domain name.

Previous UDRP panels have held that such additions do not prevent a finding of confusing similarity (see *Inter-IKEA Systems B. V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#)).

In what concerns the addition of the gTLD “.com”, this is not to be taken into consideration when examining the confusing similarity between the Complainant’s trademarks and the disputed domain name, as such is viewed as a standard registration requirement and such is disregarded under the first element confusing similarity test (see section 1.11 of the [WIPO Overview 3.0](#)).

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

The Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made out, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see section 2.1 of the [WIPO Overview 3.0](#)).

In this case, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent, as the Respondent has not submitted any response.

Thus, based on the available evidence, the Respondent does not appear to be known by “BULGARI” nor does it own any trademarks incorporating the terms “bulgari”. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its BULGARI trademarks in the disputed domain name.

Moreover, based on the evidence filed by the Complainant, the disputed domain name resolves to a website that purports to offer the sale of various massage treatments, including those of an erotic nature and also the disputed domain name links Internet users to several social media platforms that display pornographic content.

Furthermore, the disputed domain name comprises the Complainant’s BULGARI mark in its entirety in combination with the terms “men” and “spa”, which correspond to services rendered by the Complainant, leading to confusion for Internet users as to the disputed domain name’s affiliation with the Complainant.

The above does not amount to a *bona fide* offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Under paragraph 4(a)(iii) of the Policy, a complainant must show that the domain name has been registered and is being used in bad faith.

In this case, the Complainant’s rights to the BULGARI trademark predate the registration date of the disputed domain name.

The BULGARI trademark is registered in jurisdictions around the world since decades and enjoys of a well-known and highly distinctive character, recognized by earlier UDRP panels as well (see *Bulgari S.p.A. v. Therese Laube*, WIPO Case No. [D2019-2766](#); *Bulgari S.p.A. v. Perfect Privacy, LLC / Risk Management, Riskmanagement Rcom*, WIPO Case No. [D2019-1344](#)). Furthermore, the Complainant registered and is using the domain name <bulgari.com> for addressing the official website of the Complainant.

In light of the well-known character of the BULGARI trademarks, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the disputed domain name without knowledge of the Complainant’s BULGARI mark, which support a finding of bad faith registration.

The Respondent's incorporation into the disputed domain name of the Complainant's BULGARI mark in its entirety, followed by the addition of the terms "men" and "spa" separated by hyphens which correspond in fact to one of businesses of the Complainant, namely spa offerings, lead to a finding that such was made intentionally in order for such to make use of the commercial value and goodwill of the Complainant's BULGARI mark to attract and direct Internet users to the Respondent's own business offerings, which include erotic massage offerings, aspects support a finding of bad faith use. 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 (see section 3.1.4 of the [WIPO Overview 3.0](#)).

For all these reasons, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

## **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, <bulgari-men-spa.com>, be transferred to the Complainant.

*/Delia-Mihaela Belciu/*

**Delia-Mihaela Belciu**

Sole Panelist

Date: April 25, 2023