

ADMINISTRATIVE PANEL DECISION

Bulgari S.p.A. v. Che Kane Jose

Case No. D2023-3212

1. The Parties

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

The Respondent is Che Kane Jose, United States of America (“United States”).

2. The Domain Names and Registrar

The disputed domain names <replicabvlgariwatch.com> and <replicabvlgariwatches.com> are registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2023. On July 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 26, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Whois Privacy, Private by Design, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 27, 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 July 28, 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 August 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 30, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on September 5, 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, presently operating in the luxury goods (particularly high-end jewellery and watches as well as cosmetics and accessories) and hotel markets, counting with more than 230 retail locations worldwide and hotels in major locations across the globe such as London, United Kingdom, Beijing, China, Rome and Milan, Italy, Bali, Indonesia, Dubai, United Arab Emirates, Paris, France, and Moscow, Russian Federation.

The Complainant's official website is available at "www.bulgari.com" (domain name registered on February 17, 1998) and receives over 2 million visits per month from users around the world (Annex 5 to the Complaint).

The Complainant owns, among others, the following trademarks (Annex 8 to the Complaint):

- International registration No. 452694 for the word mark BULGARI, registered on May 15, 1980, successively renewed, in classes 11, 14, 20 and 21;
- International registration No. 494237 for the word mark BVLGARI, registered on July 5, 1985, successively renewed, in classes 3, 8, 11, 14, 16, 18, 20, 21, 25 and 34;
- United States trademark registration No. 1,184,684 for the word mark BULGARI, registered on January 5, 1982, successively renewed, in class 14; and
- United States trademark registration No. 1,694,380 for the word mark BVLGARI, registered on June 16, 1992, successively renewed, in class 18.

The disputed domain names were registered on March 9, 2023 and presently do not resolve to active webpages. They have been used in connection with online shops reproducing the Complainant's trademark and official product images while offering "Replica Bvlgari Watches", "the perfect option for those who want to experience elegance and sophistication without the hefty price tag" assuring that "All of our Replica Bvlgari watches are certified authentic by Swiss regulatory authorities" being offered "a 30-day money back guarantee".

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the BULGARI mark derives from its founder's name ("Voulgaris"), being the Complainant's trademark both written as BVLGARI in the classic Latin alphabet as well as BULGARI in the modern alphabet, often being used synonymously, but traditionally intended for BULGARI to be used in relation to the company name (Bulgari S.p.A), whilst the mark BVLGARI to the brand name.

According to the Complainant, its products are renowned for having a distinctive style that celebrates the Complainant's rich Roman history, having over the decades of the Complainant's existence, the BVLGARI/BULGARI brand been recognised for its vibrant colour combinations and innovations in regards to jewellery and become a distinctive identifies associated with the Complainant, as recognized by previous panels.

Under the Complainant's view, the disputed domain names are confusingly similar to the Complainant's BVLGARI trademark with the addition of the terms "replica", "watch" and "watches", which is insufficient to avoid a finding of confusing similarity under the Policy. The Complainant further contends that the unlawful

association with the Complainant's trademark is exacerbated by the addition of the terms "watch" and "watches" given their clear connotations to the Complainant (as a seller of premium watches) and that the term "replica" although could indicate a duplicate of the original item, does not serve sufficiently to distinguish or differentiate the disputed domain names from the Complainant's BVLGARI trademark (see *Hermes International v. tangyi*, WIPO Case No. [D2010-2266](#)).

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that:

- (i) the Respondent does not have any trademark rights over the "Bvlgari" term, there also being no evidence that the Respondent retains any unregistered trademark rights to the term "Bvlgari";
- (ii) the Respondent has not received any license from the Complainant to use a domain name featuring the BVLGARI trademark;
- (iii) the Respondent has not used, nor prepared to use, the disputed domain names in connection with a *bona fide* offering of goods or services, rather having used them for commercial gain and to promote the sale of counterfeit or unauthorized imitations of the Complainant's products (see [WIPO Overview 3.0](#), section 2.13.1, which states "Panels have categorically held that the use of a domain name for illegal activity [...] can never confer rights or legitimate interests on a respondent. Particularly in the case of counterfeits and pharmaceuticals, this is true irrespective of any disclosure on the related website that such infringing goods are 'replicas' or 'reproductions' or indeed the use of such term in the domain name itself");
- (iv) the Respondent is not commonly known by the term "Bvlgari", there being no plausible reason for the registration and use of the disputed domain names, other than the motive of taking advantage of the goodwill and reputation attached to the BVLGARI mark; and
- (v) the Respondent's conduct cannot be construed as fair use, since the Respondent has attempted to gain from the offer for sale of "replica" products by free-riding on the well-known character of the Complainant's BVLGARI mark and causing confusion among users as to the source or affiliation of the Respondent's website and the products offered for sale thereon.

As to the registration and use of the disputed domain names in bad faith, the Complainant submits that:

- (i) the Respondent has clearly registered the disputed domain names to target the Complainant's brand intentionally, being it inconceivable that the Respondent could have chosen to register the disputed domain names comprising of the Complainant's fanciful trademark, which has no descriptive or generic meaning, for any reason other than to target the Complainant's trademark;
- (ii) the Complainant sent a cease and desist notice to the Respondent on April 25, 2023 (Annex 13 to the Complaint) with a view to resolving the matter amicably and giving the Respondent a chance to provide evidence of any actual or contemplated good faith use, having the Respondent chosen not to respond, what corroborates the Respondent's bad faith; and
- (iii) the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's BVLGARI mark, having the Respondent used the term "Bvlgari" to promote similar or identical goods to those being offered by the Complainant, also having reproduced the Complainant's mark, logo, and copyrighted images of the Complainant's watches to advertise the sale of counterfeit "Bvlgari" watches, what therefore constitute bad faith (see *PRADA S.A. v. Domain Administrator*, See *PrivacyGuardian.org / Zan zhang*, WIPO Case No. [D2021-1802](#)).

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

- (i) the disputed domain names are 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 in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain names.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark BVLGARI is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms ("replica", "watch" and "watches") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent which has not been commonly known by the disputed domain names and neither has received any license from the Complainant to use a domain name featuring the BVLGARI trademark.

Also according to the evidence submitted by the Complainant, the nature of the disputed domain names, combined with the use made of the disputed domain names in connection with an online shop reproducing the Complainant's logo, together with the unauthorized reproduction of the Complainant's official product images, and the claim of sale of "Replica Bvlgari watches" which "are certified authentic by Swiss regulatory authorities" clearly suggests the sale of counterfeit goods which can never confer rights or legitimate interests on a respondent. This is so irrespective of any disclosure on the relevant website that such infringing goods are replicas of the original goods (see in this respect, section 2.13 of the [WIPO Overview 3.0](#), as well as, by way of example, *Bulgari S.p.A. v. Luigi Corsetti*, WIPO Case No. [DCO2021-0037](#) quoting *Saule, LLC, 100% Speedlab, LLC v. Jiang Lihang*, [WIPO Case No. D2021-1529](#)).

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The registration of the Complainant's BVLGARI trademark predates the registration of the disputed domain names. Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. In view of the reproduction of the BVLGARI trademarks in the disputed domain names, as well as the online shop that was available at the website relating to the disputed domain names, together with the sale of counterfeit products and the unauthorized reproduction of the Complainant's official product images, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain names.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 names, <replicabvlgariwatch.com> and <replicabvlgariwatches.com>, be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: September 19, 2023